THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

A History
1982-1990

Published by Authorization of

The United States Judicial Conference Committee
on the Bicentennial of the Constitution
of the United States
1991

DEDICATED TO

HOWARD T. MARKEY

First Chief Judge
(1982-1990)

with great respect for him as a patriot, soldier, lawyer, and judge, whose public service and contributions to America's defense and the administration of justice set him apart and rightly distinguish him as a man who has helped to make America great.

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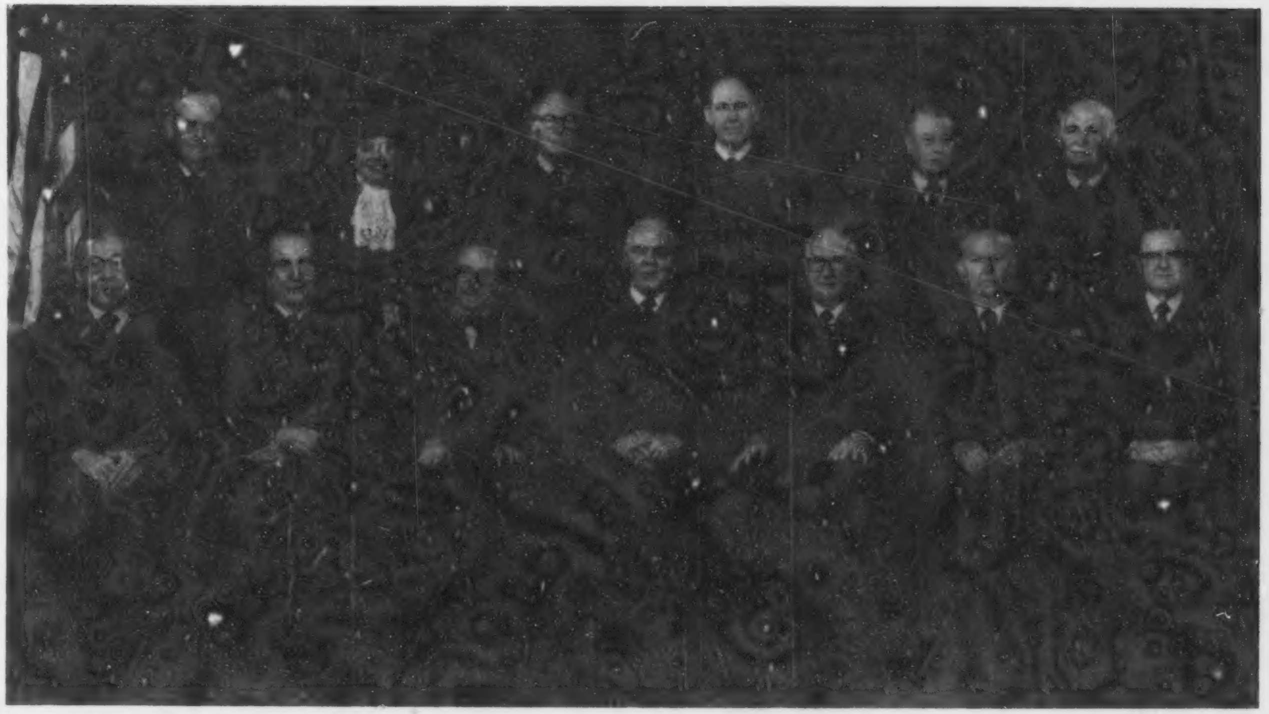

JUDGES OF THE ORIGINAL COURT

Byron G. Skelton Helen Wilson Nies Jack R. Miller Edward S. Smith Wilson Cowen Philip Nichols, Jr.
Shiro Kashiwa Oscar H. Davis Daniel M. Friedman Howard T. Markey Giles S. Rich Phillip B. Baldwin Marion T. Bennett
Not Shown: Don N. Laramore and James L. Almond, Jr.

U.S. Court of Appeals for the Federal Circuit
The National Courts Building
Washington, D.C.

FOREWORD

In celebration of our two hundred years of governance under the Constitution, that magnificent concept that has been the foundation for the unprecedented free society in which we are privileged to live, one project of the Bicentennial Committee of the Judicial Conference of the United States has been to encourage the thirteen United States Courts of Appeals to prepare written histories of the work of each circuit. We wish to acknowledge the grant of $12,000 from the committee which provided stimulation for this project. All funds were spent on the actual printing of the work. The drafting was done freely by all contributing authors, both within and outside the court. Senior Circuit Judge Marion T. Bennett undertook the formidable task of compiling and editing the history and arranging for its publication. The project consumed many months of his time which the court acknowledges with deep gratitude. Thus, this volume which sets forth the history of the Federal Circuit is primarily the work of the court itself.

As the youngest circuit, having been born only eight years ago at this writing, the "history" of the Federal Circuit, as compared to others, might be characterized as "current events." However, the first act of the Federal Circuit was an in banc hearing in the case of *South Corp. v. United States*, reported at 690 F.2d 1368, 1 Fed. Cir. (T) 1, 215 USPQ 657 (1982), which resulted in a decision by which the court adopted as precedent the case law of its two predecessors, the venerable U.S. Court of Claims (1855-1982) and the younger U.S. Court of Customs and Patent Appeals (1910-1982). [The interesting histories of these unique courts were published in 1976 and 1978 for the Court of Claims and in 1980 and 1981 for the CCPA and they may be read to obtain the complete background of the Federal Circuit.] Part I of this history details the Federal Circuit's legislative and judicial roots.

The Federal Circuit is, nevertheless, a new circuit, new not only because of the short period of its existence but also because of the novel concept of a circuit court with national jurisdiction. This innovation has been called an experiment. Congress, in creating the court, sought to bring about uniformity of decisions in certain critical areas of the law without the need for Supreme Court review to resolve conflicts between circuits. To this end, the Federal Circuit was given exclusive jurisdiction over appeals from all district courts in cases which arise under the patent laws and the Tucker Act. A particular need was seen in the field of patents where instability in the law was having a detrimental effect on an important segment of our society, the industrial and business community. Our nationwide businesses needed uniformity in interpretation of the patent laws in order to make decisions conducive to research and productivity. Our society is dependent on the self-generated efforts of individual businesses to create the goods and jobs which we enjoy. The change of direction around the world from wholly government-directed economies to increased private enterprise confirms that our forefathers selected the right course. How remarkable that the drafters of the Constitution foresaw the benefit of encouraging individual initiative by providing in the Constitution itself, among the short list of specific powers of Congress, that Congress shall have power to secure to authors and inventors the exclusive right to their writings and discoveries for a limited time. Article I, section 8. By this power and the statutes dependent on the power, our society has expressed its philosophical view that individual creativity *can* be stimulated with material rewards and that society as a whole will thereby be benefited. Only by maintaining a strong and vigorous economy can the ultimate objective of personal liberty be achieved. The Federal Circuit lives daily with the responsibility to carry out this societal decision.

The creation of the Federal Circuit was not without controversy. "Specialized" courts have been criticized as subject to myopic vision. The Federal Circuit, while unique among the circuits, has never been specialized in the sense of concentrating on only a single jurisdictional base which thereby may become separated from the mainstream of the law. The judges must be generalists in the tradition of our judicial system. From its inception, the court has had jurisdiction over widely diverse legal fields. As the reviewing court for the U.S. Court of International Trade and the U.S. International Trade Commission, it is involved in problems of importation and exportation. As the reviewing court for the U.S. Claims Court, it hears the complaints of persons having monetary grievances against the government. As examples, cases arise in connection with fifth amendment taking claims, breaches of government contracts, claims for tax refunds, mismanagement of Indian lands, vaccine injury compensation claims, monies payable under various government programs, and garnishment of government wages for alimony and child support.

The court also hears all appeals by either the government or the contractor from the many boards of contract appeals. Its jurisdiction over appeals by government employees who believe an agency has treated them unfairly in reaching an employment decision adds balance in the jurisdictional scale. The judges are well aware that their decision on whether an *individual* could legally have been demoted or fired is as important *to society* as the award of a multimillion-dollar judgment to a company for patent infringement. The court has recently been given jurisdiction over the newly created U.S. Court of Veterans Appeals, which has added appeals with another dimension of human scale.

All in all, the Federal Circuit reviews more tribunals than any other circuit.

This past year because of the emergency created by four vacancies out of a bench statutorily constituted of twelve judges, the court was able to secure the temporary assignment of a number of circuit and district judges and judges of the U.S. Court of International Trade to serve with the court. The experience was rewarding in both directions. The regular members of the court benefited from extended informal discussions with those on the front line and gained a better understanding of the problems they faced, for example, in handling a jury in a complex patent trial. The visiting judges unanimously agreed that they had gained a new perspective on the wide-ranging and complexity of the work of this court. The visitors also became familiar with the innovative procedures for processing precedential decisions. All precedential opinions of the Federal Circuit receive the scrutiny of all judges of the court before issuance. A large portion of the work of a judge of the Federal Circuit is the review of draft opinions before issuance to ensure that intra-circuit conflicts are not created. Conflicts between our own decisions would defeat a major *raison d'etre* for the court's creation. Unfamiliar with this procedure, many were surprised and not always pleased to receive suggestions from nonpanel judges for language changes in an opinion the visitor had drafted. However, once our objective was understood, unanimously, they praised the court for its efforts to maintain uniformity. Indeed, the view was expressed that this procedure is a major advance in the jurisprudential effectiveness of an appellate court and that it should be the obligation of all circuits to follow the procedure so that a trial judge has clear guidance, not conflicting directions.

I have referred to the comments of the visiting judges because they give a strong indication that the "experiment" reflected in the creation of our court is working. We also think it is working but we are not in a position to make an unbiased assessment.

This volume of the court's history is dedicated to our first Chief Judge, Howard T. Markey. I am not the best person to speak about Howard Markey. I am simply too prejudiced. He was my first chief, my only chief, and he always will be my chief. As far as I am concerned, he is the greatest chief that any court could have. He is a somewhat difficult act to follow.

He is beloved by the staff of the court. Frank Gindhart spoke for all when he said, on the occasion of Judge Markey's stepping aside, "You have been our rudder and our compass" and "a man for all seasons."

Judge Giles Rich, who has watched chiefs come and go in his twenty-eight years on the bench, said, "Howard Markey was the best." And he was.

In some ways, Howard Markey is like Wagner's music—better than it first sounds. I remember his first speech to the patent bar in Washington in 1972. Howard Markey didn't fit my image of a judge. A judge isn't a stand-up comic who enjoys his own act, who has a ball on the podium. Howard Markey never met a joke he didn't like and like telling. I heard the jokes that day, and I laughed hard. But I also listened to what followed, as I have since. His approach to law is principled pragmatism. What works, like the stimulation of creativity by the patent system, should be promoted. What doesn't work should be changed. No matter what his speech was entitled, and his speeches were legend in numbers, he almost always included expressions of unabashed patriotism and love for the Constitution. His words can be poetry. As an example, he wrote:

> Each of us, on birth, was handed a precious, gleaming jewel—the Constitution and all it represents—fought for and died for by many brave men before us. We hold it only a little while on this earth and must, someday, pass it on to those who come after us. I think it behooves us all to ask ourselves occasionally, what have we done to keep that jewel intact and untarnished? To spread its rays to others? To protect it from devaluation, compromise, abuse or

> even loss? Have we ever even told our children about it? Have we allowed a cancer, a decadence of moral values to chip away at the soul of our freedoms? Do you think and act as if ours was a completed society which has achieved its purposes and has no further great business to transact?
>
> Each man must answer for himself—but answer he must—to history if to no other. It is sad that a man can walk the earth for three-quarters of a century—and freedom never know he was here!

He made lawyers laugh but he also made them think, and not merely about the next case.

I have loved working with Chief Judge Markey. No chief could have been more appreciative and proud of the other judges of the court than he. He has been admired greatly by his judges. He astounds his colleagues with his quick intellect, the ease in his writing, and the prodigious load of work and responsibilities which he carried effortlessly. As chief, he was, in a word, terrific. He made us proud to be on the "Markey Court." And it was better and better with every passing year.

He often said the court was the lion and he only the roar. Not so, he has been the heart of the court.

To excuse our faults, I have often used the line, "Judges are appointed not anointed." I believe Howard Markey is the exception—very likely he was anointed. He is the consummate judge. We thank you, Howard Markey, for showing us the way.

One final comment. The "court" is a unity institution, but is a unit made up of individuals. I read here the biographies of the judges of the court, people whom I thought I knew very well, but I was struck by the great wealth of diverse experience and background of achievements each brings to the court, of which I was only partly aware. It is not surprising with this capable roster on the court that it is able to deal with the diverse problems it is asked to resolve. The collegial group provides a strong resource for rendering decisions not only principled in technical, legal scholarship but also tempered by real-world experience.

Thus, shall justice under the Constitution prevail.

Helen W. Nies
Chief Judge

INTRODUCTION

This history of the first eight years of the United States Court of Appeals for the Federal Circuit is published at the behest of the Judicial Conference Committee on the Bicentennial of the Constitution. Not all readers are expected to be concerned with all parts of this volume. It is hoped, however, that the materials will help in a better understanding of the judicial function in our form of self-government, particularly as it relates to a United States court of appeals with nationwide jurisdiction. Although this volume covers only the first eight years, they have been busy, important, and productive years in the high calling of administering justice in a free society. For the convenience of the reader, the history is submitted in six parts.

PART I

This part is background to explain the purpose of Congress in creating the Court of Appeals for the Federal Circuit by examination of the legislative history of the Federal Courts Improvement Act of 1982 which is the "birth certificate" of this court.

PART II

Since an institution mirrors the individuals who constitute it, we identify the judges of the court, active and senior, and their staffs. Judges appointed since 1982 were asked to write their own biographies; others were asked to edit and bring up to date their biographies which appeared in earlier histories of the Court of Customs and Patent Appeals and the Court of Claims. Pictures are included and the appendices furnish additional information about the judges.

PART III

The organization and operations of this large federal court are complex. Not all of its activities take place under the roof of the National Courts Building in Washington, D.C. Panels of the Federal Circuit sit elsewhere in the United States. Further, the judges contribute to the administration of justice by sitting on other courts when their services are requested and approved by their respective Chief Judges and by the Chief Justice. The Federal Circuit has almost continually been handicapped by judicial vacancies in its first eight years. United States judges of many federal courts have been helpful by agreeing to sit by designation on the Federal Circuit. This interchange of judges is set forth in the appendix.

Also described in part III is the vital work of the Office of the Clerk under the direction of the first Clerk of the court, George E. Hutchinson, and Francis X. Gindhart, the present Clerk. The Library is also described, as are the Administrative Services Office, the Office of the Senior Technical Assistant, and the Office of Motions Staff Attorney. The court has been blessed by the talents and dedication of able personnel in all of these offices.

PART IV

Extra-judicial support has been vital in implementing the congressionally assigned mission of the court and how it has been fulfilled. Here, the Federal Circuit Bar Association, the Advisory Committee on Rules, and the Federal Circuit Judicial Conference (the nation's largest in the federal judicial system) play an important part. Their activities are explained and summarized by those "officers of the court" who have discharged those responsibilities. The court benefits substantially by their contributions.

PART V

This history would not be complete without a look at the substantive work of the Federal Circuit on the cases and controversies brought before it on appeal from a wide variety of trial tribunals. A full discussion of what has been done with the thousands of appeals which have been filed is beyond the scope of this volume but is a matter of public record in the court's decisions. Representative cases are cited for illustrative purposes only, however, to reflect the types of issues treated by the Federal Circuit in its early years. A full table of contents for this section appears at the beginning of part V and a summary table appears in the main table of contents.

PART VI

The appendices have been prepared to show the active and senior judges who constituted the original court in 1982; subsequent appointments; the years when some took senior status, retired, or were deceased; and a table showing the lines of succession. The judges who constituted the court at any given time during twenty changes in its composition, 1982-1990, are listed. Also, the designations of Federal Circuit judges to sit on other courts and the designations of judges of other courts to sit with the Federal Circuit are shown.

In all of the disparate parts of this volume, the reader will be aided in finding what is of personal interest by reference to a fairly detailed table of contents and understanding of the organization of this history, as outlined here.

Marion T. Bennett
Senior Circuit Judge
Editor

ACKNOWLEDGMENTS

The Court of Appeals for the Federal Circuit is a public institution. Accordingly, the public is entitled to know what it does and who does it. We have tried to give the reader that information in this history of the court. It would not have been possible to do so without the cooperation of others, including a substantial part of the court staff. Special appreciation is extended to all individuals who have contributed to this history by writing parts of it or by careful proofreading and other editorial responsibilities.

We thank the judges for part II and the following members of the court staff for their contributions to part III: Francis X. Gindhart, Clerk; Ruth A. Butler, Administrative Services Officer; Donna L. Raeder, Assistant Administrative Services Officer; Regina R. Schade, Administrative and Financial Officer; Patricia M. McDermott, Librarian; Melvin L. Halpern, Senior Technical Assistant; Eleanor M. Thayer, Motions Staff Attorney; Henry A. Petri, Jr., my law clerk; Dorothy I. Butts, my secretary; and Cleopatra P. Stark, secretary (ret.).

Our grateful thanks are also due to Douglas B. Henderson, Esq., Donald R. Dunner, Esq., and George H. Hutchinson, Esq., for their contributions to part IV, and to Attorneys Nancy Schaefer, Robert D. Wallick, Jack C. Goldstein, David M. Cohen, and Andrew P. Vance, all of whom were presidents of the Federal Circuit Bar Association who made valuable contributions for part IV.

Part V, authored by Melvin L. Halpern, has its own special acknowledgments of appreciation, but I wish to extend my personal thanks to Mr. Halpern for his thorough, scholarly, and thoughtful discussion of this extensive and technical subject, as well as to those who were of such valuable assistance to him—Janet Stockhausen, MaryAnn Lastova, and Adrienne Parker of the STA staff, and to Jeffrey Mills, Patricia Donovan, Mark Dukes, Barbara B. Florence, Patricia M. McDermott, and David J. Lockwood.

This volume is proudly presented as a team effort. To the extent it may lack cohesion, fails to do justice to its subject, or is otherwise deficient, the editor accepts full responsibility.

Marion T. Bennett
Senior Circuit Judge
Editor

PART I

ORIGINS OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT — ORIGINS

Senior Judge Marion T. Bennett

We begin this history of the United States Court of Appeals for the Federal Circuit with Why and How this court was established in 1982. For the complete story, however, we must also answer the questions Who, What, When, and Where, and these will all be addressed in the following narration, but not necessarily in the order stated. We will identify some key players in this legislative development which took root gradually in the late 1970s and early 1980s, discuss what Congress' intentions for the court were, and how the court has fulfilled its assigned mission. Although only eight years old at this writing, enough has taken place to be able to answer all questions with confidence in the court and its future.

The court's able first Chief Judge, the Honorable Howard T. Markey, in an address to the Boston Patent Law Association, said in a flight of rhetoric:

> Like the famed Phoenix, the United States Court of Appeals for the Federal Circuit rose on October 1, 1982, from the ashes of two former courts. On that day, the 127 year old United States Court of Claims and the 73 year old United States Court of Customs and Patent Appeals went out of existence, leaving a history of outstanding contributions to the administration of justice.[1]

As with most analogies, this one may not be exact. The contributions of the predecessor courts are without doubt, but the Egyptian Phoenix of mythology arose after self-immolation. The Federal Circuit's predecessor courts never considered this. They were simply overtaken by changing circumstances before being consigned to the dust bin of history.[2]

Lawyers have reason to know, although the general public may not, that the federal judicial system has an organizational structure frequently compared to that of a pyramid. At the bottom there is a broad base of important trial tribunals which make initial decisions based on evidence heard or presented in public sessions and which evidence can be, and usually is, of an adversarial nature. There are ninety-four United States district courts of general jurisdiction scattered throughout the nation in the fifty states, the District of Columbia, Puerto Rico, and our territories or possessions. In addition, there are specialized courts of limited subject matter, but with nationwide jurisdiction, such as the United States Claims Court and the United States Tax Court located in Washington, D.C., and the United States Court of International Trade located in New York City. Military courts occupy a special category not relevant to this discussion. All of these trial courts where cases are tried before a judge and jury or a judge without a jury enter judgments appealable to a middle layer of the pyramid. This layer consists of the thirteen United States courts of appeals with review authority as prescribed by law. Twelve courts of appeals have broad subject matter jurisdiction but they have geographic limits. The Federal Circuit, located in Washington, D.C., has unlimited geographic jurisdiction nationwide with broad but limited subject matter jurisdiction. At the peak of the pyramid is the United States Supreme Court. This, the most important court in America, may in its discretion review the judgments of the courts on the judicial structure below. Many states have generally parallel judicial systems to handle legal questions arising under state laws, but they interpret, apply, and enforce due process under both state constitutions and the United States Constitution with limited access to U.S. Supreme Court review. There are only nine justices on the Supreme Court and annually there are literally thousands of appeals lawyers would like for them to review, but this is impossible. In recent times the Supreme Court has decided about 150 cases each year with opinions. Thus, the circuit courts of appeals are the courts of last resort in most litigated matters involving federal law.

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[1] Markey, *The Phoenix Court*, 32 Clev. St. L. Rev., No. 1, at 1 (1983-1984); 10 APLA Q.J. (No. 4, 1982).

[2] Histories of the United States Court of Customs and Patent Appeals and the United States Court of Claims were published by the Superintendent of Documents, Government Printing Office, in two volumes for each court—in 1980 and 1981 for the former court, and 1976 and 1978 for the latter. They were published by authorization and direction of the Committee on the Bicentennial of Independence and the Constitution of the Judicial Conference of the United States.

The litigation explosion in America has caused a back-up of cases throughout the judicial structure. From time to time Congress has authorized the appointment of additional district and circuit court judges but this has been insufficient to break the caseload logjam, causing serious delays in getting important cases decided timely and with finality. Courts themselves have employed rules, innovative procedural methods, and automation to speed up litigation. However, the great population and business growth in the nation naturally generates more litigation. There is also an unfortunate popular view, untrue but widely held, that all ills of society have a judicial remedy. For some time the Supreme Court has been unable to review more than one percent of the cases decided by the courts of appeals. When the latter courts are in conflict with one another in deciding similar cases and the Supreme Court cannot hear and resolve all of them, it is clear that great uncertainty in the law ensues. Lawyers then shop for a tribunal most likely to favor a client's petition. Citizens, otherwise equal, may thus receive inequality of justice as a result of nothing more than their residence in different parts of the country.

In 1971 the then-Chief Justice, Warren E. Burger, appointed a Study Group to propose remedies for these and attendant problems affecting the Supreme Court's caseload. The group was chaired by Harvard Law Professor Paul A. Freund. After extensive work, the Freund Committee recommended creation of a National Court of Appeals composed of circuit judges borrowed from other courts, sitting on a revolving basis, to screen cases where Supreme Court review was sought. It would approve some cases for Supreme Court review and decide others itself. The controversial proposal died by reason of congressional inertia.[3]

In 1972 Congress created a Commission on Revision of the Federal Court Appellate System.[4] This Commission came to be known as the Hruska Commission after its distinguished Chairman, Senator Roman L. Hruska (R. Neb.) of the Senate Judiciary Committee. The Hruska Commission was composed of four members appointed by the President, four by the Chief Justice, four by the Senate, and four by the House of Representatives. Professor A. Leo Levin of the University of Pennsylvania Law School served, on leave, as Executive Director of the Commission.

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[3] Report of the Study Group on the Caseload of the Supreme Court, 57 F.R.D. 573 (1972). The proposal was described by one observer as having been reduced "to a residue of embers in legal journals." Leventhal, *A Modest Proposal for a Multi-Circuit Court of Appeals*, 24 Am. U.L. Rev. 881, 889-90 (Summer 1975).

[4] Pub. L. No. 92-849, 86 Stat. 807 (Oct. 13, 1972), as amended by Pub. L. No. 93-420, 88 Stat. 1153 (Sept. 19, 1974). 28 U.S.C. § 41 note (1988); 67 F.R.D. 195 (1975). McGranery, *Random Justice: Shorting the Circuits*, 37 Fed. B. News & J. 358 (No. 6, 1990).

The Hruska Commission held hearings and researched the exponential growth of litigation in the federal courts. It concluded that, among many other reforms, a National Court of Appeals was needed but that screening of the hundreds of petitions for certiorari should remain with the Supreme Court. Critics called the proposed new court a Junior Supreme Court. This proposal suffered the same terminal fate as the recommendation of the Freund Committee and the pleas of Chief Justice Burger for experimentation with a temporary (five year) Intercircuit Panel to resolve conflicts.

The broad studies of the Hruska Commission, however, confirmed that conflicts persisted, especially in the areas of federal tax and patent laws, because of the lack of a nationally uniform resolution of issues in those areas. This added to legal confusion about what the law was from circuit to circuit, increased the cost of litigation, and was wasteful and inefficient. Still another research group, the Advisory Council for Appellate Justice, chaired by Professor Maurice Rosenberg of the School of Law at Columbia University, reached conclusions not inconsistent with the Freund and Hruska bodies regarding the undesirability of circuit court conflicts which could not, or with increasing frequency did not, reach the Supreme Court.

Systemic change to improve the judicial machinery seemed to be going nowhere, notwithstanding the hundreds of thousands of dollars spent and years of thought and effort devoted to analyses of the problems and agreements by Members of Congress, judges, legal scholars, and knowledgeable spokesmen for industry that "something had to be done." Much patent litigation was being spawned by the many patents issued from applications then being filed with the United States Patent and Trademark Office at a rate exceeding 100,000 annually. Finally, with the appointment of Griffin B. Bell as Attorney General of the United States in the Carter Administration, the issues began to take on physical dimensions. Within the Department of Justice he established the Office for Improvements in the Administration of Justice. The President then named the highly regarded Professor Daniel J. Meador of the faculty of the University of Virginia School of Law as the Assistant Attorney General to head this office.

On July 21, 1978, Professor Meador circulated for public comment a tentative proposal to reconstruct the federal judicial pyramid. Based on prior studies, original research, and perceived need, it was proposed to merge the appellate functions of the seven-judge United States Court of Claims, the five-judge United States Court of Customs and Patent Appeals, plus three additional judges, into a new fifteen-judge circuit court of appeals. The new circuit would have the appellate jurisdiction of its two predecessor courts, plus exclusive appellate jurisdiction in civil tax, environmental, and patent cases, the latter to include suits between private parties and from the district courts. It would be unlike regional circuits, however, in that it would have nationwide jurisdiction of all appeals covering the subject matter assigned to it. Hopefully this would reduce the caseloads in the Supreme Court and in the regional circuit courts and bring uniformity in areas of law where consistency was perceived by Congress to be required in the national interest.

This proposal would not create another layer to the judicial pyramid, so it was less drastic than earlier proposals. Proposed tax and environmental jurisdiction was, however, highly controversial, and these areas were generally opposed by the bar. Opinion was divided in the various divisions of the Department of Justice. Strong support was received from the patent community, although not without some controversy. To consolidate support for the proposed legislation, both within and outside the government, tax and environmental cases were eventually eliminated from proposed legislation. On February 27, 1979, President Carter, in a special message to Congress, urged that the Congress establish the United States Court of Appeals for the Federal Circuit on the same tier as the existing courts of appeals.[5]

The Administration's bill, S. 677, was introduced "on request" in the Senate by Senator Edward M. Kennedy (D. Mass.), Chairman of the Senate Judiciary Committee, and by Senator Dennis W. DeConcini (D. Ariz.), Chairman of the Senate Judiciary Subcommittee for Improvements in Judicial Machinery. Senator Kennedy also introduced his own broader bill, S. 678. In the House of Representatives, H.R. 3806 was introduced by Congressman Peter W. Rodino, Jr. (D. N.J.), Chairman of the House Committee on the Judiciary. He then referred it to the Subcommittee on Courts, Civil Liberties and the Administration of Justice. Congressman Robert W. Kastenmeier (D. Wisc.) chaired the subcommittee.

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[5] 15 Weekly Compilation of Presidential Documents, No. 9, at 340-46 (week ending Mar. 2, 1979), Superintendent of Documents, Government Printing Office, Washington, D.C. 20402.

Hearings were held in the Senate and on October 30, 1979, S. 1477, "a clean bill," passed the Senate with bipartisan support. Unfortunately, the bill was encumbered by the addition of an extraneous and very controversial amendment opposed by leaders in the House of Representatives. The amendment by Senator Dale Bumpers (D. Ark.) would have reversed the judicial presumption in law that an agency rule or regulation was valid.

After hearings by the subcommittee in early 1980, H.R. 3806 passed the House by unanimous consent on September 15, 1980. S. 1477 was never considered in the House. It was not possible to work out an agreement to eliminate the extraneous amendment by the Senate, and the legislation died with the end of the 96th Congress.

The 1980 election began the "Reagan Revolution." Supporters of the court legislation did not know the intentions of the new Administration regarding the proposed law to create the new Federal Circuit and to institute miscellaneous reforms applicable to all federal courts. Democrats had lost the Presidency and Republicans captured the Senate. Concern soon declined, however, because the Judicial Conference of the United States, speaking for the entire judicial branch of the government, embraced the legislation. Support in the private sector for the patent jurisdiction intensified. Congress listened.[6]

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[6] It is not intended here to omit reference consciously to any individual who labored long and hard and whose efforts were indispensable in support of this key legislation. Long hours and great negotiation skills were necessary at both the Member and staff levels to pass the legislation. Certain persons, however, are remembered for their frequent consultations with the courts: Subcommittee Chairman Robert W. Kastenmeier and Minority Members Thomas F. Railsback and Robert McClory in the House of Representatives, and Senators Dennis W. DeConcini and Robert J. Dole in the upper House. On the Senate staff side there were Robert E. Feidler and Richard Velde. On the House staff Bruce Lehman, Michael Remington, and Thomas Mooney stand out. Frank P. Cihlar, representing the Department of Justice and the Carter Administration, performed indispensable services for the Senate, House, and the courts. In his definitive monograph, *The Court American Business Wanted and Got: The United States Court of Appeals for the Federal Circuit*, prepared for the National Chamber Foundation, an affiliate of the Chamber of Commerce of the United States, Mr. Cihlar pays tribute to individuals in the private sector, including Robert Benson of Allis-Chalmers Corporation, Eldon Luther of Combustion Engineering, Inc., Pauline Newman of FMC Corporation, Homer Blair of Itek Corporation, and Thomas Sager of E.I. du Pont de Nemours & Company.

Several new bills were introduced and additional hearings were held in the 97th Congress. In addition to jurisdiction of all appeals formerly heard by the Court of Customs and Patent Appeals and the Court of Claims, the proposed Court of Appeals for the Federal Circuit was finally given exclusive jurisdiction of appeals from the district courts in patent cases, the boards of contract appeals, and the Merit Systems Protection Board, along with review of certain final determinations of the Secretary of Commerce relating to imports, and appeals from decisions of the Secretary of Agriculture under the Plant Variety Protection Act.[7] Trial functions of the United States Court of Claims were split off for handling by a new sixteen-judge United States Claims Court created under article I of the Constitution with enhanced jurisdiction and with its decisions appealable to the Court of Appeals for the Federal Circuit.[8] Differences between H.R. 4482 and S. 1700, as passed, were resolved in March 1982, and a bill was submitted for the President's signature.[9]

On April 2, 1982, in a rose garden ceremony at the White House attended by judges of the new Federal Circuit,[10] the legislators most concerned with this legislation, and a few invited guests, President Reagan signed into law the Federal Courts Improvement Act of 1982.[11] The most important judicial improvement in almost 100 years had been launched in waters the new court must chart. How well the court has succeeded must ultimately be left to others.

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[7] Federal Circuit jurisdiction is detailed at 28 U.S.C. §§ 1292, 1295 (1988). *See generally* discussion by Adams, *The Court of Appeals for the Federal Circuit: More Than a National Patent Court*, 49 Mo. L. Rev. 43 (Winter 1984).

[8] 28 U.S.C. §§ 171-177, 791-799, 1491-1509, 1926, 2501-2522 (1988).

[9] *Legislative History—H.R. 4482 (S. 1700)*:
H.R. Rep. No. 312, 97th Cong., 1st Sess. (1981).
S. Rep. No. 275, 97th Cong., 1st Sess. (1981), *reprinted in* 1982 U.S. Code Cong. & Admin. News 11-50.

Congressional Record:
127 Cong. Rec. 27785-94, 27985 (Nov. 17-18, 1981);
H.R. 4482 considered and passed House.

127 Cong. Rec. 29849-88 (Dec. 8, 1981);
S. 1700 considered and passed Senate; proceedings vacated and H.R. 4482, amended, passed in lieu.

128 Cong. Rec. 3562 (Mar. 9, 1982); House concurred in Senate amendment, with an amendment.

128 Cong. Rec. 4949 (Mar. 22, 1982); Senate concurred in House amendment.

[10] The first court of the United States Court of Appeals for the Federal Circuit was composed of Chief Judge Howard T. Markey and Circuit Judges Daniel M. Friedman; Giles S. Rich; Philip Nichols, Jr.; Oscar H. Davis; Phillip B. Baldwin; Shiro Kashiwa; Marion T. Bennett; Jack R. Miller; Edward S. Smith; and Helen W. Nies; plus four senior judges, Don

Final reference must be made, however, to questions posed at the beginning of this review of the origins of the Federal Circuit. How and Why? With the benefit of hindsight, it can now be understood that this change in the judiciary, while supported by analysis of the statistics which seemed to mandate such a change, would have met the terminal fate of earlier judicial reform proposals had it not been for a greater force which captured the attention and support of the White House and the Congress. While the legislation enjoyed bipartisan support almost from the beginning, the engine that pulled the train over the legislative mountain was fueled by political and industrial necessity.

President Carter's Administration, 1977-1981, had been beset by many difficulties in the national economy, some of which still exist. The budget deficit continued out of control. Unemployment was high. We were becoming the world's greatest debtor nation at a time when lesser debtors in the world were asking us for grants and loans. Exports were declining while imports increased. Industry was retrenching. Industrial innovation was declining. Economic growth was stagnant. There was double-digit inflation. The President called it "malaise," wisely initiated a Domestic Policy Review, and sought expert advice. His advisors told him that the most important area in which the nation still surpassed all others was industrial innovation, but that it needed encouragement. This was not touted as a remedy for all ills but was believed to be one key element on the road to economic recovery and stability.

Earlier studies, previously mentioned, had shown that technological innovation was being impeded by the lack of uniformity in applica-

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N. Laramore; James Lindsay Almond, Jr.; Wilson Cowen; and Byron G. Skelton. There was one vacancy on the active bench due to the untimely death of Court of Claims Judge Robert Lowe Kunzig shortly before the signing of the legislation into law.

[11] Pub. L. No. 97-164, 96 Stat. 25 (1982), effective Oct. 1, 1982.

tion of patent laws. Article I, section 8, clause 8, of the Constitution gave Congress the authority "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Congress eventually raised the protective period for patented inventions from fourteen to seventeen years during which time an inventor could enjoy a return on his invention through the exclusive rights granted and, hopefully, recoup his capital investment. This indeed proved a powerful incentive to technological innovation and industrial growth.

This incentive is based on a characteristic of human nature and was well known to historians and to the learned delegates to the American Constitutional Convention in Philadelphia in 1787. They recognized, but did not discover, this characteristic as valuable to promotion of "Science and useful Arts." Judge Giles S. Rich has traced the use of this incentive as far back as the sixth century B.C. in Europe and has followed it down through the Middle Ages to England and thence to the English colonies in America, with useful examples of how protection of an invention for a limited time has helped elevate civilization.[12]

The first Congress under the Constitution passed H.R. 41, the Act of April 10, 1790. This law in effect permitted grant of a patent, for an invention believed to be new, upon application to a board that consisted of the Secretary of State, the Secretary of War, and the Attorney General of the United States. If two of the three agreed that the device was new and "sufficiently useful and important," a patent would be issued for a protected period of fourteen years. Secretary of State Thomas Jefferson personally examined all applications for patents for the first three years. The first patent was issued on July 31, 1790. President Washington and Attorney General Edmond Randolph signed it. This was not a very costly procedure. The law set a fee of fifty cents for filing the application, ten cents per page for specifications, and one dollar for "the Great Seal." There was a delivery charge of twenty cents. If an infringement was discovered, the patentee was entitled to "such damages as shall be assessed by a jury."

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[12] Address by Giles S. Rich, Circuit Judge, United States Court of Appeals for the Federal Circuit, May 9, 1990, before the Foundation for a Creative America, Bicentennial Celebration, United States Patent and Copyright Laws.

It is clear that Congress was aware that a patent might suffer infringement but could not foresee how many pirates would be abroad in the land who would, with little or no hesitation, steal inventions by copying and selling them as their own. Now, these pirates are both individuals and corporations, both home-grown and alien. Since protection of inventions was secured to inventors, that right is enforced through the judicial process. This proved to be not so simple when the cost to a litigant in the average patent infringement case for legal fees alone approached half a million dollars in the 1980s. It was easier to grant a would-be infringer a license to use the patent in exchange for royalty payments but this has not always been to the inventor's interest monetarily. Sometimes it seemed to inventors that to obtain a patent was to buy a lawsuit.

Still another factor entered the picture to diminish the patent system further as an incentive to industrial innovation. Some of the regional circuit courts, expressing strong feelings about the dangers of monopoly and having a low regard for the expertise of the Patent Office, tended not to give any deference to the administrative examination process and invalidated many patents. It thus became important to make sure, where possible, that a patent suit be brought in the least inhospitable forum. This became a high-risk game of forum-shopping. If an inventor could not be sure that his patent rights would be respected in the marketplace, or enforced in the courts, he was deprived of important incentives to research and development. The risk factor in technological development was too great. This uncertainty plus the high cost of marketing something new contributed to the decline in innovation experienced in the late 1970s, especially for research institutions and technology-based industry.

In 1977 the Department of Justice Committee on Revision of the Federal Judicial System summed up the general forum-shopping situation as follows:

> "This is not a crisis for the courts alone. It is a crisis for litigants who seek justice, for claims of human rights, for the rule of law, and it is therefore a crisis for the Nation."[13]

So as to bring consistency into this field of law and to restore the incentive for technological innovation, the proposal for a new court with exclusive jurisdiction over appeals in patent cases, although pressed by patent-dependent industry and much of the patent bar, was in itself so innovative that it was received with guarded optimism and apprehension in the legal community. There were serious objections by those who thought it would be a specialized court with specialized judges all afflicted with tunnel vision. Specialized courts outside the regular judicial system were suspect. Further, some lawyers preferred to forum shop and did not like the proposal for that reason. A minority of the judges on the United States Court of Claims initially did not think they should be brought into this controversy. The court had performed well since 1855. They thought that Court of Claims jurisdiction of patent suits against the government should be given to the Court of Customs and Patent Appeals (CCPA), along with such other patent, copyright, trademark, and international trade review authority as Congress wished to bestow upon the CCPA in the way of exclusive jurisdiction. This view was not communicated to Congress. So great was the momentum by the Administration, Congress, and industry to strike decisively in the other direction that it probably would not have made any difference. Further, this idea would have required additional CCPA judges. Sound legislative and political strategy required that the additional judge-power should be furnished by judges already in office.

There were extensive hearings by the United States Senate and House of Representatives judiciary subcommittees in the 95th, 96th, and 97th Congresses. Multiple bills all to the same general purpose were introduced in both Houses of Congress.[14] All hearings were attended by Judges Edward S. Smith and Marion T. Bennett, upon designation by the Court of Claims. Chief Judge Howard T. Markey of the CCPA and Chief Judge Daniel M. Friedman of the Court of Claims testified as to the technical aspects of the bills. Numerous witnesses expressed the views of industry, which had solidly urged that this new court be formed. The strongest objection to creating the Federal Circuit—specialization—was resolved by the broad range of jurisdiction of the proposed new court. In rejecting the concept of specialization, similar language appears in committee reports and from bill to bill in both Houses of Congress. The following are typical examples:

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[13] H.R. Rep. No. 312, 97th Cong., 1st Sess. 17 (1981) (quoting Report of the Department of Justice Committee on Revision of the Federal Judicial System 1 (1977)).

[14] There were many bills and hearings and so many changes in their language that space does not allow them to be identified here. This has been well covered elsewhere. *See supra* note 6, the Cihlar monograph, and a monograph by two former clerks of the United States Court of Claims, J. Gary McDavid and Steven C. Lambert, Washington, D.C. In 1982 they wrote *The Creation of the United States Court of Appeals for the Federal Circuit—An Overview; see*

> By combining the jurisdiction of the two existing courts along with certain limited grants of new jurisdiction, the bill creates a new intermediate appellate court markedly less specialized than either of its predecessors and provides the judges of the new court with a breadth of jurisdiction that rivals in its variety that of the regional courts of appeals. The proposed new court is not a "specialized court." Its jurisdiction is not limited to one type of case, or even to two or three types of cases. Rather, it has a varied docket spanning a broad range of legal issues and types of cases. It will handle all patent appeals and some agency appeals, as well as all other matters that are now considered by the CCPA or the Court of Claims. The Court of Claims decides cases involving federal contracts, civil tax issues if the government is the defendant, Indian claims, military and civilian pay disputes, patents, inverse condemnation, and various other matters. [28 U.S.C. sections 1491-1507.] The CCPA decides patent and customs cases from several sources, and those cases often include allegations of defenses of "misuse, fraud, inequitable conduct, violation of the antitrust laws, breach of trade secret agreements, unfair competition, and such common law claims as unjust enrichment." [Footnote omitted.][15]

A Senate report spoke in a similar vein:

> The Court of Appeals for the Federal Circuit will not be a "specialized court," as that term is normally used. The court's jurisdiction will not be

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also Congress and The Courts, A Legislative History, 1978-1984 by Professor Bernard D. Reams, Jr., published by Wm. S. Hein & Co., Buffalo, N.Y. (1985).

The Federal Circuit library has a complete set of all bills, reports, and hearings pertaining to this legislation, compiled by David J. Lockwood, Assistant Librarian. A picture of the President signing the bill creating the United States Court of Appeals for the Federal Circuit, and one of the pens he used to do so, are in a library display case at the Court of Appeals for the Federal Circuit, the National Courts Building, Washington, D.C.

[15] H.R. Rep. No. 312, 97th Cong., 1st Sess. 19 (1981) (on H.R. 4482); H.R. Rep. No. 1300, 96th Cong., 2d Sess. 17 (1980) (on H.R. 3806); *see also supra* note 7.

> limited to one type of case, or even to two or three types of cases. Rather, it will have a varied docket spanning a broad range of legal issues and types of cases. It will handle all patent appeals, plus government claims cases and all other appellate matters that are now considered by the CCPA or the Court of Claims—cases which contain a wide variety of issues.
>
> This rich docket assures that the work of the proposed court will be broad and diverse and not narrowly specialized. The judges will have no lack of exposure to a broad variety of legal problems. Moreover, the subject matter of the new court will be sufficiently mixed to prevent any special interest from dominating it.[16]

Congress observed that the new circuit court of appeals would not add to the number of federal courts because the two older courts would be abolished. The docket of the new circuit would be composed of unusually complex and time-consuming litigation, but the Federal Circuit, at little or no additional expense to the taxpayers, would make maximum use of facilities and experienced personnel already in place and already a part of the federal judicial system. It was also congressional consensus that the new court would provide a ready forum for later legislation, expanding its jurisdiction as need arose rather than creating specialized courts to handle then-unforeseen problems.[17] This foresight proved to be sound when Congress added to the Federal Circuit jurisdiction appeals from a newly created United States Court of Veterans Appeals,[18] the vaccination liability appeals from the United States Claims Court,[19] appeals from the

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[16] S. Rep. No. 304, 96th Cong., 1st Sess. 13 (1979) (on S. 1477); S. Rep. No. 275, 97th Cong., 1st Sess. 6 (1981) (on S. 1700). Chief Judge Markey calculated that the Federal Circuit has jurisdiction to review 112 tribunals and over 1,000 decision makers at the trial level. For background, *see also* S. Plager, *The United States Courts of Appeals, the Federal Circuit, and the Non-Regional Subject Matter Concept: Reflections on the Search for a Model*, 39 Am. U.L. Rev. 853 (Summer 1990).

[17] Such as the Temporary Emergency Court of Appeals and the Special Court under the Regional Rail Reorganization Act of 1973.

[18] Veterans' Judicial Review Act, Pub. L. No. 100-687, Div. A, title III, § 301(a), 102 Stat. 4105, 4120 (1988) (codified at 38 U.S.C. § 4092).

[19] 42 U.S.C. § 300aa-12(e) (1988), as amended by the Vaccine and Immunization Amendments of 1990, Pub. L. No. 101-502, 104 Stat. 1285.

General Accounting Office Personnel Appeals Board,[20] and appeals from judgments against the Trust Territory of the Pacific Islands.[21]

Finally, to overcome concerns that the new circuit, headquartered in the National Courts Building, Washington, D.C., would inconvenience some litigants, Congress authorized the Federal Circuit to hold sessions elsewhere in the United States. This it has dutifully done when sufficient ready cases justified the expense of travel. Congress also authorized the court to sit in panels of three or more judges. These panels do not specialize. Panel membership rotates and each panel has a cross-section of cases assigned to it. The Federal Rules of Appellate Procedure are applicable in the court's proceedings but it has supplemented these rules with its own where necessary to accommodate the peculiarities inherent in nationwide jurisdiction of subject matter assigned to the court.

The judges of the United States Court of Appeals for the Federal Circuit assumed their responsibilities in a historic Inaugural Session on October 1, 1982, after being administered the Judicial Oath of Office by the Chief Justice of the United States. The court has since made every effort to justify the confidence of its founders, supporters, and the bar. The court's motto and guide for the administration of justice is: "The best quality decisions, at the least cost, in the shortest time."

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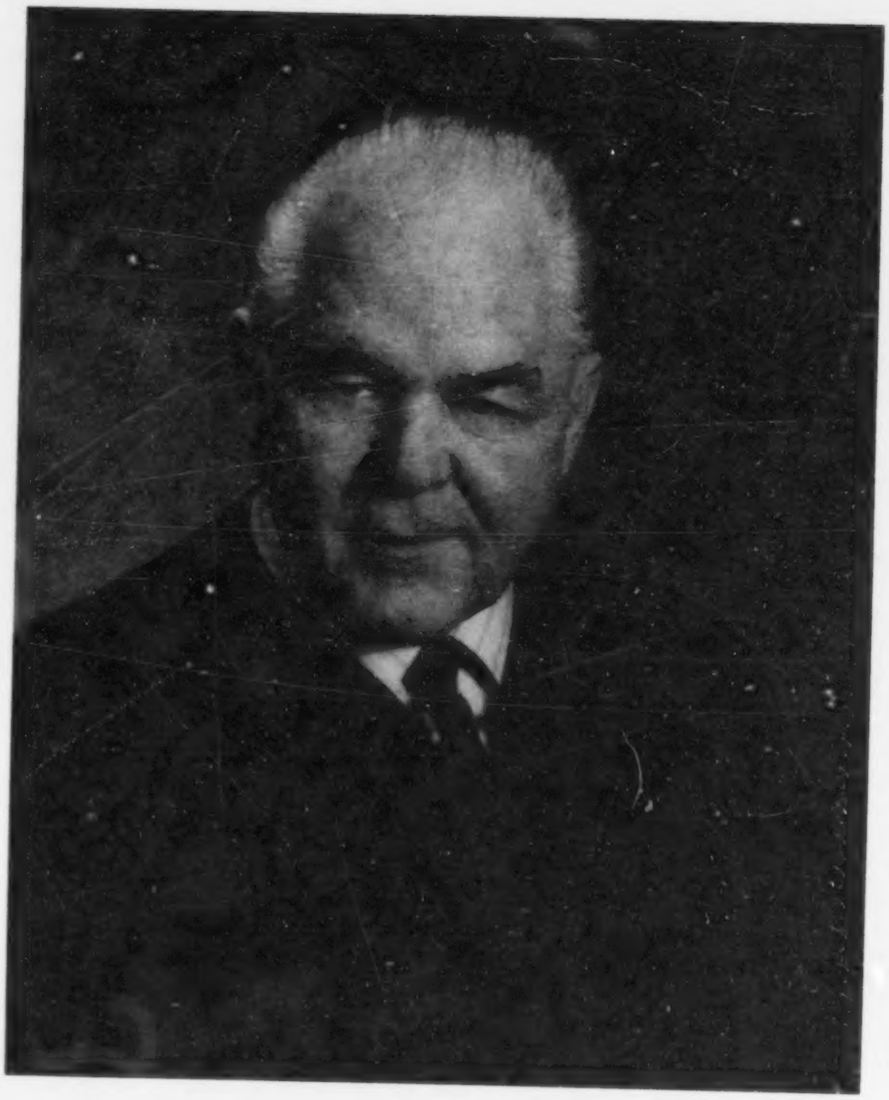
[20] 31 U.S.C.A. § 755(a) (West Supp. 1990).

[21] Approval of the Compact of Free Association with the Government of Palau, Pub. L. No. 99-658, 100 Stat. 3672, 3686 (1986), *reprinted in* 48 U.S.C. § 1681, at 164, 171 (1988); and Approval of the Compact of Free Association with the Federated States of Micronesia and Republics of the Marshall Islands. Pub. L. No. 99-239, 99 Stat. 1770, 1811 (1986), as amended, *reprinted in* 48 U.S.C. § 1681, at 178, 197 (1988).

PART II

THE JUDGES AND THEIR STAFFS



Howard Thomas Markey

CHIEF JUDGE HOWARD THOMAS MARKEY

First Chief Judge

(1982-1990)

Howard T. Markey was born on November 10, 1920, in Chicago, Illinois, the son of Thomas Joseph and Vera Marie (Dryden) Markey. His father was a railroad telegrapher and his mother wrote for a newspaper as a vaudeville critic. On March 17, 1942, he married Elizabeth Pelletier of Chicago. Their children: Jeffrey Howard, a lieutenant colonel in the U.S. Air Force; Christopher Gerard, social worker and teacher; Thomas (deceased); and Jennifer Catherine.

Judge Markey attended primary schools in Maywood, Illinois, and St. Philip High School in Chicago. Thereafter, he attended the University of Arizona and Loyola University in Chicago, receiving his law degree from the latter in 1949, cum laude; was editor of the law review; did graduate work in law at John Marshall Law School, Chicago, receiving a master of patent law degree in 1950; and was in private practice in Chicago during the period 1949-1972, specializing in patent, trademark, and related law.

As with many young men of the time, his education was interrupted by World War II, in which he served from 1941 to 1946. His military duty was in various capacities, including flying cadet, flight instructor, engineering officer, and test pilot, and he was one of the first pilots of American jet aircraft (1944-1946). He was recalled to active duty during the Korean War during which he was deputy commander of the 315th Air Division in Japan and Korea with the rank of lieutenant colonel. Thereafter, he was commander of an Air National Guard Wing (1954-1970). A brigadier general at the age of thirty-eight, in 1958 he commanded the Illinois Air National Guard until 1970. For the next six years he was deputy commander for the Reserves, Tactical Air Command. He achieved the rank of major general in 1973, and is now retired. For his service he received the Distinguished Service Medal, Legion of Merit, Distinguished Flying Cross, Soldier's Medal, Purple Heart, Air Medal, Bronze Star, Military Merit ULCHI (Government of Korea), and nine service medals. In 1974 he received the Man of the Year Award from the Air Force Association.

On May 3, 1972, President Nixon nominated Howard T. Markey to be the Chief Judge of the U.S. Court of Customs and Patent Appeals

(CCPA). The United States Senate confirmed the nomination on June 21, his commission was issued the same day, and he entered on duty June 26, 1972. His formal investiture was on July 21, 1972, in the CCPA courtroom, presided over by Chief Justice Warren E. Burger.

On October 1, 1982, the Federal Courts Improvement Act of 1982 created the U.S. Court of Appeals for the Federal Circuit, combining therein the appellate functions of the CCPA and the U.S. Court of Claims. By the terms of that Act, Howard T. Markey became Chief Judge of the new court.

In civilian life Judge Markey has been honored by the award to him of the George Washington Honor Medal by the Freedoms Foundation, Valley Forge (1964); the Citation of Merit, John Marshall Law School (1972); Medal of Excellence, Loyola University School of Law (1973); Old Master Certificate, Purdue University (1970); the Jefferson Medal of the New Jersey Patent Law Association (1977); the American Judicature Society's Herbert Harley Award (1985); the Thomas More Award (1986); and an honorary doctor of science degree by the Worchester Polytechnic Institute (1982). In the years 1982-1990, he received seven honorary doctor of law degrees, respectively, from New York University Law School, Western State University College of Law, the Dickinson School of Law, Loyola University School of Law, St. John's University Law School, Franklin Pierce Law Center, and the William Mitchell School of Law.

Ever active in legal, military, and civic affairs, he has served as chairman or vice chairman for the Federal Judiciary in the annual campaign of the United Way for the National Capital Area (1973-1987), on the board of the Supreme Court Historical Society, chairman of the American Inns of Court Foundation, national president and chairman of the board of the Air Force Association, member of the American and Federal Bar Associations, on the World Association of Judges, was founder of the Thomas More Society of America, and is a fellow of the American Law Institute and the American Judicature Society. He has lectured on intellectual property law at Loyola University, on appellate advocacy at George Washington University, and on judicial ethics and technology and the law at the Federal Judicial Center.

As the senior member of the Judicial Conference of the United States, having served thereon from 1972 to 1990, he has been a member of its Committee on Court Administration, its Board for Certification of Circuit Executives, chairman of the Ethics Advisory Committee on Codes of Conduct, and a member of the Conference Executive Committee. He was also chairman of the Conference Committee on the Bicentennial of the Constitution (1985-1988), and chairman of the International Appellate Judges Conferences (1987-1988).

Ever in demand as a public speaker, Judge Markey has also written extensively on judicial matters, having been published in fifty-seven different law reviews and other like publications of interest to lawyers and judges. A principal contribution to the law was in his administration of the two United States appellate courts of which he was Chief Judge. He reduced the interval between the filing and final decision of cases from three years to seven months and did so on a self-reduced budget without hindering the court's work. He is also the first active judge to have sat with every federal circuit court of appeals. He has sat in over 1,400 cases (268 criminal), has written opinions covering over 250 cases for the regional circuit courts in every field of law, in addition to 5,000 cases and 800 opinions for the U.S. Court of Customs and Patent Appeals and the U.S. Court of Appeals for the Federal Circuit.

Judge Markey served as Chief Judge of the Federal Circuit for eight years, voluntarily vacating that position on June 27, 1990, but remaining as an active Circuit Judge. On April 30, 1991, he left the bench to become Dean of the John Marshall Law School in Chicago.

On September 26, 1990, Judge Markey was honored at a testimonial dinner in Washington, D.C., attended by several hundred lawyers and friends. Tributes were paid to Judge Markey by over a dozen speakers, including retired Chief Justice Warren E. Burger. The latter remarked that, had he been empowered to make the appointments, Judge Markey would have been a Justice on the Supreme Court.

At this testimonial dinner, the Federal Circuit Bar Association and Judge Markey's law clerks presented to the court a splendid oil portrait of the Chief Judge, and it hangs near the main courtroom where he presided as Chief Judge with great distinction.

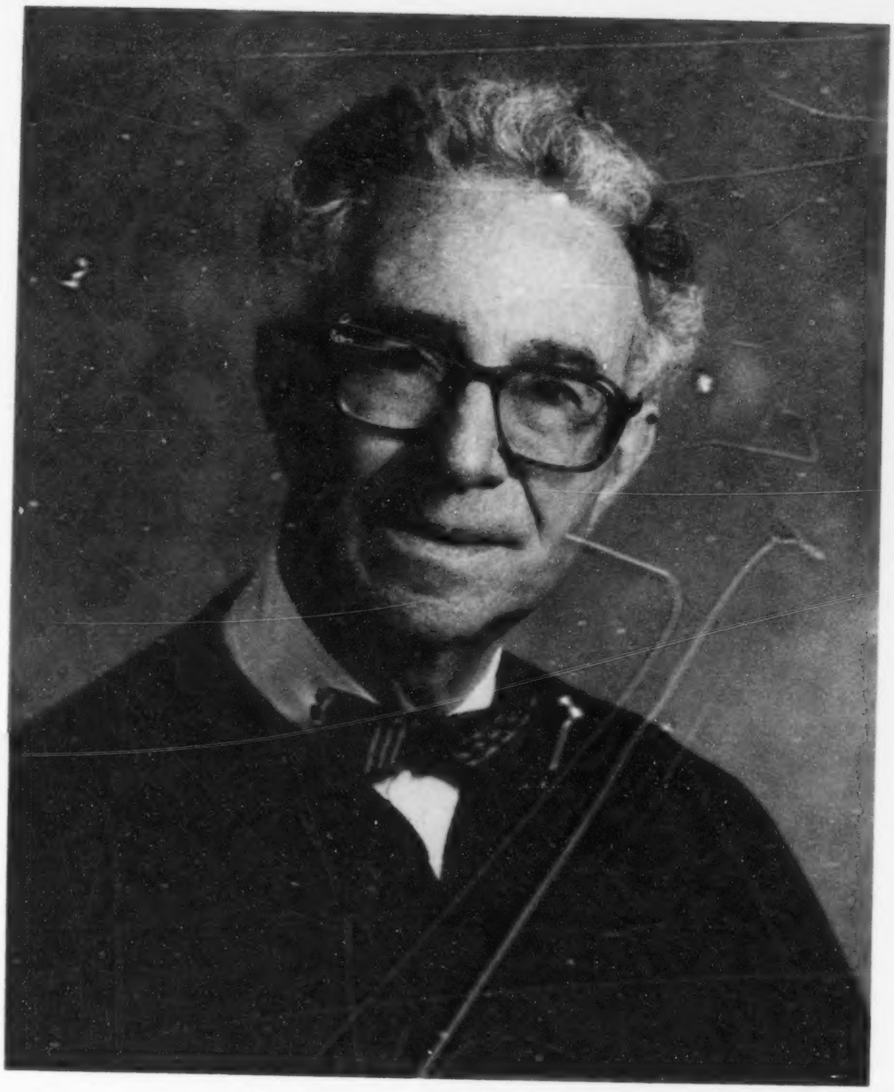
STAFF OF CHIEF JUDGE MARKEY

SECRETARIES:

Linda L. Jamison	Oct. 1, 1982—Feb. 25, 1988
Patricia L. Massey	Oct. 1, 1982—May 19, 1989
Mary Catherine O'Connor	Oct. 1, 1982—Mar. 11, 1983
Brenda Mueller	June 5, 1989—June 27, 1990
Joyce D. Sonntag	Apr. 18, 1983—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Medlock, Nina L.	1982-83	Banner, Birch, McKie, Beckett One Thomas Circle Washington, DC 20005
Pencoske, Edward L.	1982-84	Kirkpatrick & Lockhart 1500 Oliver Bldg. Pittsburgh, PA 15222
Collins, Stephanie	1983-85	4849 Connecticut Ave., NW. #115E Washington, DC 20008
Alison, John R.	1984-86	Howrey & Simon 1730 Penn. Ave., NW. Washington, DC 20006
Re, Joseph R.	1985-87	Knobbe, Martens, Olson & Bear 620 Newport Center Dr. Newport Beach, CA 92660
Woods, Fronda C.	1986-88	722 - 13th Ave., SE., #104 Olympia, WA 98501
Fish, Edmund J.	1987-89	Weil, Gotshal & Manges 1615 L St., NW. Washington, DC 20036

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Abate, Mark J.	1988-90	Morgan & Finnegan 345 Park Ave. New York, NY 10054
Mosley, Molly	1989-90	Fish & Richardson 1 Financial Center Boston, MA 02111-2658
Carmichael, James T.	1990-present	



Daniel Mortimer Friedman

JUDGE DANIEL MORTIMER FRIEDMAN

Daniel Mortimer Friedman was born on February 8, 1916, in New York City, the only child of Henry M. (1878-1961), an insurance broker, and Julia (Freedman) Friedman (1882-1952), a nurse. He is a descendant of English and Russian ancestors, his paternal great-grandfather having come to this country from England, and his maternal great-grandparents both having come from Russia.

Daniel M. Friedman was educated in New York City, attending the Ethical Culture School beginning in 1922. In 1933 he received his high school diploma from its Fieldston School. In 1933 he entered Columbia College where he majored in government and history, received scholastic honors in his studies, was assistant managing editor of the Columbia Daily Spectator, and graduated with an A.B. degree in 1937. In 1937 he entered Columbia Law School where he was an editor of the Columbia Law Review and a Kent Scholar. He received his LL.B. degree from Columbia in 1940, was first in his class in his last year, and was admitted to the New York bar in 1941.

Judge Friedman's career is that of a career civil servant. All but two of his years since graduation from law school have been in the employment of the United States Government. The two years he was in private practice, 1940-1942, he was with the law firm of Newman & Biso of New York City and with I. N. Thurman, Esq., a single practitioner, also of New York City. In 1942 he joined the legal staff of the Public Utilities Division of the Securities and Exchange Commission in Philadelphia. From September 1942 to February 1946 he was in the Quartermaster Corps, U.S. Army, saw service in Europe, and was honorably discharged as a master sergeant. Upon completion of his military service he returned to the Securities and Exchange Commission where he engaged in corporate and securities law matters, assisted in the preparation of major commission opinions, and acted as legal assistant to a commissioner.

In 1951 he joined the Antitrust Division of the United States Department of Justice, Washington, D.C., where he performed appellate work in antitrust and administrative law, becoming Assistant Chief of the Appellate Section in 1954. In 1959 he joined the Office of the Solicitor General, serving as Assistant to the Solicitor General from 1959 to 1962, as Second Assistant from 1962 to 1968, and as First Assistant, later First Deputy Solicitor General, from 1968 to 1978. In the latter position he was senior lawyer, next to the Solicitor General, and was responsible for general administration of the office. In 1977 he was Acting Solicitor General. Accustomed to demanding and arduous work, he argued eighty cases before the Supreme Court and was recognized for his outstanding skill as a lawyer. He worked on and was responsible for Supreme Court briefs in hundreds of cases in addition to the many he argued. His experience in the law has been almost entirely at the appellate level.

In 1969 Daniel M. Friedman received the highest award of his Department, the Exceptional Service Award of the Attorney General. In 1976 he received the Justice Tom C. Clark Award presented by the District of Columbia Chapter of the Federal Bar Association, and in the same year received the National Civil Service League Career Service Award presented annually to ten outstanding career civil servants throughout the Federal Government.

On January 16, 1955, Daniel M. Friedman was married to Leah L. Lipson (1912-1969). On October 18, 1975, he married Elizabeth M. Ellis (b. September 5, 1922), who received her A.B. degree from the University of Chicago in 1942, her M.A. from George Washington University, and her Ph.D. in psychology from the University of Maryland. She is presently a clinical psychologist in private practice. There are no children of these two marriages.

On March 22, 1978, President Carter nominated Daniel M. Friedman to be the eleventh Chief Judge of the United States Court of Claims. He was the fourth Chief Judge to be appointed who was not previously an Associate Judge of the Court of Claims. The Senate confirmed his nomination on May 17, 1978, and he took his oath of office, which was administered by the Chief Justice of the United States, Warren E. Burger, on May 24, 1978. The investiture of the new Chief Judge was in the main courtroom of the courthouse in Washington, D.C., in the presence of his family, the judges, officials and employees of the court, and his friends from the Department of Justice and the bar.

While Chief Judge of the United States Court of Claims, Judge Friedman was a member of the Judicial Conference of the United States from 1978 to 1982. Upon the establishment of the United States Court of Appeals for the Federal Circuit on October 1, 1982, Judge Friedman became an active Circuit Judge of that court. He is a member of the American Law Institute and the American and Federal

Bar Associations. From 1983 to 1987 he was a member of the board of directors of the Federal Judicial Center. By designation of the Chief Justice, he has frequently sat on the Courts of Appeals for the Second and District of Columbia Circuits. He has also sat with the Eighth Circuit.

Since 1983 Judge Friedman has been a senior lecturer in law at Duke Law School, teaching appellate advocacy; taught appellate advocacy in 1987 as an adjunct professor at the Washington College of Law of American University; and is the author of several law review articles. His principal interest is legal work, but he also finds some time for stamp collecting and photography as hobbies. He is an Ethical Culturist by religion, a political Independent, and a member of the Washington Ethical Society, the American Philatelic Society, the United States Philatelic Classics Society, and the Cosmos Club.

In 1988, Judge Friedman's law clerks presented a portrait of the judge to the court, and it now hangs in the courthouse.

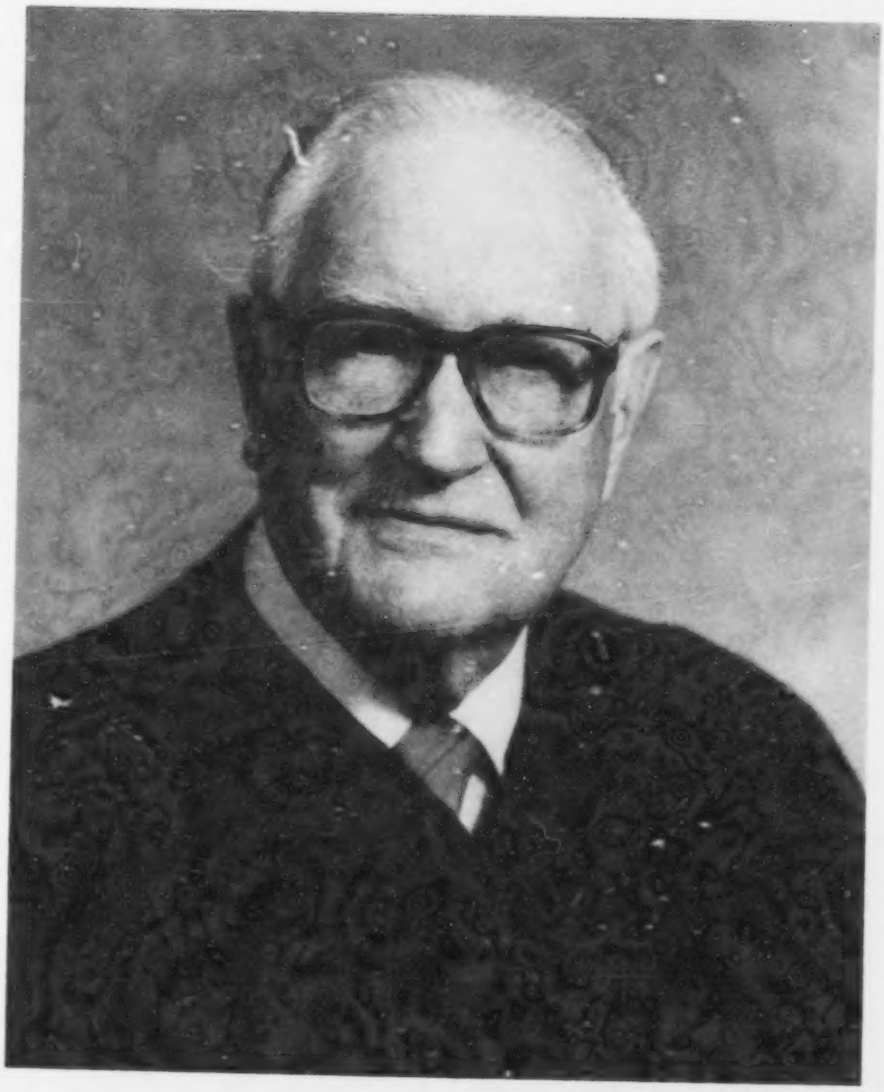
Judge Friedman assumed the status of Senior Circuit Judge on November 1, 1989, and remains active in the work of the United States Court of Appeals for the Federal Circuit. He also continues to sit on the bench of other courts of appeals.

STAFF OF JUDGE FRIEDMAN

SECRETARY: Elaine B. Heffley . . . . . Oct. 1, 1982—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Bialos, Jeffrey P.	1982-83	Weil, Gotshal & Manges 1615 L St., NW. Washington, DC 20036
Layton, James R.	1982-83	Vinson & Elkins 1455 Penn. Ave., NW. Washington, DC 20004
Kelly, Michael B.	1983-84	Professor, Law School University of San Diego Alcala Park San Diego, CA 92110
Moy, R. Carl	1983-85	Merchant, Gould, Smith, Edell, Welter & Schmidt 3100 Norwest Center 90 South 7th St. Minneapolis, MN 55402
Canon, Karen J.	1984-85	Faegre & Benson 2200 Norwest Center 90 South 7th St. Minneapolis, MN 55402
Schuman, Mark D.	1985-86	Merchant, Gould, Smith, Edell, Welter & Schmidt 3100 Norwest Center 90 South 7th St. Minneapolis, MN 55402
Artz, Cherie B.	1985-86	Schnader, Harrison, Segal & Lewis 1111 - 19th St., NW. Washington, DC 20036

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Long, Lisa M.	1986-87	Fried, Frank, Harris, Shriver & Jacobson 1001 Penn. Ave., NW. Washington, DC 20004
Fisher, Montgomery K.	1986-87	Skadden, Arps, Slate, Meagher & Flom 1440 New York Ave., NW. Washington, DC 20005
Twitchell, Karen	1987-88	Fried, Frank, Harris, Shriver & Jacobson 1001 Penn. Ave., NW. Washington, DC 20004
Shetka, Debra	1987-88	Irell & Manella 545 Middlefield Rd. Menlo Park, CA 94025
Strobos, Jurriaan	1988-89	Judge Raymond C. Clevenger, III United States Court of Appeals for the Federal Circuit 717 Madison Pl., NW. Washington, DC 20439
Estreicher, Herbert	1988-89	Covington & Burling 1201 Penn. Ave., NW. Washington, DC 20044
Macedo, Charles R.	1989-90	Cravath, Swaine & Moore Worldwide Plaza 825 - 8th Ave. New York, NY
Simkin, Brian M.	1990-present	



Giles Sutherland Rich

JUDGE GILES SUTHERLAND RICH

Giles S. Rich was born in Rochester, New York, on May 30, 1904, the son of Giles Willard Rich, a patent lawyer, and Sarah Thompson (Sutherland) Rich. He was educated in private and public schools in Rochester through the first year of high school, after which the family moved to New York City. He finished high school in the Horace Mann School for Boys in 1922, going on to Harvard College where, in 1926, he received his S.B. degree in history, government and economics. He obtained an LL.B. from the Columbia University School of Law in 1929 and was admitted to the New York bar.

Rich commenced the practice of patent and trademark law in his father's firm of Williams, Rich & Morse in the fall of 1929, almost simultaneously with the great stock market crash of that year. On January 10, 1931, he married Gertrude Verity Braun, the daughter of a Barnard College professor who was head of the German Department. She later became a professor of philosophy in the same college. They had one daughter, Verity Sutherland, born in 1940, who is now Dr. Verity S. Grinnell, an M.D. in the field of neuro-radiology in Sydney, Australia, where she resides with her second husband, Dr. John M. Hallinan. Gertrude Rich died in 1953 and Giles Rich married Helen Gill Field of Milton, Massachusetts, who was, at the time, a medical librarian with the National Institute of Mental Health in Bethesda, Maryland.

Commencing in 1942 and continuing until he left New York in 1956, Rich was a lecturer on patent law at Columbia University in its School of General Studies. During one semester he also gave a course on patent law at the New York Law School.

In the early 1940s under the stimulus of a prize competition, Rich wrote a monograph on *The Relation Between Patent Practices and the Antimonopoly Laws*. He did not win the prize, but published the paper as a series of five articles in the Journal of the Patent Office Society (24 JPOS 85, 159, 241, 328, 422). A topic principally dealt with was contributory infringement and misuse. He was at the same time active in the work of the New York Patent Law Association, and when it undertook, after the virtual destruction of the doctrine of contributory infringement by the Supreme Court in the *Mercoid cases* in 1944, to introduce and foster legislation to correct the situation, Rich became deeply involved with it. As NYPLA vice president in 1948 and 1949 it was his responsibility to explain this legislation to congressional committees. As a result of bills which the NYPLA wrote and had introduced, and other bills in the patent law field, the House Patents Subcommittee, which was also the committee on the codification of the law, decided to revise and codify the patent statutes, title 35 of the *United States Code,* and proceeded to do so with the aid of the patent bar and Mr. P. J. Federico, an Examiner-in-Chief of the Patent Office who was loaned to the committee in an advisory capacity. The patent bar organized what was known as the Coordinating Committee—virtually the National Council of Patent Law Associations under another name—under the chairmanship of Henry Ashton of New York, then president of the American Patent Law Association. Ashton appointed Rich to be one of the two-man drafting committee to work with him and Federico in preparing the bills which became, eventually, the Patent Act of 1952. It was this legislative work over a period of some four years that brought Rich to the attention of the patent bar which put him forward as a candidate for nomination to the U.S. Court of Customs and Patent Appeals (CCPA) when the next vacancy came along.

Meanwhile, back in New York, Rich became president of the NYPLA for the year 1950-1951. About that time he and his partner, Howard M. Morse, combined their firm with the survivors of another old firm to create Churchill, Rich, Weymouth & Engel wherein he was practicing when nominated to the court.

President Eisenhower nominated Giles Rich to be an Associate Judge of the CCPA on May 17, 1956; he was confirmed on July 19 and assumed the duties of the office on July 20, 1956. During his twenty-six years on that court he presided at hearings as Acting Chief Judge, due to the absence of a Chief Judge, 160 times. With the merger of the CCPA and the U.S. Court of Claims on October 1, 1982, Rich became a Circuit Judge of the newly created Court of Appeals for the Federal Circuit. As of this writing, he is still an active judge of that court.

Judge Rich is the author of further papers on patent law as follows: *Infringement Under § 271 of the Patent Act of 1952*, 21 Geo. Wash. L. Rev. 521, 35 JPOS 476; *Principles of Patentability*, 28 Geo. Wash. L. Rev. 393, 42 JPOS 75; *Congressional Intent—Or, Who Wrote the Patent Act of 1952?*, Patent Procurement and Exploitation (BNA 1963); *The Vague Concept of "Invention" As Replaced By § 103 of the 1952 Patent*

Act, IDEA, Conf. No. 1964, 136, Calvert Encyclopedia of Patent Practice 592, Nurturing New Ideas, L. Harris 349; *Laying the Ghost of the "Invention" Requirement*, 1 APLA Q.J. 26; *Change*, 2 APLA Q.J. 213; *How Systematic Is the Patent System?*, APLA Bull., Oct.-Nov. 1975, 700, 57 JPOS 696; *Escaping the Tyranny of Words—Is Evolution in Legal Thinking Impossible?*, APLA Bull., May-June 1978. Several of the above are republished in book form in J. Witherspoon (Ed.), *Nonobviousness—The Ultimate Condition of Patentability* (BNA 1980), together with *Why and How Section 103 Came To Be*, 1:201. He also wrote *A Brief History of the Court of Customs and Patent Appeals* (1980).

Judge Rich was the first lecturer on patent law to newly appointed federal judges, Denver, 1965, and again at the Federal Judicial Center Seminars for Newly Appointed Judges, 1970, 1971, for which he prepared the *Judges' Primer: Patent and Copyright Law and Procedure.*

Judge Rich has received the following awards: Jefferson Medal, N.J. Pat. Law Ass'n, 1955; Chas. F. Kettering Award, 1963, and the Distinguished Government Service Award in recognition of outstanding contributions in the industrial-intellectual property field, 1970, of the Patent, Trademark and Copyright Institute of the George Washington University; Freedman Foundation Patent Award of the American Institute of Chemists, 1967; Eli Whitney Award of the Conn. Pat. Law Ass'n, 1972; honorary life membership in the Los Angeles Pat. Law Ass'n, 1974; and an honorary life membership in the Rochester [N.Y.] Pat. Law Ass'n, 1976, and the San Francisco Pat. and Trademark Law Ass'n, 1986. He has received honorary LL.D. degrees from the John Marshall Law School, Chicago, 1981, and the George Washington University, 1989.

On March 7, 1990, the Federal Circuit Bar Association and Judge Rich's law clerks, in a courtroom ceremony, presented an oil portrait of the judge to the court. It is displayed in the National Courts Building, Lafayette Square, Washington, D.C.

STAFF OF JUDGE RICH

SECRETARY: Josephine F. Pizza . . . . Oct. 1, 1982—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Duft, Bradford J.	1982-83	Lyon & Lyon 4250 Executive Sq. La Jolla, CA 92037
Shaw, Anthony W.	1982-83	Burns, Doane, Swecker & Mathis 699 Prince St. Alexandria, VA 22314
Adler, Reid G.	1983-85	Director, Office of Technology Transfer National Institute of Health Bldg. 31—Rm. B1C36 9000 Rockville Pike Bethesda, MD 20892
Doyle, Richard P.	1983-85	Flehr, Hohbach, Test, Albritton & Herbert Four Embarcadero Center San Francisco, CA 94111-4187
Swain, Philip C.	1985-86	Kirkland & Ellis 700 South Flower St. Los Angeles, CA 90017
Nilles, Andrew J.	1985-87	Nilles, Custin & Kirby First Wisconsin Center 777 East Wisconsin Ave. Milwaukee, WI 53202

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Jakes, J. Michael	1986-88	Finnegan, Henderson, Farabow, Garrett & Dunner 1300 I St., NW. Washington, DC 20005-3315
Sylvester, Brett S.	1987-89	Sughrue, Mion, Zinn, MacPeak & Seas 2100 Penn. Ave., NW. Washington, DC 20037
Gartman, John E.	1988-90	Brown & Bain 600 Hansen Way Palo Alto, CA 94306
Vandenburgh, J. Derek	1989-present	
Mueller, Janice M.	1990-present	

Philip Nichols, Jr.

JUDGE PHILIP NICHOLS, JR.

Philip Nichols, Jr., was born in Boston, Massachusetts, on August 11, 1907, the son of Philip (1875-1956) and Mabel (Gibson) Nichols of Boston. His father—A.B. Harvard (1895); LL.B. Harvard Law School (1898)—was a lawyer and chairman of the Massachusetts State Housing Board. He wrote the authoritative work, *Nichols on Eminent Domain,* but his practice specialty was taxation. There were two children in this family, in addition to Philip, Jr.: Katherine (Nichols) Winslow (b. July 1910) and Margaret (Nichols) Fitzgerald (1913-1945).

Nichols attended both public and private schools in Newton, Massachusetts. From 1925 to 1929 he attended Harvard College, from which he received the A.B. degree, concentrating in English. He was on the board of the Harvard Advocate, an undergraduate literary monthly. The next three years he spent as a student in the Harvard Law School from which he received the J.D. degree in June 1932. He was in the Powell Law Club, the Ames Competition, and the Harvard Legal Aid Society.

Upon admission to the Massachusetts bar in 1932, Nichols became an associate in the Boston law firm of Mayberry, Ham & Witte for three years. From 1935 to 1938 he was a partner in the Boston firm of Nichols, Boyer & Morton. He moved to Washington, D.C., in June 1938, and from then to 1941 he was a special attorney in the Lands Division, Department of Justice. From 1942 to 1943 he was a special attorney with the War Production Board and counsel to various industry divisions of the board. From 1944 to 1946 he was in the Office of the General Counsel, Department of the Navy, dealing in procurement matters, starting in uniform at the rank of lieutenant, junior grade, and ultimately rising to lieutenant commander. On his separation from active duty in early 1946 he accepted an appointment as a Navy civilian contract attorney.

From 1947 to 1951 he was in the Treasury Department, first as counsel to the Bureau of Federal Supply, and later as assistant general counsel, Customs and Narcotics. In the years 1951-1954, he was general counsel to the Renegotiation Board. He then was admitted to the District of Columbia bar in 1954 and resumed private practice, as an individual attorney, in the years 1954-1957, specializing in matters before the Renegotiation Board, customs matters, and the probate of estates, the first two so far as allowed by the conflict-of-interest rules effective during that period. From 1957 to 1961 he was a partner in the Washington, D.C., firm of Butler, Koehler & Tausig, with a practice of similar nature.

In the years 1961-1964, Nichols was Commissioner of Customs under Secretary of the Treasury Douglas Dillon. In this position he was the chief of a Treasury bureau of 9,000 employees. He received the Exceptional Service Medal for his discharge of duties under this appointment.

In June 1964 Nichols was appointed to the United States Customs Court in New York City by President Lyndon B. Johnson. He was confirmed by the Senate in September, and President Johnson staged a joint swearing-in at the White House for Judge Nichols and Judge Linton Collins of the Court of Claims. He assumed the bench on October 1, 1964, and lived in New York until 1966.

Under the Act of May 11, 1966, 30 Stat. 139, two additional judges were authorized for the Court of Claims. Judge Nichols received the second of these appointments on October 10, 1966, from President Johnson. He was confirmed by the Senate on October 20, 1966, was commissioned on November 3, 1966, and took the oath of office on December 1, 1966, as an Associate Judge of the Court of Claims. On October 1, 1982, through the merger of the Court of Claims and the Court of Customs and Patent Appeals into the new U.S. Court of Appeals for the Federal Circuit, Judge Nichols became a Circuit Judge of the new court. He thus achieved the distinction of serving as a federal judge on three different United States courts. One year later, on October 1, 1983, he took Senior Circuit Judge status, continuing to sit until his health failed in 1989. After a prolonged illness, he died in Washington, D.C., on January 26, 1990.

Judge Nichols supervised and edited *Federal Eminent Domain* (1941), a government publication, and is the author of *Equalizing Profit & Loss in Renegotiation*, published in the Law Review of the University of Virginia (1959). He was a member of the American and Federal Bar Associations.

Judge Nichols grew to manhood in New England with a Yankee's love of the sea. As a boy he learned sailing and canoeing from his father, and almost always owned a boat of some description, muscle- or sail-propelled. He was a member of the Cambridge Boat Club, 1935-1938; the Potomac Boat Club, 1938-1941; the Old Dominion Boat

Club, 1947-1953; and the Orienta Yacht Club (Mamaroneck, New York), 1964-1966; and was a member of the West River Sailing Club, Galesville, Maryland, 1959-1990. He takes pride in being called a "waterman" rather than a "yachtsman."

In April 1940 he married Dorothy Jackson (d. 1990) of Cotulla, Texas. She was secretary and administrative assistant to Lyndon B. Johnson from time to time when he was a Member of Congress and later when he was Vice President, President, and ex-President of the United States. Judge and Mrs. Nichols were the parents of Donald (b. April 1941), an engineer; Patricia (b. October 1942), a lawyer; and Christopher (b. June 1952), a businessman.

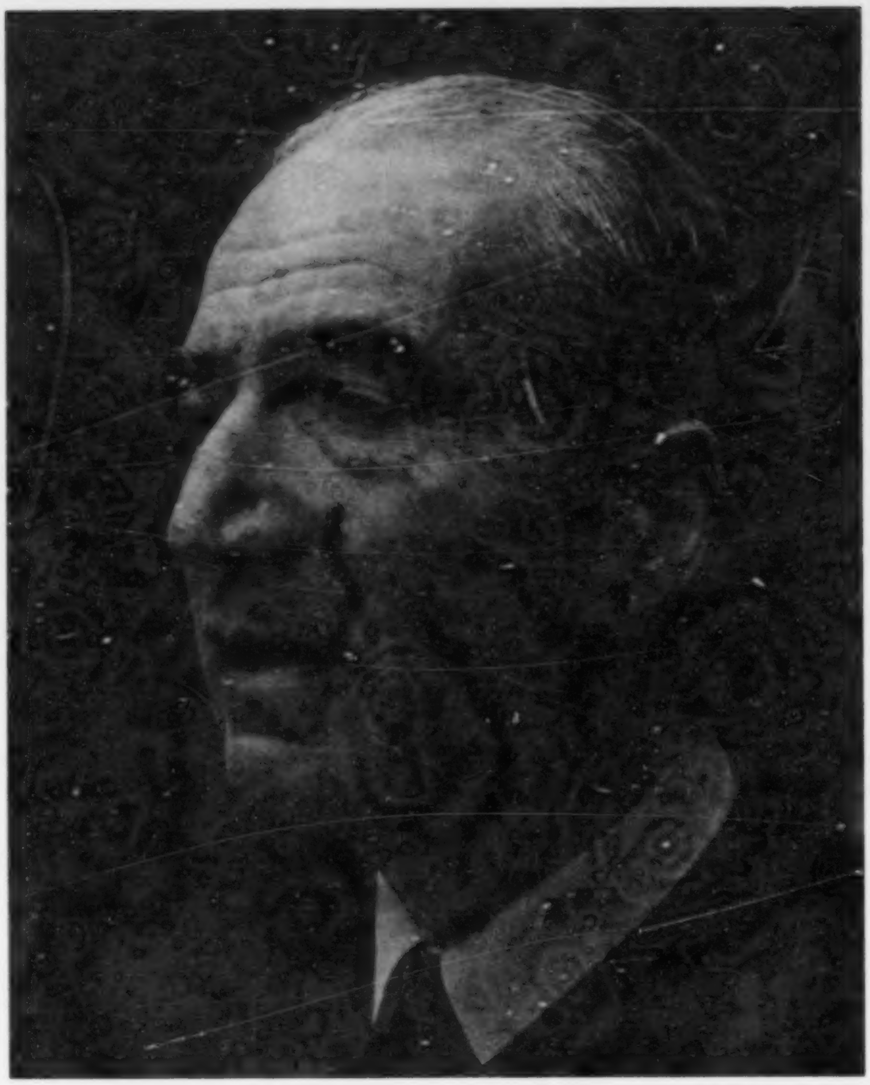
Judge Nichols is remembered as a kind and patient man, scholarly and hard working with a distinctive style of writing. He was a federal judge for over twenty-three years. A memorial session for Judge Nichols was held at the court on April 6, 1990. A resolution in his honor was adopted by the Judicial Conference of the United States on March 13, 1990.

STAFF OF JUDGE NICHOLS

SECRETARY: Lois A. Stewart . . . . . . Oct. 1, 1982—Sept. 29, 1989

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Horowitz, David E.	1982-83	Federal Communications Commission Mass Media Bureau 1919 M St., NW. Washington, DC 20554
Meagher, Patricia A.	1982-83	Pettit & Martin 101 California St. San Francisco, CA 94111
Bauer, Steven M.	1983-84	Allegretti & Witcoff, Ltd. 75 State St. Boston, MA 02109
Ben-Ami, Leora	1984-85	Anderson, Kill, Olick & Oshinsky, P.C. 666 - 3d Ave. New York, NY 10017
Fordis, Jean B.	1985-86	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Plave, Mitchell E. F.	1986-87	Crowell & Moring 1001 Penn. Ave., NW. Washington, DC 20004-2505

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Cinelli, Giovanna M.	1987-88	Howry & Simon 1730 Penn. Ave., NW. Washington, DC 20006
Thaler, Melinda B.	1988-89	Crowell & Moring 1001 Penn. Ave., NW. Washington, DC 20004-2505



Oscar Hirsh Davis

JUDGE OSCAR HIRSH DAVIS

Oscar H. Davis was born in New York City on February 27, 1914, the son of Jacob (1877-1942) and Minnie (Robison) Davis (1879-1962). His father arrived in New York from Europe in 1904 and was naturalized in 1914. His mother arrived in 1884. Jacob Davis (Davisky) left his home in Czarist Russia, in the area of Lithuania, as a young man of about sixteen years of age, and traveled about Europe looking for better opportunities. He lived successively in Warsaw, Poland; Berlin, Germany; Stockholm and Malmo, Sweden; and Paris, France, where he attended school, and came to the United States from England. In this country, Jacob was a small manufacturer of artificial silk and dealt in real estate and insurance. Jacob and Minnie Davis were the parents of three sons: Leo (1910-1917); Lawrence (b. 1917), a medical doctor and professor of radiology at the University of Louisville, Kentucky; and Oscar.

Oscar H. Davis was educated in the public schools of Mount Vernon, New York. He attended Harvard College from which he was graduated in 1934 with an A.B. degree. He graduated summa cum laude and Phi Beta Kappa. He then attended Columbia University School of Law in New York City from which he received his LL.B. degree (later changed to J.D.) in 1937. In law school he was a Kent Scholar in his first and third years and was on the law review staff, serving as the decisions editor. He became a member of the New York bar in 1938.

The future United States judge worked at miscellaneous jobs to help pay his way through Harvard. As a law student he worked in the summer as a clerk-messenger and a research assistant. In September 1937 he became an associate for two years with Chadbourne, Wallace, Parke & Whiteside, New York City, a firm in the general practice of law. In 1939 he came to Washington, D.C., to a position in the Supreme Court Section of the Claims Division (now the Appellate Section of the Civil Division), U.S. Department of Justice, and worked chiefly on Supreme Court briefs. He was admitted to the Supreme Court bar and the bar of the Court of Claims in 1941. He continued to work at the Department of Justice until he entered the Army in July 1942 where he served until May 1946, reaching the rank of captain in the Air Corps. In the military service he was involved mainly in legal work, including courts-martial problems, procurement, and legal assistance. He received the Army Commendation Medal for his work on atomic energy legislation for the War Department during World War II.

Returning to the Department of Justice after the war, Oscar Davis supervised, revised, and wrote briefs and argued government cases primarily in the Supreme Court, but also to some extent in other courts. In September 1950 he became Second Assistant to the Solicitor General and served in that post until June 1954. From July 1954 to April 1962 he was First Assistant to the Solicitor General (now called the Deputy Solicitor General). Twice he was Acting Solicitor General for brief periods in 1953 and 1956. He personally argued over fifty cases before the Supreme Court of the United States.

On January 31, 1962, Oscar Davis was nominated to be an Associate Judge of the U.S. Court of Claims by President Kennedy, and this nomination was confirmed on April 11, 1962. His commission is dated the following day, and he took his oath of office on April 26, 1962, succeeding Judge J. Warren Madden, retired. On October 1, 1982, through legislation, Judge Davis became a Circuit Judge on the newly created U.S. Court of Appeals for the Federal Circuit.

Judge Davis is the author of *The Federal Lawyer*, published in the March 1959 issue of Columbia Law School Alumni Bulletin, volume III; a book review of *Government Litigation: Cases and Notes* by Schwartz & Jacoby, 28 D.C.B.J. (1961); and a review of *Handling Federal Tort Claims: Administrative and Judicial Remedies* by Jayson, 66 Colum. L. Rev. 616 (1966). Judge Davis was a member of the American Law Institute and served on its advisory committees on Restatement of Judgments and on the Division of Jurisdiction Study. He was a member of the American Bar Association, the Federal Bar Association, the New York County Lawyers Association, and the New York State Bar Association.

Judge Davis never married. He was wedded to the law. He traveled extensively in Europe and was known for his pleasure in exercise by walking. His hobby was his work which was performed with great distinction and with the admiration of colleagues and the bar. He continued with his work as an active judge of the Federal Circuit while terminally ill, such was his dedication to his responsibilities. He died in Washington, D.C., on June 19, 1988, after a long illness. A memorial session for Judge Davis was held by the court on October 5, 1988. The proceedings are reported at 866 F.2d XCI.

On June 6, 1990, an oil portrait of Judge Davis was presented to the court by the Federal Circuit Bar Association and his law clerks.

STAFF OF JUDGE DAVIS

SECRETARIES:	Naida Cain	Oct. 1, 1982—Mar. 25, 1983
	Mary Catherine O'Connor	Apr. 14, 1983—Sept. 20, 1988

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Sherry, Robert J.	1982-83	McKenna, Conner & Cuneo 1575 I St., NW. Washington, DC 20005
Lazarus, William B.	1982-84	U.S. Department of Justice Environment & Natural Resources Main Bldg. Washington, DC 20530
Jacobson-Armbruster, Robin	1983-84	Covington & Burling 1201 Penn. Ave., NW. Washington, DC 20004
Lieberman, Mark	1984-85	Deputy Assistant Secretary of Technology U.S. Department of Commerce Washington, DC 20230

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Parker, Robert P.	1984-85	Counsel to the Vice Chairman U.S. International Trade Commission Washington, DC 20436
Johnson, Beverly K.	1985-86	
Friedman, Bruce	1985-86	Office of Special Counsel P.O. Box 65490 Washington, DC 20035-5490
Coyne, Randall	1986-87	University of Oklahoma Law Center 300 West Timberdell Norman, OK 73019
Eccleston, Lynn	1986-87	Cushman, Darby & Cushman 1615 L St., NW. Washington, DC 20036
Foreman, David	1987-88	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Lincoln, Steven F.	1987-88	Heller, Ehrman, White & McAuliffe 333 Bush St. San Francisco, CA 94104

STUDENT INTERN:	**Part-time During a Semester Unless Indicated**	**Law School**
Lieberman, Mark	1983*	Benjamin N. Cardozo School of Law

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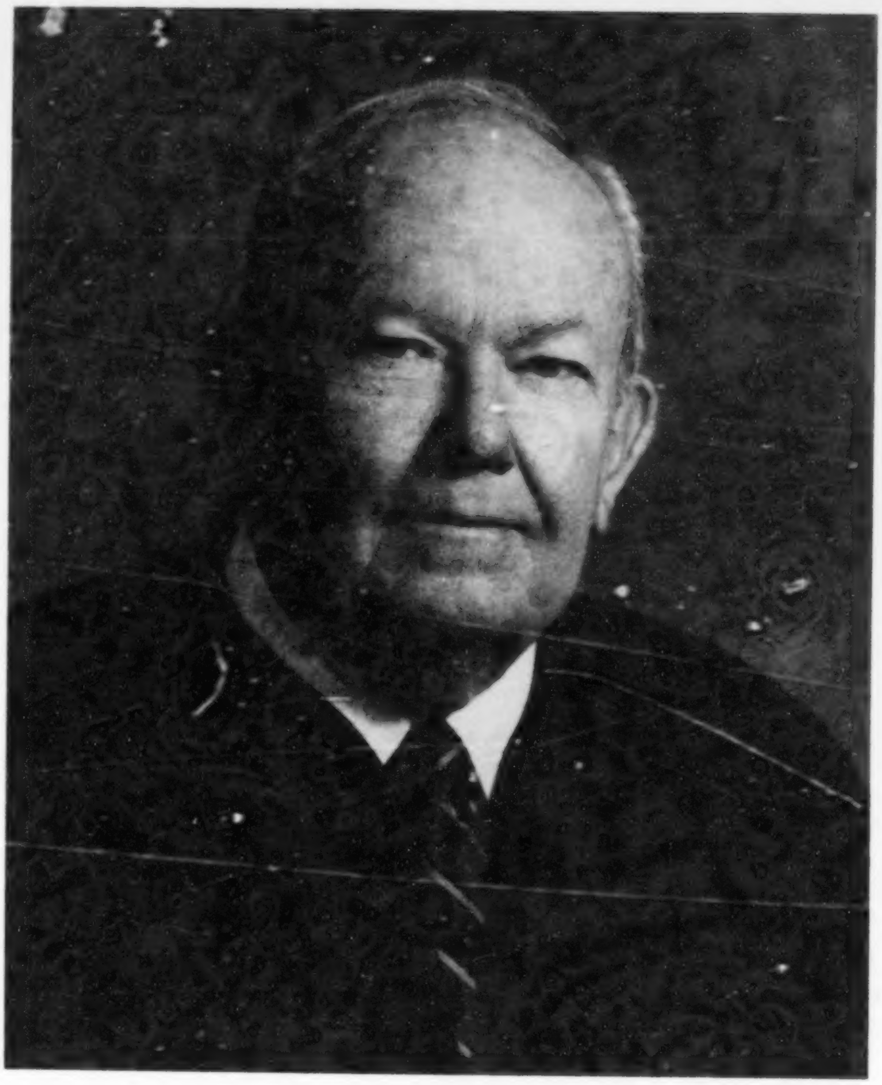
*Semester full time.



Phillip Benjamin Baldwin

JUDGE PHILLIP BENJAMIN BALDWIN

Phillip B. Baldwin was born in Marshall, Harrison County, Texas, on December 23, 1924, the son of Dr. Jack Browning and Lucille (Jones) Baldwin. His ancestors for five generations were all medical doctors.

Baldwin attended the Marshall public schools, the University of Texas, University of North Texas (B.A. 1949), and East Texas Baptist University (1950). With thoughts of becoming a doctor himself, he majored in biology with a minor in chemistry. On July 2, 1948, he married Mertie Bellamy of Marshall. They have four children: Rebecca (Mrs. Bruce C. Clark), Nancy (Mrs. Tom Rohtert), Jane (Mrs. Bradley Chrisenberry), and Phillip Benjamin, Jr.

He attended Baylor University Law School (1950-1951) and South Texas School of Law (1951-1952), receiving the Most Distinguished Alumni Award in 1958 from South Texas School of Law. He was admitted to the Texas bar in 1952 and to the United States Supreme Court bar in 1961.

He practiced law in Marshall as partner in the firm of Baldwin & Curry, was assistant district attorney, Marshall, Harrison County (June 1953 to July 1954), and was criminal district attorney of Harrison County (1954-1958). He was president of the Harrison County Bar Association.

World War II intervened in the education of Phillip Baldwin. He was in the United States Army Air Force from 1943 to 1946. He served in the Pacific Theater as a low-level attack bomber pilot (B-25), 405th Flight Squadron, 38th Bomb Group, 5th Air Force. He flew missions over New Guinea, the Philippine Islands, Borneo, Formosa, and the China Sea. He served as squadron operation officer and flight leader, was awarded the Asiatic-Pacific Campaign Medal with six Bronze Stars (Luzon, Western Pacific, New Guinea, China Sea offensive, air offensive of Japan, air combat of Borneo), the American Theater Campaign Medal, Philippine Liberation Medal with one Bronze Star, the presidential unit citation, and Army of Occupation Medal (Japan). He was awarded the Philippine Independence Medal and Philippine Liberation Medal by the Philippine Government in recognition of his participation in air-to-ground support for the Philippine guerrillas in the Battle of North Luzon. Judge Baldwin is a member of the American Legion and the Veterans of Foreign Wars, Elks Lodge, Alpha Tau Omega social fraternity, and Phi Delta Phi legal fraternity.

President Lyndon Johnson nominated Judge Baldwin to be an Associate Judge of the U.S. Court of Customs and Patent Appeals on May 29, 1968, the Senate confirmed the nomination on July 25, 1968, and he assumed his duties as judge on August 7, 1968. Pursuant to the Federal Courts Improvement Act of 1982, he became a Circuit Judge of the U.S. Court of Appeals for the Federal Circuit. Although Judge Baldwin took Senior Judge status on November 24, 1986, he has remained an active participant on the bench of the Court of Appeals for the Federal Circuit and as a judge by designation in numerous district courts.

STAFF OF JUDGE BALDWIN

SECRETARIES:

SECRETARIES:	Donna Lee Kennon	Oct. 1, 1982—May 13, 1988
	Naomi M. Mitchell	June 30, 1988—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Bent, Stephen A.	1982-83	Schwartz, Jeffery, Schwaab, Mack, Blumenthal & Evans, P.C. P.O. Box 299 Alexandria, VA 22313-0299
Kjeldgaard, Richard H.	1982-84	Burns, Doane, Swecker & Mathis 699 Prince St. Alexandria, VA 22314
Buckles, Mary-Elizabeth	1983-85	Porter, Wright, Morris & Arthur 1233 - 20th St., NW. Washington, DC 20036
Zischkau, Jonathan D.	1984-86	Crowell & Moring 1001 Penn. Ave., NW. Washington, DC 20004
Looper, Valerie E.	1985-86	Allegretti, Newitt, Witcoff & McAndrews, Ltd. 125 South Wacker Dr. Chicago, IL 60606
Ray, Patricia L.	1986-88	Weil, Gotshal & Manges 767 - 5th Ave. New York, NY 10153
Nunnenkamp, Kenneth J.	1988-89	Squire, Sanders & Dempsey 1201 Penn. Ave., NW. Washington, DC 20004

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Donovan, Patricia A.	1989-90	Foley & Lardner 1800 Diagonal Rd. Alexandria, VA 22313
Gallagher, Patrick	1990-present	

Shiro Kashiwa

JUDGE SHIRO KASHIWA

Shiro Kashiwa was born on October 24, 1912, in Kohala, Island of Hawaii, Territory of Hawaii, the son of the Reverend Ryuten (1898-1960) and Yukiko (Matsubara) Kashiwa (1890-1944). His father was Bishop at the headquarters in Honolulu of the leading sect of Japanese Buddhism called Jodo Shinshu. The judge is a member of that faith. His father was also a private school teacher and a graduate of Ryukoku University, Kyoto, Japan. He came to Hawaii in 1908. Shiro Kashiwa was one of a family of eight children. He had three brothers—Lester Tetsuro (1916-1972), a physician, Genro (b. 1921), an attorney, and Herbert Koro (b. 1925), a professor of anatomy at the University of Washington Medical School; and four sisters—Edith Shigeko (Kashiwa) Izumi (b. 1910) and Irene Yoshiko (Kashiwa) Franks (b. 1914), both teachers, Anita Atsuko (Kashiwa) Ainge (b. 1918), a nurse, and Judy Takako (Kashiwa) Kawabata (b. 1923), also a teacher.

Shiro Kashiwa attended public schools on the Island of Oahu, Hawaii, and in the years 1930-1932 attended the University of Hawaii in Honolulu. He transferred to the University of Michigan at Ann Arbor, Michigan, and received his B.S. degree in 1935 from that institution. He was a member of Phi Kappa Phi, a scholastic honorary fraternity. In 1936 he received his J.D. degree from the University of Michigan School of Law and was admitted to the Hawaii bar in 1937 and to the District of Columbia bar in 1971.

In 1937 Shiro Kashiwa entered the private practice of law in Hawaii with emphasis on civil matters, especially those relating to the Trading With the Enemy Act. He was appointed by Governor William F. Quinn as the first Attorney General of Hawaii in 1959 and supervised a staff of thirty-five lawyers. In 1963 he entered into a law partnership with his brother, Genro, practicing under the firm name of Kashiwa & Kashiwa in Honolulu and specializing in corporate and realty law. President Richard M. Nixon appointed him as the Assistant Attorney General for the Land and Natural Resources Division of the U.S. Department of Justice in 1969. In this capacity he entertained a special interest in enforcement of the environmental laws of the United States. He represented the United States in a number of important cases before the Supreme Court.

On November 30, 1971, Shiro Kashiwa was nominated by President Nixon to be an Associate Judge of the U.S. Court of Claims, succeeding Judge James R. Durfee, retired. Judge Kashiwa was confirmed by the Senate on December 2, 1971, commissioned on January 3, 1972, and assumed office on January 6, 1972. He was the first American of Japanese ethnic origin to be appointed an assistant attorney general or to the federal bench. On October 1, 1982, through the merger of the U.S. Court of Claims and the U.S. Court of Customs and Patent Appeals into the new U.S. Court of Appeals for the Federal Circuit, Judge Kashiwa became a Circuit Judge of that court. On January 6, 1986, he retired from that position to enter the private practice of law in Washington, D.C.

Judge Kashiwa has been active in the Republican Party and in local civic and legal affairs in Hawaii. He was vice chairman of his party in Hawaii in 1956 and 1957. He was both a director and president of the Honpa Hongwanji Mission, a president of the Hawaii Legai Aid Society, a member of the executive committee of the Honolulu Community Chest, and a director of the Kuakini Hospital in Honolulu. In 1970 he was chosen by the Japanese American Citizens League as "Nisei of the Biennium." While a student he was a member of the Lawyers Club at the University of Michigan and has been a member of the school's alumni association since 1936. He is a member of the American Bar Association, the American Judicature Society, the Federal, District of Columbia, and Hawaii Bar Associations, and the International Academy of Trial Lawyers. While Attorney General of Hawaii he was a member of the executive committee of the National Association of Attorneys General. He is a member of the Supreme Court Historical Society and of the Japan-America Society of Washington, D.C., of which he has been a trustee since 1973.

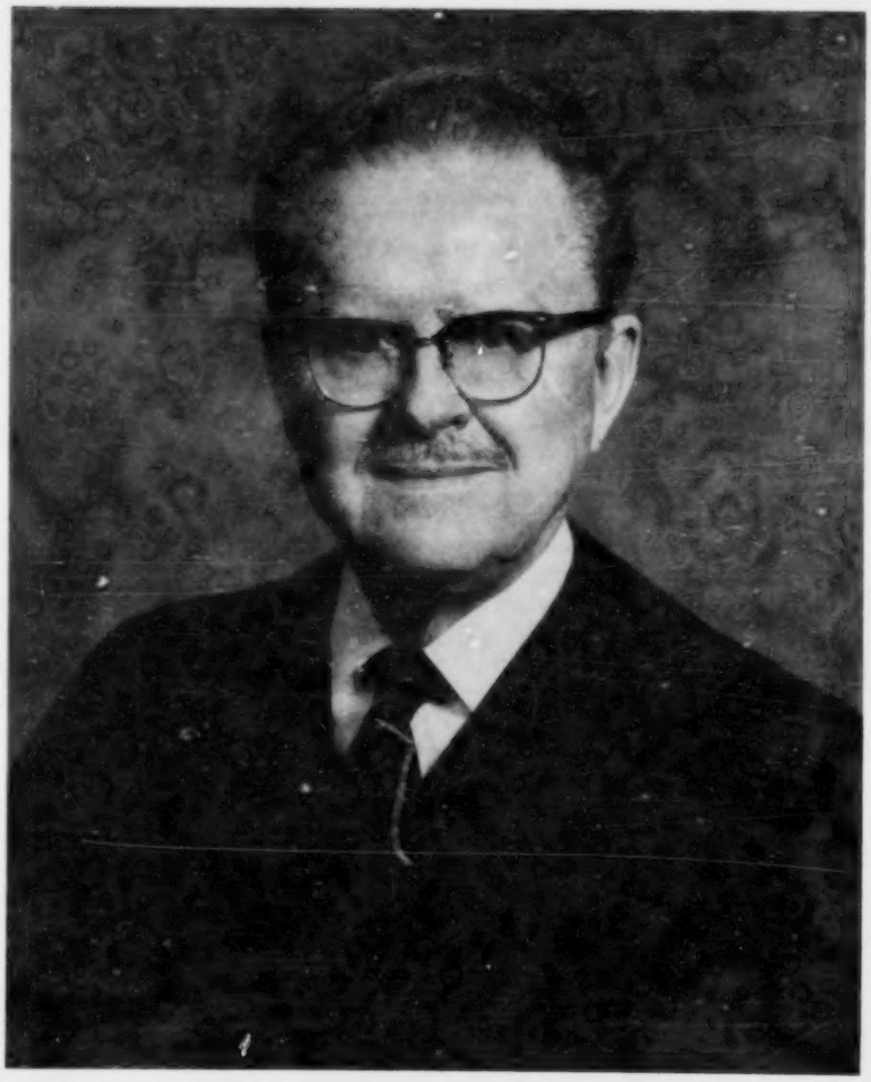
On July 20, 1941, Judge Kashiwa married Mildred Aiko Yamagata, a 1938 graduate of the University of Hawaii from which she received her B.A. degree. They are the parents of a son, Gregg Ryuji (b. October 1942), a realtor, and a daughter, Wendy Yuki (b. February 1945), an artist and art teacher in Berkeley, California. The Kashiwas are the grandparents of one granddaughter and one grandson.

Judge Kashiwa's portrait was received by the court in 1990 as a gift from his former law clerks. It hangs in one of the courtrooms.

STAFF OF JUDGE KASHIWA

SECRETARY: Margaret Y. Makino . . . Nov. 15, 1982—Jan. 5, 1986

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Doherty, Pearl A. (Bader)	1982-83	Covington & Burling 1201 Penn. Ave., NW. Washington, DC 20004
Chiang, Chun-I	1982-84	U.S. Department of Justice Civil Division Commercial Litigation 550 - 11th St., NW. Washington, DC 20530
Sciarra, Lorraine	1983-84	Princeton University Office of University Counsel 120 Alexander St. Princeton, NJ 08544
Radke, Terrance	1984-86	Weingarten, Schurgin, Gagnebin & Hayes One State St. Boston, MA 02109
Gordon, Marian R.	1984-86	Federal Communications Commission Policy Division for Common Carrier Bureau 1919 M St., NW. Washington, DC 20554



Marion Tinsley Bennett

JUDGE MARION TINSLEY BENNETT

Marion T. Bennett was born on June 6, 1914, in Buffalo, Missouri, the son of Philip Allen (1881-1942) and Mary Bertha (Tinsley) Bennett (1891-1987). He has a sister, Mary Edith (Mrs. F. Gordon Robertson) of Springfield, Missouri. His father was a newspaper publisher, a state senator from 1920 to 1924, Lieutenant Governor of Missouri from 1924 to 1928, a Republican Member of the 77th Congress, and Member-elect of the 78th Congress.

Marion Bennett attended public schools in Springfield, Missouri, where he was president of his class during his junior and senior high school years. He was awarded a scholarship in 1932 to attend Southwest Missouri State University in Springfield, and in 1935 received an A.B. degree with "highest distinction" in scholarship. He majored in both English and economics. While a college student he was president of his class, editor of the university newspaper, a member of the student council, and continued his activity in debate and oratory in which he annually won state, regional or national championships, beginning in Jarrett Junior High School in Springfield. He was awarded a scholarship to Washington University School of Law in St. Louis, Missouri, by Dean Wiley B. Rutledge, later a Justice of the United States Supreme Court, and graduated with an LL.B. degree (later changed to J.D.) in 1938. He was on the law review staff, was a moot court winner, and was on the university's international debate team.

Admitted to the Missouri bar in 1938, Marion Bennett began the private practice of law in Springfield and taught commercial law as a substitute teacher at the university. He was elected a member of the Greene County (Missouri) Republican Central Committee from the Ninth Springfield Ward in 1938, 1940, and 1942, managed his father's two successful campaigns for Congress, and was a delegate to the Missouri Republican state conventions six times during the period 1938 to 1948. Upon the death of his father he was elected, at twenty-eight years of age, at a special election on January 12, 1943, to the 78th Congress and was reelected to the 79th and 80th Congresses, serving from 1943 to 1949. He was a member of the Committees on Veterans Legislation and Interstate & Foreign Commerce and was a co-author of the first G.I. Bill of Rights for veterans' benefits. In 1946 a published poll of Members of both political parties named Bennett as "the most promising new Member of the House of Representatives."

In 1945, by invitation of General Dwight D. Eisenhower, Supreme Allied Commander, and by designation of the Speaker of the House, Bennett was one of ten Members of the House and Senate who constituted an official delegation of Congress to follow the United States Army into the infamous Nazi concentration camp at Buchenwald, near Weimar, Germany. Members of the delegation thereafter toured the United States describing what they saw and debunking enemy propaganda about concentration camp conditions.

On January 4, 1949, the day after his third term expired in the House, Marion T. Bennett was appointed a trial commissioner (trial judge since 1972) of the United States Court of Claims. He became Chief Commissioner of the court's Trial Division on September 11, 1964, serving in that position until his nomination in 1972 by President Richard M. Nixon to become an Associate Judge of the Court of Claims. Upon prompt confirmation by the United States Senate he assumed the duties of that office upon taking the judicial oath on July 7, 1972. The American Bar Association Standing Committee on the Federal Judiciary and the Federal and District of Columbia Bar Associations gave him their highest rating for appointment, "exceptionally well qualified."

Judge Bennett was a member of the Building Committee for the National Courts Building in Washington, D.C., which was dedicated in 1967, and was a member of the court's Standing Committee on Rules. He is a member of the American, District of Columbia, Missouri (inactive), and Federal Bar Associations, and was a member of the National Council of the FBA from 1958 to 1976. He is a member of the Reserve Officers Association, Delta Theta Phi legal fraternity, National Lawyers Club, the Association of Former Members of Congress, past president of the Bethesda-Chevy Chase Exchange Club, former trustee of the Chevy Chase (Maryland) United Methodist Church, as well as president of the Men's Club and twice chairman of the administrative board of that church. He is a colonel, retired, with twenty-four years of service in the United States Air Force Ready Reserve. In 1964 he received the Outstanding Alumnus Award of Southwest Missouri State University and the Award of Merit from the American Academy of Public Affairs; the Patriotic Service Medal of the American Coalition of Patriotic Societies in 1963; and the Legion of Merit, United States Air Force, in 1974. Bennett received commendations for his judicial service from the Federal Bar Association in 1986, the Bar Association of the District of Columbia in 1989, and on October 25, 1990, he was honored by the Federal Circuit Bar Association for his fifty years of public service.

Judge Bennett is the author of a number of legal articles published in various journals, and the author of the reference book, *American Immigration Policies, A History* (1963), published under the auspices of Drury College, Springfield, Missouri. He is the author of *The United States Court of Claims—A History, Part I* (1976), and co-author and editor of *Part II* (1978). He has the distinction of having held commissions in all three branches of the Federal Government—legislative, executive, and judicial.

On April 27, 1941, Judge Bennett married June Young of Hurley, Missouri, a high school teacher at Galena, Missouri, and honor graduate of Southwest Missouri State University (B.S. 1938). They are the parents of Ann (Mrs. Paul B. Guptill, b. June 3, 1944), a graduate of Southwest Missouri State University (1966), and William Philip (b. September 2, 1945), a graduate of Princeton University (1968), Duke University School of Law (1974), and an Army combat engineer officer in the Vietnam conflict. The Bennetts have two grandsons and two granddaughters.

After October 1, 1982, Judge Bennett continued in office as a Circuit Judge of the United States Court of Appeals for the Federal Circuit. He took status as a Senior Circuit Judge on March 1, 1986, and has continued to sit on the Court of Appeals for the Federal Circuit and, on occasion, by designation of the Chief Justice, on the Court of Appeals for the Eighth Circuit and as a United States district judge for the District of Columbia.

STAFF OF JUDGE BENNETT

SECRETARY: Dorothy I. Butts . . . . . . Oct. 1, 1982—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Anwyll, J. Bradford	1982-83	Miller & Chevalier Metropolitan Sq. 655 - 15th St., NW. Washington, DC 20005
Ross, Richard L.	1982-84	644 Independence Ave., SE. Washington, DC 20003
Burningham, Kent S.	1983-85	Workman, Nydegger & Jensen American Plaza II 57 West 200 South Salt Lake City, UT 84101
Nelson, Thomas L.	1984-85	Armstrong, Allen, Prewitt, Gentry & Holmes 1900 One Commerce Sq. Memphis, TN 38103-2568
Farney, Wm. Bryan	1985-86	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Boyd, Walter Y., Jr.	1985-86	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Stanley, Richard L.	1986-88	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Hadlock, Timothy J.	1988-89	Shell Oil Company One Shell Plaza Houston, TX 77252-2463
Petri, Henry A., Jr.	1989-present	

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Hajost, Cynthia M.	1984	The George Washington University National Law Center
Thomas, Elaine M.	1984	Georgetown University Law Center
Sofferman, Mark D.	1985	The George Washington University National Law Center
Webster, Hugh K.	1985*	Duke University School of Law
Lewis, Jeffrey I. D.	1985*	Benjamin N. Cardozo School of Law Alexander Fellow
Simmonds, Lisha	1986	The George Washington University
Webster, Aen Walker	1986	Stanford Law School

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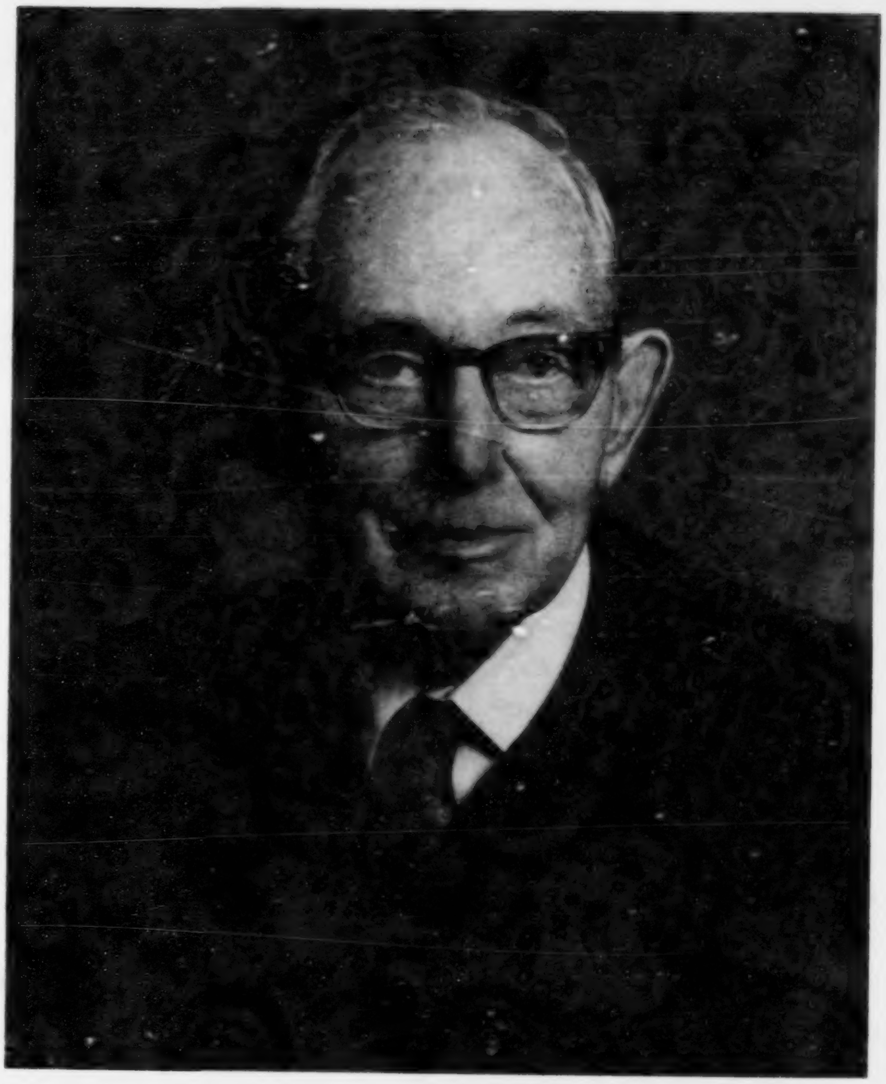
*Semester full time.



Jack Richard Miller

JUDGE JACK RICHARD MILLER

Judge Jack Miller was born June 6, 1916, in Chicago, Illinois, the son of Forest W. and Blanche Miller. The family moved from Wilmette, Illinois, to Sioux City, Iowa, in 1932 and to Bedford, Iowa, in 1937. He received his A.B. (cum laude) from Creighton University, Omaha, Nebraska, in 1938 and, as a Knights of Columbus Fellow, an M.A. from Catholic University, Washington, D.C., in 1939. He earned his J.D. degree at Columbia University School of Law in 1946 and did post-graduate work at the State University of Iowa College of Law the same year. He holds honorary (LL.D.) degrees from Creighton University (1966), Loras College (1967), Iowa Wesleyan College (1969), and Yonsei University (Korea) (1976).

During World War II, Judge Miller served over four years with the United States Army Air Corps, 1942-1946, attaining the rank of lieutenant colonel. His assignments included: faculty of the Army Command and General Staff College, Fort Leavenworth, Kansas, and the China-Burma-India Theater of Operations. He is a brigadier general in the U.S. Air Force Reserve.

He married Isabelle (Jerry) Browning of Windber, Pennsylvania, at Bolling Field, D.C., in 1942. They have four children—Janice (Mrs. John Flanagan), Judy (Mrs. Robert Flynn), James, a lawyer, and Jaynie (Mrs. Woody Studenmund)—and ten grandchildren.

Judge Miller is a member of the bars of Iowa, Nebraska, and the District of Columbia and a member of the American, Iowa, Nebraska, and District of Columbia Bar Associations and the American Patent Law Association. He is a life member of the American Law Institute. He served as an attorney, Office of Chief Counsel, Internal Revenue Service, Washington, D.C., 1947-1948; professorial lecturer in taxation, George Washington University, 1948; assistant professor of law, University of Notre Dame College of Law, 1948-1949; and engaged in the private practice of tax law in Sioux City, Iowa, 1949-1960. He is the author of numerous articles on taxation and patent law appearing in various legal periodicals and for many years was a co-author of the Prentice-Hall Tax Ideas Service.

He served in the Iowa House of Representatives, 1955-1956, and in the Iowa State Senate, 1957-1960. In 1960 he was elected U.S. Senator from Iowa and served two terms, from January 3, 1961, through January 2, 1973. As a member of the Senate he was the author of the Plant Varieties Protection Act of 1970 and of the Minimum Income

Tax Amendment, which was a key item in the Tax Reform Act of 1969. He also originated the idea of providing for automatic increases in Social Security and Railroad Retirement Act pensions to reflect increases in the cost-of-living index.

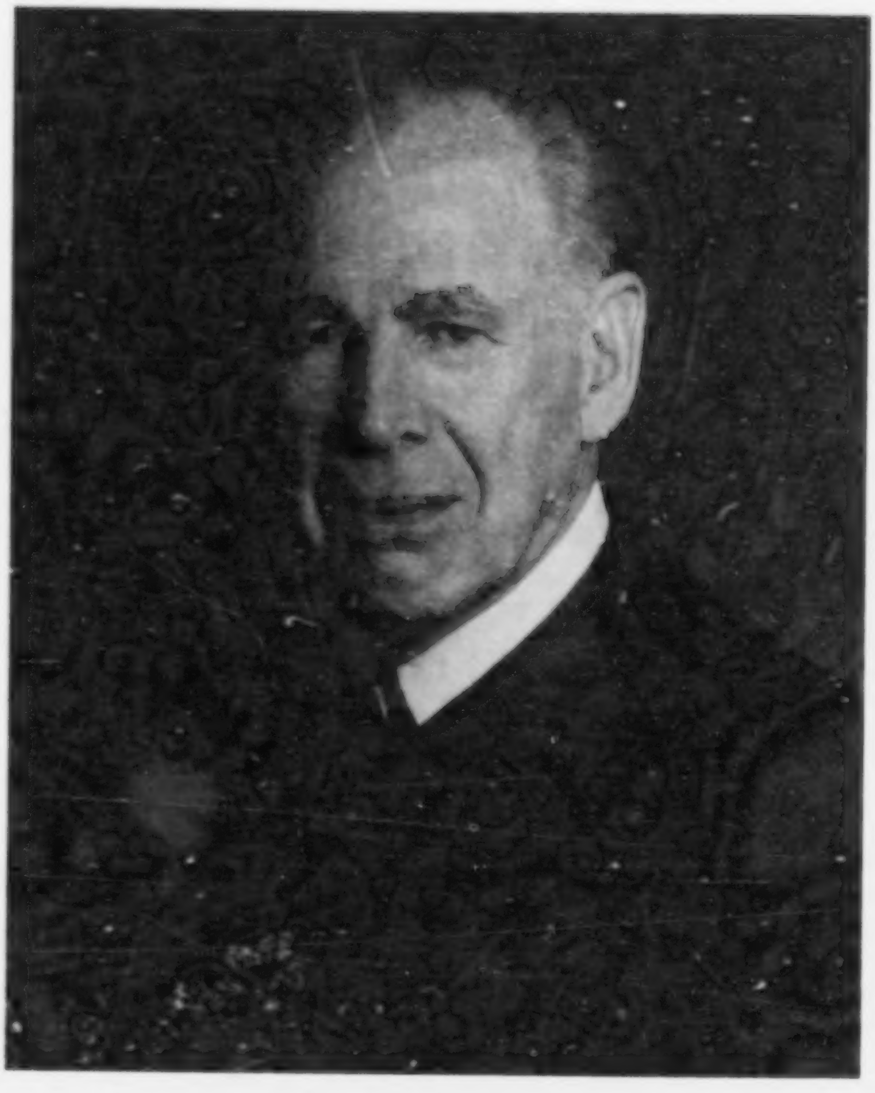
On June 28, 1973, President Nixon nominated Jack Miller to be an Associate Judge of the U.S. Court of Customs and Patent Appeals. His nomination was received from the White House by the Senate at 6 p.m. and was confirmed at 6:11 p.m. on the same day. In a letter to Judge Miller, the Secretary of the Senate stated that "this lapse of time is the shortest ever between the receipt of a Presidential nomination by the Senate and its confirmation." Judge Miller was commissioned on July 6, 1973, and sworn in the same day.

He became a United States Circuit Judge of the Court of Appeals for the Federal Circuit on October 1, 1982, upon enactment of the Federal Courts Improvement Act of 1982 and took Senior Judge status on June 6, 1985. He has sat with and written published opinions for all of the United States circuit courts of appeals and continues to perform judicial duties even though semi-retired as a Senior Judge.

STAFF OF JUDGE MILLER

SECRETARY: Barbara (Cannon)
Matthews . . . . Oct. 1, 1982—Sept. 8, 1986

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Israelsen, Ned A.	1982-83	Knobbe, Martens, Olson & Bear Koll Center 501 West Broadway San Diego, CA 92101
Drost, Patricia M.	1982-84	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Goldman, Michael L.	1983-85	Nixon, Hargrave, Devans & Doyle P.O. Box 1051 Clinton Sq. Rochester, NY 14603
Morron, Kelly L.	1984-86	Dewey, Ballantine, Bushby, Palmer & Wood 140 Broadway New York, NY 10005
McQuade, Paul F.	1986-87	Pillsbury, Madison & Sutro 1667 K St., NW. Washington, DC 20006



Edward Samuel Smith

JUDGE EDWARD SAMUEL SMITH

Edward Samuel Smith was born on March 27, 1919, in Birmingham, Alabama, to Joseph Daniel Zadock Smith and Sarah Jane (Tatum) Smith. He attended public schools in Birmingham and Alabama Polytechnic Institute (now Auburn University), where he majored in mechanical engineering. In 1938 he entered the University of Virginia at Charlottesville, where he majored in English, receiving his B.A. degree in 1941. He entered the university's law school in 1940, but his education was interrupted by military service.

Ed Smith enlisted in the Navy June 9, 1941, as a seaman and was discharged in February 1946 as a lieutenant. He served forty-two months at sea on two amphibious combat ships, seven months of recruiting duty, and participated in five major battles: Morocco, Sicily, Normandy, Southern France, and Okinawa, and in the initial landings in Korea and Tientsin, China. As the gunnery officer of U.S.S. *Susan B. Anthony*, sunk off Normandy on June 7, 1944, he received a commendation from the Commander, United States Naval Forces in Europe. Thereafter, he was executive officer of the U.S.S. *Arcturus*. He returned to the law school at the university and received his LL.B. (J.D.) degree in 1947.

He began the practice of law with Blair, Korner, Doyle & Appel, Washington, D.C., and later became a partner, specializing in tax, renegotiation, and probate matters. Among the landmark cases in which he was involved was *Estate of Ralph W. Simmers*, 23 T.C. 869 (1955), *aff'd*, 231 F.2d 909 (4th Cir. 1956), which reversed the long-standing method of taxing Maryland ground rents.

In 1961 Deputy Attorney General Byron R. White appointed Ed Smith chief of the trial section in the Tax Division, Department of Justice. In 1962 he became the assistant for civil trials (Deputy Assistant Attorney General).

Arguing in the Ninth Circuit opposite the noted tax litigator, Robert Ash, he won *Theodore E. Moberg v. Commissioner*, 310 F.2d 782 (9th Cir. 1962). On the day of argument, the court was advised that the Court of Appeals for the Fifth Circuit had held the exact opposite in a case involving Mr. Moberg's brother, *Vern H. Moberg v. Commissioner*, 305 F.2d 800 (5th Cir. 1962). These cases have been cited as examples of the need for a single court of tax appeals in order to avoid conflicts in general and the injustice of two participants in the same transaction being taxed differently solely because of their residence in different judicial circuits. In 1963 he and Louis F. Oberdorfer, head of the Tax Division, served as liaison between the Attorney General and Harrison Tweed, Bernard G. Segal, and Jerome J. Shestack in formation, at President Kennedy's behest, of the Lawyers Committee on Civil Rights Under Law.

On November 22, 1963, Ed Smith left the Justice Department and became a partner, head of the tax department, and principal tax litigator in Piper & Marbury in Baltimore. For three years he was its managing partner. His success in *Head Ski Co. v. United States*, 323 F. Supp. 1383 (D. Md. 1971), *aff'd*, 454 F.2d 732 (4th Cir. 1972), resulted in discontinuance of the attempt to disallow deduction of premiums incurred for premature payment of long-term convertible notes. In a notable Tax Court case, he persuaded that court, in a decision marked by numerous concurring and dissenting opinions, to reverse its previous decision on the right of testamentary trustees to avail themselves of their decedent's statutory right of tax-deferred replacement of involuntarily converted property. *Estate of John E. Morris*, 55 T.C. 636 (1971), *aff'd*, 454 F.2d 208 (4th Cir. 1972). He served as tax counselor to the Rouse interests in the acquisition of some 15,000 acres of land for the new city of Columbia, Maryland, and obtained numerous revenue rulings that resulted in creation of the Rouse Company.

He was admitted to practice in Maryland, Virginia, and the District of Columbia and has been active in bar association activities, including service as chairman of the Section of Taxation of the Maryland State Bar Association and chairman of the Tax Litigation Committee of the Section of Litigation, American Bar Association. He has published articles and lectured on tax and other legal subjects. In the field of education, he has served as counsel to the Chronicle of Higher Education and as general counsel to the National Catholic Education Association.

Ed Smith has been active in civic, fraternal, and church activities, served as a director of the Roland Park Civic League, Inc., of Baltimore, and is a past president of the St. Andrew's Society of Washington, D.C. He is a member of the Episcopal Church, Lambda Chi Alpha fraternity, the Society of the Cincinnati, the Chevy Chase Club, the Metropolitan Club, the Lawyer's Club of Washington, the National Lawyers Club, Washington, D.C., and the Summit Club of Birmingham.

On May 5, 1942, Ed Smith married Innes Adams Comer. Mrs. Smith is listed in *Who's Who of American Women*. They have two children, Edward Samuel, Jr. (b. September 23, 1944), a lieutenant commander in the United States Navy, and Innes Comer (Mrs. Ronald F. Richards, b. September 29, 1947). The Smiths have two grandchildren, Merrill and Catharine Smith.

Edward S. Smith was appointed by President Carter to the United States Court of Claims in 1978. On October 1, 1982, he was by statute continued in office as Circuit Judge of the United States Court of Appeals for the Federal Circuit. On June 1, 1989, he assumed the status of Senior Judge and moved his chambers to Birmingham. He has lectured at the University of Alabama School of Law and the Cumberland School of Law, Samford University. He continues to sit regularly on the Courts of Appeals for the Federal, Eleventh, and Fourth Circuits, and has served as a trial judge in the United States District Court for the Northern District of Alabama.

STAFF OF JUDGE SMITH

SECRETARIES:
Cleopatra P. Stark . . . . Oct. 1, 1982—June 30, 1989
Eugenia W. Burch . . . . June 12, 1989—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Applegate, John S.	1982-83	Assistant Professor of Law University of Cincinnati College of Law Cincinnati, Ohio 45221-0040
Coyne, Patrick J.	1982-84	Collier, Shannon, Rill & Scott 1055 Thomas Jefferson St., NW. Washington, DC 20007
Seastrum, Elizabeth C.	1983-85	Lepon, McCarthy, Jutkowitz & Holzworth 1146 - 19th St., NW. Washington, DC 20036
Weisman, Robert M.	1984-86	U.S. Nuclear Regulatory Commission Washington, DC 20555
Boyd, Walter Y., Jr.	1985-85	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Beem, Richard P.	1985-87	Neuman, Williams, Anderson & Olson 77 West Washington St. Chicago, IL 60602-2954

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Prior, Patricia (Lombardo)	1986-88	Killworth, Gottman, Hagan & Schaeff 1400 One First National Plaza Dayton, OH 45402
Koclanes, Peter G.	1987-89	Simpson, Thacher & Bartlett 425 Lexington Ave. New York, NY 10017
Brugge, Parker E.	1988-89	Patton, Boggs & Blow 2550 M St., NW. Washington, DC 20037-1350
Gwin, H. Sanders	1989-90	Sughrue, Mion, Zinn, MacPeak & Seas 2100 Penn. Ave., NW. Washington, DC 20036
Paschall, James C.	1990-present	

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Ullmann, Margaret E.	1984	Brigham Young University
Simmonds, Lisha	1985	The George Washington University National Law Center
Boyd, Walter Y., Jr.	1985	The George Washington University National Law Center

STUDENT INTERNS: *(Cont'd)*	**Part-time During a Semester Unless Indicated**	**Law School**
Simonton, Pamela A.	1985	The George Washington University National Law Center
Koclanes, Peter G.	1986	The George Washington University National Law Center
Mann, Jennifer K.	1988	American University Washington College of Law
Bradley, Alice Margaret	1990	Samford University Cumberland School of Law
Adams, Doris Cabell M.	1990	Samford University Cumberland School of Law
Dean, Kevin R.	1990	Samford University Cumberland School of Law
James, Paul M., Jr.	1990	Samford University Cumberland School of Law
Marsh, Suzanne G.	1990	Samford University Cumberland School of Law
Dai, Minxiang	1990	Samford University Cumberland School of Law

STUDENT INTERNS: *(Cont'd)*	**Part-time During a Semester Unless Indicated**	**Law School**
Lewis, Thomas M.	1990	Samford University Cumberland School of Law
Jenkins, Robert L.	1990	Samford University Cumberland School of Law

Helen Wilson Nies

CHIEF JUDGE HELEN WILSON NIES

Circuit Judge (1982-1990)
Second Chief Judge (1990-_____)

Helen Wilson Nies was appointed to the United States Court of Customs and Patent Appeals on June 18, 1980, by President Carter and entered on duty July 25, 1980. A political independent, she had been recommended to the President by the Judicial Selection Committee for national courts and had received the endorsement of both Senator Charles "Mac" Mathias (R) and Senator Paul Sarbanes (D) of Maryland. She became Circuit Judge of the United States Court of Appeals for the Federal Circuit upon its establishment on October 1, 1982. On June 27, 1990, she was elevated to the position of Chief Judge of that court.

Chief Judge Nies is a member of the Supreme Court, the District of Columbia and the Michigan bars. In private practice, Chief Judge Nies was very active in the field of protection of intellectual property. She held the positions of chairman of the Trademark Division of the Patent, Trademark and Copyright Law Section of the American Bar Association; a member of the board of directors of the American Patent Law Association; and chairman of the Patent, Trademark and Copyright Law Section of the Bar Association of the District of Columbia, following which she served on the board of directors of that association. She was also a member of the board of directors of the United States Trademark Association, and chairman of the National Coordinating Committee for Trademarks. She was on the United States Department of Commerce Public Advisory Committee for Trademarks. She has lectured and written extensively in the intellectual property field, and is an advisor on the American Law Institute committee which is drafting the *Restatement (Third) of the Law of Unfair Competition.*

Chief Judge Nies served on the Committee of Visitors, University of Michigan Law School, and in various positions in the Women's Bar Association of the District of Columbia. She is also a member of the National Association of Women Lawyers. She was chosen to receive the Woman Lawyer of the Year Award in 1980 by the Women's Bar Association of the District of Columbia, and, in 1988, received the University of Michigan Athena Award, given each year to an outstanding alumna. Chief Judge Nies now is a member of the Committee on the Bicentennial of the Constitution of the Judicial Conference of the United States. She has represented the United States in numerous international conferences throughout the world.

The future judge was born in Birmingham, Alabama, on August 7, 1925, the second child of George Earl Wilson (1902-1980) of Edgefield, South Carolina, an insurance adjuster, and Lida Blanche (Erckert) Wilson (b. 1903) of Rochester, New York. Her brother, Dr. George Earl Wilson, Jr. (b. 1922), practiced optometry in the Washington, D.C. area, with offices at the Pentagon and in McLean, Virginia, until his retirement; her brother, David Reynolds Wilson (1943-1968), who was killed in Vietnam, was a graduate of the United States Military Academy, West Point, New York. Although lacking a higher formal education, her father was a rising young executive in the insurance business in Detroit, Michigan, at the time of the stock market crash which brought down the company for which he worked. The young man began an odyssey through the Midwest struggling, as so many did at the time, to keep his family together and find better employment. During her formative years, the future judge attended public schools in Detroit, Michigan; St. Louis, Missouri; Bloomington, Illinois; Hamilton, Ohio; Flint, Michigan; and Mt. Pleasant, Michigan. Despite attending a different school each of her four years in high school, she maintained scholastic excellence while always active in theatre, musical productions, and service organizations. She graduated first academically in her class from Mt. Pleasant High School, but was most appreciative of her fellow students' choice as the most congenial member of the class. The most influential person on her future career was a gifted teacher of that school, Francis Robinson, who arranged for promising students to attend and obtain financial assistance from the University of Michigan. As a result of his interest, she received her first scholarship from that school and enrolled in a concentrated six-year curriculum of economics and law, receiving a B.A. degree in 1946 with high honors and membership in Phi Kappa Phi and Phi Beta Kappa.

With the end of World War II in August 1945, the law school enrolled the largest class it had ever admitted, mostly veterans of the war. Nicknamed "Lulu," a name still used by friends from that time, she was one of ten women in a student body of over a thousand. She remembers her male classmates with great fondness because of their friendly and encouraging acceptance of her as a competitor, colleague, and friend. She graduated in the top of one of Michigan's "great" classes and was one of the school's youngest graduates. In 1948, she received a J.D. degree (at that time a degree signifying high honors) and was awarded the Order of the Coif. During her years in school, she was financially self-supporting.

Selected to become the first woman clerk of the Michigan Supreme Court, her career plans changed because of her marriage following graduation to a classmate, John Dirk Nies, of St. Charles and Oak Park, Illinois, and Saugatuck, Michigan, and a former captain in the U.S. Air Force. Raised in a remarkable family of classical scholars, writers, scientists and musicians, he had all of these interests and talents himself and stimulated what was to become her lifelong interests in the arts, particularly in the artists.

The young couple was married on July 10, 1948, and moved to Washington, D.C., where John entered the U.S. Patent Office and Helen became a staff attorney in the Department of Justice, Office of Alien Property (1948-1951). She transferred to the Office of Price Stabilization in the General Counsel's Office headed by Harold Leventhal, later Circuit Judge of the U.S. Court of Appeals for the District of Columbia Circuit. She was made Branch Counsel supervising a staff of fifteen in charge of pricing all consumer durable goods during the Korean War.

By this time a dedicated career woman, she expected to return to work after the birth of the couple's first child, John Dirk (III), in 1952, having taken only a leave of absence from her position. However, maternal instincts proved too strong and she remained at home as a full-time homemaker for the next nine years and part-time for three more. Their daughter, Nancy Allyn (Nies) Sloan was born in 1954, and a second son, Eric Wilson Nies, in 1958. Dirk, a graduate of the University of Colorado (B.A. 1974) and the University of Maryland (Ph.D. 1978) (both degrees in chemistry), is married to Carmen Alicia (Morales) of San Juan, Puerto Rico. They have two children, Ryan and Katherine, and reside in Rockville, Maryland. Nancy, a graduate of Duke University (1976) and University of Cincinnati School of Law (1983), is a sole practitioner in Las Vegas, Nevada. Eric, a graduate of Massachusetts Institute of Technology (1981) and now a professional river guide and instructor, resides in Bryson City, North Carolina. John is now senior partner in the firm of Nies, Kurz, Bergert and

Tamburro of Arlington, Virginia. Lujon Enterprises, a family business, has engaged for many years in promoting young operatic talent.

After her years at home, Chief Judge Nies resumed her professional career in 1961 with the firm of Woodson, Pattishall & Garner of Chicago, Illinois, and Washington, D.C., specializing in trademark, copyright and unfair competition law. From 1978 until appointment to the bench, she was a partner in the Washington, D.C., firm of Howrey & Simon working in the same fields and in antitrust law.

Chief Judge Nies has been engaged in extensive community service activities in the Washington area. In 1990, she served as chairman of the Combined Federal Campaign for the Judiciary in the District of Columbia. She prepared the first study of county juvenile detention facilities; helped organize the Potomac Valley League which spearheaded the preservation of the river valley in its natural state and prevented intensive real estate development on the riverbanks and the construction of a freeway along the Palisades; led a drive for the development of small neighborhood play parks for children; worked for the preservation of the historic Glen Echo/Chautauqua facilities in Bethesda, Maryland, as a public park; organized numerous events for the American Field Service program for foreign exchange students; publicized and worked against the dangerous hazing of young military officers after the death of her brother's classmate; and supports various programs to assist homeless and abused women.

For recreation, Chief Judge Nies enjoys skiing (level: "terminal beginner"), biking, hiking, white-water rafting, beaching, and family musicales.

STAFF OF JUDGE NIES

SECRETARIES:	Catherine Lally	Oct. 1, 1982—Mar. 31, 1984
	Christine Tomasello	May 15, 1984—Aug. 29, 1986
	Barbara (Cannon) Matthews	Sept. 9, 1986—Sept. 1, 1989
	Nancy B. Bradley	Sept. 6, 1989—present
	Brenda Mueller	June 27, 1990—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Grossman, Kurt L.	1982-83	Wood, Herron & Evans 2700 Carew Tower Cincinnati, OH 45202
Schneller, Marina V.	1982-84	Office of Patent Counsel Mobil Oil Corporation 3225 Gallows Rd. Fairfax, VA 22037
Soffen, Stephen A.	1983-85	Ostrolenk, Faber, Gerb & Soffen 1725 K St., NW. Washington, DC 20006
von Hoffman, Gerard	1984-86	Knobbe, Martens, Olson & Bear 620 Newport Center Dr. Newport Beach, CA 92660
Rooklidge, William C.	1985-87	Knobbe, Martens, Olson & Bear 620 Newport Center Dr. Newport Beach, CA 92660

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Simenauer, Jeffrey	1986-88	Cushman, Darby & Cushman 1615 L St., NW. Washington, DC 20036-5601
Casey, Kevin R.	1987-89	Ratner & Prestia 500 North Gulph Rd. Valley Forge, PA 19482
Samaras, Harrie R.	1988-90	Knobbe, Martens, Olson & Bear 620 Newport Center Dr. Newport Beach, CA 92660
Mills, Jeffrey	1989-present	
Halkowski, Thomas L.	1990-present	

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Malone, Wade	1984	The George Washington University National Law Center
Simenauer, Jeffrey	1985	The George Washington University National Law Center
Allegretti, Daniel	1986	
Ryan, John	1986	The George Washington University National Law Center

STUDENT INTERNS: *(Cont'd)*	**Part-time During a Semester Unless Indicated**	**Law School**
Patashnick, Kent	1988	Franklin Pierce Law Center (selected but unable to serve for reasons of health)
Zenger, Todd	1988	The George Washington University National Law Center
Susser, Howard	1989*	The George Washington University National Law Center
Brotman, Harris	1989*	Southwestern University School of Law
Barrow, Kenneth S.	1989*	Brigham Young University J. Reuben Clark Law School
Fedorochko, Gary	1990	The George Washington University National Law Center
Wiant, Teresa J.	1990	Franklin Pierce Law Center
Elson, Vera Marie	1990*	University of Southern California Law Center

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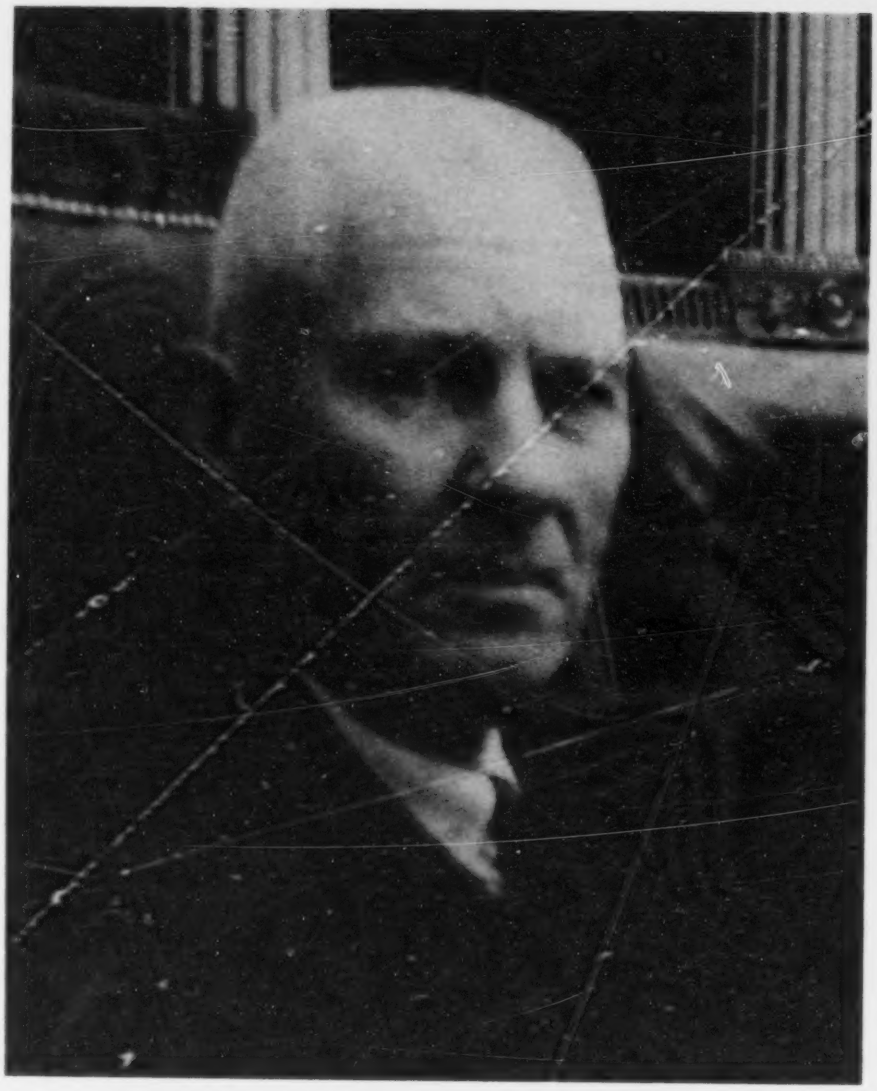
*Semester full time.



Don Nelson Laramore

JUDGE DON NELSON LARAMORE

Don N. Laramore was born on December 22, 1906, in Hamlet, Starke County, Indiana, the son of Louis Nelson (d. 1921), a livestock buyer, and Pearl (Stephenson) Laramore (d. 1967), a librarian. He had one brother and two sisters: Robert K. (b. July 1918); Dorothy (Laramore) Bell (b. June 1904); and Marjorie (Laramore) Sides (b. August 1912). His paternal grandparents were Andrew Jackson and Elizabeth (Hill) Laramore.

Don Laramore was educated in the public schools of Hamlet and Knox, Indiana, in the years 1912 to 1924, and thereafter attended Gregg College in Chicago for a year where he studied court reporting. He was the official reporter for the Starke County circuit court from 1925 to 1936. During the period 1926 to 1928 he attended three summer sessions of law at the University of Chicago and in 1928 attended the Indiana School of Law in Indianapolis. While a court reporter, he also studied law in the office of Judge William C. Pentecost in Knox, Starke County, Indiana. On April 18, 1931, he was admitted to practice law in the State of Indiana.

In 1936 he discontinued court reporting and until 1942 worked in the claims departments of the Nickel Plate, Pennsylvania, and New York Central Railroads. He was a judge pro tempore of the 44th Judicial Circuit, Starke County, from 1942 to 1944, and in November 1944, and again in November 1950, was elected to that office on the Republican ticket.

On March 17, 1954, Judge Laramore was commissioned by President Dwight D. Eisenhower to be an Associate Judge of the United States Court of Claims, succeeding Judge Evan Howell, resigned. He took his oath of office on May 1, 1954, and after serving over seventeen years on the Court of Claims bench he took status as a Senior Judge on January 17, 1972. Thereafter, he continued to sit at some of the sessions of the court and by designation on various United States circuit courts of appeals. Judge Laramore was succeeded on the bench by Robert L. Kunzig of Pennsylvania. On October 1, 1982, through the merger of the U.S. Court of Claims and the U.S. Court of Customs and Patent Appeals into the new U.S. Court of Appeals for the Federal Circuit, Judge Laramore became a Senior Circuit Judge of the new court.

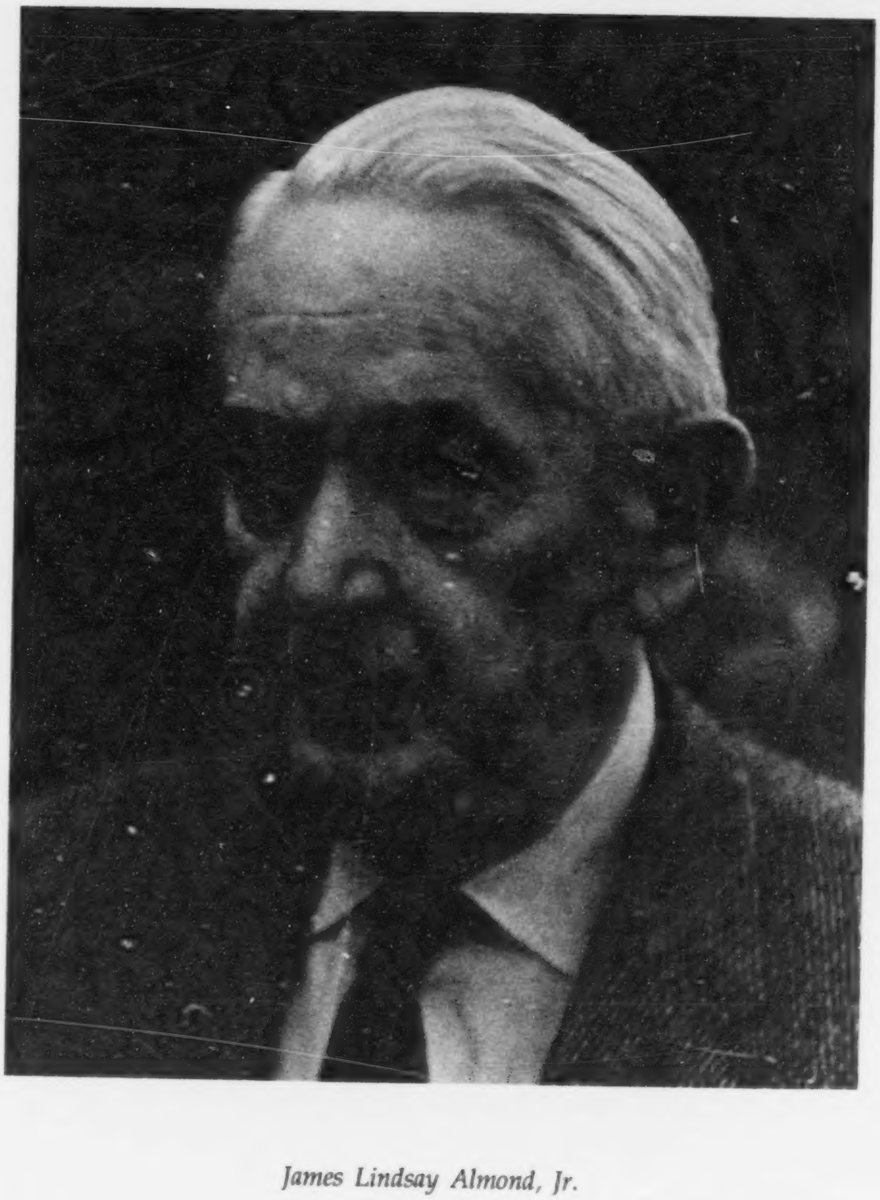
The occasion of Judge Laramore's retirement as an active judge of the Court of Claims was marked by a testimonial dinner on March

15, 1972, at the Mayflower Hotel, Washington, D.C., sponsored by the American and Federal Bar Associations and the Bar Association of the District of Columbia. Among the several speakers on that occasion was Court of Claims Chief Judge Wilson Cowen who remarked upon Judge Laramore's remarkable memory for the precedents of the court, of his special interest in tax cases, and of his contribution to the work of the court which was aided by his extensive experience as a trial judge.

Judge Laramore was a member of the American Bar Association, the American Judicature Society, the National Lawyers Club, and the Gamma Eta Gamma legal fraternity, and was a Mason and a Shriner.

On December 29, 1938, he was married in Chicago, Illinois, to Charlotte Mary Schminke (b. May 31, 1913), the daughter of George Walter and Charlotte (Meyer) Schminke. Judge and Mrs. Laramore had one daughter, Prudence Ann (b. July 25, 1945), who received her master's degree in education and is now a teacher in Aiken, South Carolina.

Judge Laramore died in Washington, D.C., on August 9, 1989, and is buried in Knox, Indiana. His state and federal service as an active and senior judge spanned almost thirty-five years. An order of the Court of Appeals for the Federal Circuit on October 6, 1989, remarked that "Judge Laramore left warm memories in the hearts of his former colleagues and a record of achievement in the annals of the Judiciary." The October session of the U.S. Court of Appeals for the Federal Circuit adjourned in his honor.



James Lindsay Almond, Jr.

JUDGE JAMES LINDSAY ALMOND, JR.

J. Lindsay Almond, Jr., was born at Charlottesville, Virginia, June 15, 1898, the son of James Lindsay and Edmonia Nicholas (Burgess) Almond. His father was a locomotive engineer. When he was a small boy his family moved to a farm in Orange County, Virginia, where he was reared, doing the practical physical work of a farmer's son, plowing and the like. He graduated from the Orange High School in 1917 and went to the University of Virginia where he was a member of the Students Army Training Corps in 1917-1918, ready to be mustered into the Regular Army when the Armistice was signed November 11, 1918. He graduated in law from the University of Virginia with an LL.B. degree in June 1923. Judge Almond practiced law in Roanoke, Virginia, from August 1923 to January 1, 1930. On August 15, 1925, he married Josephine Katherine Minter. They had no children but they reared a nephew, Lewis Minter.

On January 1, 1930, he became Assistant Commonwealth Attorney, Roanoke, a position he held until February 1, 1933, when he became judge of the Hustings Court, Roanoke. (That court is now part of the five-judge 23d Judicial Circuit of Virginia.) Almond was elected to Congress to represent the Sixth Congressional District to fill a vacancy during the 79th Congress in 1946 and was reelected to the 80th Congress. He resigned his seat in April 1948 upon being elected Attorney General of Virginia, a post he held until September 1957. Almond was satisfied to remain a congressman, but Senator Harry Flood Byrd insisted that he run and he won the election. During his nine-year term as Attorney General, Almond argued many of the Virginia school desegregation cases in the lower courts and before the United States Supreme Court. As he said in an interview reported in the Richmond News Leader of December 13, 1979, "I believed in the segregation of our public schools and I argued the doctrine of states' rights in the courts . . . but we lost every case, and either we had to accept some desegregation or close the public schools."

In November 1957 Almond was elected Governor of Virginia and served a four-year term, a Virginia governor not being eligible to succeed himself. Senator Byrd, Sr., head of the Commonwealth's Democratic organization and originally an ally of Governor Almond, was responsible for a policy of "massive resistance" to school desegregation, so named by Byrd, which had been implemented by state laws under which the Governor felt impelled in September 1958 to close nine public schools rather than let them submit to integration orders of the federal courts. In January 1959, however, the Virginia Supreme Court and a three-judge federal court declared the massive resistance laws unconstitutional. Governor Almond then renounced the old policy in favor of a substitute known as "Freedom of Choice." This he did in a historic speech to the Virginia General Assembly on January 28, 1959, which cost him his long friendship with Senator Byrd, Sr., and also brought him the enmity of many members of the Byrd organization. After the speech, Byrd never spoke to him again. Almond's position was simply that the Supreme Court had issued decisions which were the law of the land and the law must be obeyed.

President Kennedy, for whom Governor Almond had campaigned in Virginia, nominated him to be an Associate Judge of the Court of Customs and Patent Appeals on April 16, 1962, and, when the Senate failed to confirm the nomination because Senator Byrd blocked it, gave him an interim appointment while Congress was in recess on October 23, 1962. Judge Almond assumed the duties of the office on October 30, 1962.

As reported in the News Leader interview with Almond, mentioned above, he said, "Later on, the President called me over and we talked about the situation . . . I told him to go ahead and drop my appointment because Harry was fighting it. The President said he wouldn't do that, and that I would be confirmed." On January 15, 1963, President Kennedy sent a second nomination of Judge Almond to the Senate which, after 164 days, confirmed his appointment on June 28, 1963. As Judge Almond explained it, subsequently Byrd did not show up for a committee meeting at which his confirmation was recommended. "He didn't want me on the court but I think the public pressure in Virginia had gotten so great that he decided to back off fighting it." Judge Almond took a second oath of office on November 5, 1963. After serving more than ten years, he retired and became a Senior Judge on March 1, 1973.

Judge Almond's stand, when Governor, on the school desegregation issue caused a painful split with his party leader and friend, Senator Byrd, Sr. Twenty-one years later the Virginia Legislature passed a joint resolution citing the Almond career as "an example to all Virginians of selfless service, dauntless courage and nobility of character." At the same time, the National Association of Secretaries of State presented him with its Meritorious Public Service Medallion. Speaking for the association, Frederick T. Gray, Jr., Virginia's Secretary of State, said that Almond's call for a change in state policy, in defiance of Senator Byrd's massive resistance, has been hailed as "the bravest political act in the history of modern Virginia." (Richmond Times-Dispatch, Mar. 9, 1980.) Interestingly, in 1972 at the University of Virginia, Frederick T. Gray, Jr., wrote a student dissertation entitled "The Almond Revolution."

A later Virginia governor, Linwood Holton, described Governor Almond's anti-Byrd, pro-desegregation stand as probably "one of the loneliest acts that has ever been performed in the governor's chair in Virginia." (Richmond Times-Dispatch, Jan. 6, 1980.)

Judge Almond had served as a teacher; as a principal of Zoar High School, Locust Grove, Orange County, Virginia; as a Lutheran Sunday school teacher in Roanoke, Virginia; a 33d degree Scottish Rite Mason and a Shriner; belonged to the Fraternal Orders of Eagles, Moose, and United Commercial Travellers; and was a member of Delta Theta Phi legal fraternity, Alpha Kappa Psi, and Omicron Delta Kappa. He was actively engaged in the work of the United Lutheran Church. When he was Governor, Almond received an LL.D. from the College of William and Mary in Virginia on May 17, 1959.

Judge Almond became a Senior Judge of the U.S. Court of Appeals for the Federal Circuit in 1982, by operation of law, but did not participate in its work because of declining health. He lived in retirement in Richmond, in his home state of Virginia, until he died on April 14, 1986.

Wilson Cowen

JUDGE WILSON COWEN

Wilson Cowen was born on December 20, 1905, in the village of Norse, near Clifton, Bosque County, Texas, the son of John Rentz and Florence Juno (McFadden) Cowen.

He graduated from Clifton High School in 1923. As a representative of his high school, he twice won first place in declamation, and was three times a member of the winning debating team in the annual county interscholastic league contests. He was president of his class during each of his four high school years, ranked second in his graduating class, and was awarded a scholarship to the University of Texas. In his freshman year he won the first prize, a gold watch, as the best speaker in the university intersociety debating contest, and was later a member of the varsity debating and wrestling teams. At the law school of the University of Texas, from which he received his LL.B. degree in 1928, he was a contributor to the law review, was a member of the moot court society, and was the class speaker at graduation.

Admitted to the Texas bar in 1928, Wilson Cowen commenced the general practice of law at Dalhart, Texas, as an associate with the firm of Tatum & Strong. He was president of the Dallam County Bar Association for four years. In 1934 he was elected county judge of Dallam County on the Democratic ticket, and as a judge he sat on a court of record with jurisdiction of probate, juvenile, criminal misdemeanors, and small civil cases. He was also ex officio chairman of the Board of County Commissioners, and as such was also the principal administrative officer of the county.

The Panhandle of Texas was hit hard by the economic depression of the 1930s, and its troubles were compounded by the severe drought in the Great Plains. Dallam County was in the heart of the Dust Bowl. The dust storms, which began in 1932, reached their height in 1935. They caused drastic financial losses and resulted in hardships and suffering by many people. Because of these circumstances, the young judge became involved in a number of local, state, and federal projects and programs that were undertaken to relieve the widespread human distress and to curb the devastating soil erosion in the area. His participation and experience in these activities led to his appointment in 1938 as Texas State Director of the Farm Security Administration, Department of Agriculture. In 1939 he became Associate Director of the agency's Rural Rehabilitation Division in Washington, D.C., and in 1940 was appointed Director of Region 12 of the FSA. In the latter position he had responsibility for the FSA programs in New Mexico and parts of Texas, Kansas, and Colorado. In 1942 he came to Washington, D.C., to accept the appointment as a commissioner (trial judge since 1972) of the United States Court of Claims. In September 1943 he was granted a leave of absence from the court to serve as Assistant War Food Administrator under Judge Marvin Jones, his mentor and close friend of many years. From July 1 to October 1, 1945, he was Special Assistant to the Secretary of Agriculture during the post-war reorganization of the Department. In October 1945 he returned to the court to continue his judicial duties as a trial commissioner and was appointed Chief Commissioner of the court's Trial Division in 1959. He was a member of the court's Committee on Rules since it was first organized in 1947 and was responsible for many innovations in the court's procedures, including the preparation of orders for the handling of special litigation and the drafting of forms and orders pertaining to discovery, depositions, and pretrial procedures. After Congress first appropriated funds for the new courthouse, which was dedicated on September 29, 1967, he was chairman of the court's Building Committee and acted as its representative in dealings with architects, officials of the Public Buildings Service, and other interested officials and persons.

On June 16, 1964, Wilson Cowen was nominated to be Chief Judge of the Court of Claims by President Lyndon B. Johnson, to succeed Chief Judge Marvin Jones, retired. He was confirmed by the Senate on July 2, 1964, commissioned on July 8, and took his oath of office and assumed his duties on July 14, 1964.

During his service as Chief Judge, he participated in a position of leadership in the revision and modernization of the court's rules and in securing legislation which strengthened the court and broadened its jurisdiction. New laws enacted at his request include acts which: (1) increased the number of the court's judges from five to seven (the first enlargement since 1863) and authorized the court to sit in panels, 80 Stat. 139 (1966); (2) provided for the reference of private claims by either House of Congress to the Chief Commissioner, 80 Stat. 958 (1966); (3) authorized contract reporting of all court proceedings, 84 Stat. 298 (1970); (4) granted the court jurisdiction over contract suits against nonappropriated fund activities (military exchanges), 84 Stat.

449 (1970); (5) gave the court jurisdiction to redetermine excessive profits found by the Renegotiation Board, 85 Stat. 97 (1971); (6) authorized the court to recall retired trial judges, 86 Stat. 529 (1972); and (7) granted the court authority to remand matters to administrative and executive bodies and officials, and to implement its judgments by ordering restoration of officers and employees to office or position or placement in appropriate status, 86 Stat. 652 (1972). As a result of changes in the statutory law and in the rules of the court, the Court of Claims during his tenure became a two-division court which combined in one tribunal the facilities and attributes of a trial and an appellate court. He was the representative of the court on the Judicial Conference of the United States and served on its committees on Trial Practice and Technique and Judicial Improvement.

He retired from active service as Chief Judge of the Court of Claims on March 1, 1977, and assumed status as a Senior Judge. On October 1, 1982, Judge Cowen became a Senior Circuit Judge of the newly created U.S. Court of Appeals for the Federal Circuit and continues to sit on that court.

Judge Cowen is a member of the Cosmos and National Lawyers Clubs, the Texas Bar Association, the Federal Bar Association, and the American Bar Association. He is a member of the Presbyterian Church.

On April 18, 1930, Judge Cowen married Florence Elizabeth Walker of Texas (b. July 10, 1908; d. March 23, 1989). Judge and Mrs. Cowen had two sons—Dr. Wilson Walker Cowen (b. June 5, 1934; d. February 22, 1987), a graduate of Harvard University and Director of the University Press, University of Virginia, Charlottesville, Virginia, and John Elwin Cowen (b. March 24, 1942), a graduate of Gallaudet College and an editorial assistant, Federal Supply Service, General Services Administration.

In 1978, Judge Cowen's colleagues in the Court of Claims, the trial judges of that court, and the staff presented his portrait to the court. It now hangs in the courthouse on Lafayette Square.

On October 25, 1990, Judge Cowen was additionally honored by the Federal Circuit Bar Association for his service of over fifty years in the administration of justice.

STAFF OF SENIOR JUDGE COWEN

SECRETARIES: Antoinette Baglia . . . . . Oct. 1, 1982—Aug. 10, 1987
Pamela S. Dambrava . . . Aug. 5, 1987—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Rothstein, Beverly I.	1982-83	U.S. Department of Health & Human Services Office of General Counsel Food & Drug Division 5600 Fishers Lane Rockville, MD 20857
Downs, Burtis E., IV	1983-84	University of Georgia Law School Athens, GA 30602
Sampliner, Gary	1984-85	McKenna, Conner & Cuneo 1575 I St., NW. Washington, DC 20004
Johnson, Scott A.	1985-86	Perkins Cole 1900 Washington Bldg. Seattle, WA 98101
Trope, Konrad L.	1986-87	Foley & Lardner 1775 Penn. Ave., NW. Washington, DC 20006-4680
Lewis, Guy A.	1987-88	United States Attorney's Office 155 South Miami Ave. Miami, FL 22120
Adams, Halvor N., III	1988-89	Miller & Chevalier 655 - 15th St., NW. Washington, D.C. 20005-5701

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Rosenthal, Michael J.	1989-90	U.S. Department of Justice Tax Division 10th & Penn. Ave., NW. Washington, DC 20530
Baird, Stephen R.	1990-present	

Byron George Skelton

JUDGE BYRON GEORGE SKELTON

Byron Skelton was born in Florence, Williamson County, Texas, on September 1, 1905, the son of Clarence Edgar (1882-1975), a farmer and merchant, and Avis Ione (Bowmer) Skelton (1885-1958). The future judge had seven brothers and two sisters: Hiram Bowmer (1903-1953), a theatre owner; William Hiram (1907-1976), a former chairman of the Board of Pardons and Paroles of Texas; Clarence Edgar, Jr. (1909-1928); Barnet B. (b. 1912), a lawyer; Max DeWitt (1914-1977); Howard (b. 1919), a theatre manager; Joe Ray (b. 1921), a postmaster; Margaret Lena (Skelton) Alsup (b. 1914); and Kathryn (Skelton) Lee (b. 1923).

After attending public schools in Clarendon, Ashtola, Goldston, and Groom, Texas, Byron Skelton entered Baylor University at Waco, Texas, in 1923 where he spent one year. Thereafter, he attended the University of Texas in Austin, receiving his B.A. degree in political science in 1927, his M.A. degree in 1928, also in political science, and his LL.B. in 1931. As an undergraduate he was Phi Beta Kappa, Pi Sigma Alpha, Sigma Delta Pi, a member of the Tejas Club, a Rhodes Scholar nominee, and a cum laude graduate. He was also a member of the student assembly and president of the student body. In law school he was on the law review staff.

Admitted to the Texas bar in 1931, he commenced the private general practice of law in Temple, Texas, and was a partner in the firm of Saulsbury & Skelton from 1934 to 1942, the firm of Saulsbury, Skelton, Everton, Bowmer & Courtney from 1944 to 1955, and the firm of Skelton, Bowmer & Courtney from 1955 to 1966. He was elected county attorney of Bell County, Texas, serving from 1934 to 1938, and served by appointment as city attorney of Temple from 1945 to 1960. In the years 1942 to 1945 Byron Skelton was special assistant and legal advisor to the U.S. Ambassador to Argentina. Always active in local civic and legal affairs, he was president of the Bell-Lampasas-Mills Counties Bar Association and a member of the grievance and legislative committees of the state bar of Texas. He is a member of the American Bar Association, the American Law Institute, and the American Judicature Society. He was twice president of the Temple Kiwanis Club (1933 and 1938), president of the Temple Chamber of Commerce (1946-1947), president of the Temple YMCA (1939), and president of the USO Council and of the Ex-Students Association of the University of Texas (1950-1952). He is Past Worshipful Master and D.D.G.M. of Knob Creek Lodge No. 401 of the

Masons at Temple, and a member of the Shrine, Karem Temple, Waco, Texas. He was a member of the board of directors and president of the Temple, Texas, Industrial Foundation and a director of the First National Bank of Temple.

Active in political affairs of the Democratic Party, Byron Skelton was chairman of the Democratic Advisory Council of Texas from 1955 to 1957 and a delegate to each of the nine state conventions from 1946 to 1964 and vice chairman of the conventions in 1948 and 1958. He was a delegate to the Democratic National Conventions in 1948, 1956, 1960, and 1964, serving on the Credentials Committee from 1956 to 1964, was the Texas Democratic National Committeeman from 1956 to 1964, and was chairman of the Texas Inaugural Committee in 1961. While Judge Skelton was the Democratic National Committeeman for Texas, and upon learning of the proposed visit of President John F. Kennedy to Dallas on November 22, 1963, he became deeply concerned about the President's safety because of some hostile, inflammatory statements appearing in the Dallas press. He had a premonition that because of these statements there might be some violence, and wrote to the President's brother, Attorney General Robert F. Kennedy, on November 4, 1963, and to Walter Jenkins, administrative assistant to Vice President Johnson, on November 6, 1963, urging that Dallas be omitted from the President's itinerary of the state's urban centers. He also made a trip to Washington, D.C., to see Chairman John Bailey of the Democratic National Committee to make the same admonition. Had his warning been heeded, the President's assassination might have been avoided.

On August 17, 1966, Byron Skelton was nominated by his friend and fellow Texan, President Lyndon B. Johnson, to be an Associate Judge of the U.S. Court of Claims. He was one of two additional judges authorized by 80 Stat. 139 (1966), which enlarged the court from five to seven judges. He was confirmed by the Senate on October 20, 1966, was commissioned on November 3, 1966, and took his oath of office and assumed his judicial duties on November 9, 1966. After serving over ten years on the Court of Claims bench, Judge Skelton took Senior Judge status on May 1, 1977, and returned to Texas. Through the merger of the U.S. Court of Claims and the U.S. Court of Customs and Patent Appeals into the new U.S. Court of

Appeals for the Federal Circuit, he became a Senior Circuit Judge of the new court on October 1, 1982.

In 1973 Judge Skelton administered the oath of office to his friend, Leon Jaworski, the Watergate special prosecutor, in a ceremony in the Court of Claims courtroom. He also administered the oaths of office to John H. Crooker, Jr., as Chairman of the Civil Aeronautics Board (1968), and to Congressman Bob Casey as a member of the Federal Maritime Commission. On many occasions through the years he has sat by special designation as a judge on the United States Circuit Courts of Appeals for the First, Fifth, Seventh, and Ninth Circuits. He maintains an office in Temple, Texas, and residences in Temple and nearby Salado, Texas.

On November 28, 1931, Byron Skelton was married to Ruth Alice Thomas (1907-1988) and they had two daughters—Sue Helen (Mrs. Jerry Ramsey, b. April 8, 1935) and Sandra Ruth (Mrs. Robert T. Farrell, b. June 2, 1937)—seven grandchildren, and four great grandchildren. Before her marriage, Mrs. Skelton was secretary to the Casualty Insurance Commissioner of Texas.

Judge Skelton is a hunter and fisherman, collects Indian lore and artifacts and mint and proof sets of U.S. coins, and has always been interested in gardening and in the growing of flowers, particularly roses and geraniums. He has received many honors and in 1959 was named a Kentucky colonel and an admiral in the Texas Navy. He is an honorary member of Delta Theta Phi, has received the Legion of Honor of Kiwanis International and the Legion of Honor of DeMolay, and was named the Outstanding Citizen of Temple, Texas, in 1984.

He is an active member of the Methodist Church, and a former trustee and member of the Board of Stewards of the church in Temple, Texas.

STAFF OF SENIOR JUDGE SKELTON

SECRETARIES:

Rose Stavinoha . . . . . . Oct. 1, 1982—May 27, 1983
Estelle Quiroz . . . . June 27, 1983—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Burleson, Aaron Bruce	1982-84	Bowmer, Courtney, Burleson, Normand & Moore First National Bank Bldg. Temple, TX 76503
Dahan, David	1985-86	707 South Gulfstream Ave., #1004 Sarasota, FL 33577

JUDGE PAULINE NEWMAN

Pauline Newman was born on June 20, 1927, in New York, New York, daughter of Maxwell H. and Rosella G. Newman. Her father was a lawyer and her mother a teacher. She received the B.A. degree from Vassar College in 1947, the M.A. in Pure Science from Columbia University in 1948, and the Ph.D. degree in chemistry from Yale University in 1952. Her LL.B. degree is from New York University School of Law in 1958. She received many academic honors. She was admitted to the New York bar in 1958 and to the Pennsylvania bar in 1979.

At Vassar she exhibited the initiative that would characterize her career. She founded an intercollegiate conference to provide a forum for undergraduate scientific research, and in 1947 the First Annual Eastern Colleges Science Conference was held at Vassar under her chairmanship. The conference continues to meet annually.

She continued her education as a scientist at Columbia and then at Yale. At Yale she was awarded the Henry B. Loomis Fellowship, and conducted her dissertation research on "Oxidation-Reduction Potentials of Hydroquinone-Monoethers." She worked as a research chemist for the American Cyanamid Company from 1951-1954, concentrating on problems in the chemistry of polymers and pigments. She was granted several United States and foreign patents on this work.

In 1954 she moved to the Food Machinery and Chemical Corporation (later renamed FMC Corporation), attending night classes at New York University School of Law. She received the LL.B. degree in 1958, graduating with high honors, and was admitted to the New York bar that year. In 1961-1962, on leave from FMC, she worked for the United Nations Educational, Scientific and Cultural Organization as a Science Policy Specialist, headquartered in Paris. In 1969 she was appointed Director of the Chemical Patent, Trademark, and Licensing Department for FMC, a position she held until her appointment to the bench.

Throughout her career Judge Newman maintained a bridge between the cultures of science and law. She has held many elected and appointed offices in scientific organizations. Her service with the American Chemical Society included three three-year terms on the board of directors of the American Chemical Society, chairman of the Budget and Finance Committee, chairman of the Public Affairs and Public Relations Committee, chairman of the Committee on Grants and Awards, chairman of the Committee on Patent Matters and Related Legislation, and vice chairman of the Council Policy Committee.

She served four three-year terms on the board of directors of the American Institute of Chemists, and was the chairman of its New York Section. She has served with other groups, including special committees of the American Association for the Advancement of Science.

She also held leadership positions in several bar associations. She served on the board of directors of the American Intellectual Property Law Association, and the Council of the American Bar Association's Patent, Trademark and Copyright Section. She served as vice president of the United States Trademark Association, and for two terms on its board of directors. She was a member of the board of governors of the New York Patent Law Association. She was president of the Pacific Industrial Property Association, an organization of Japanese and American technology companies. She also served on the Executive Committee of the International Patent and Trademark Association. Her committee chairmanships and other contributions are too numerous to list, a tribute to her capacity for work and her devotion to public service.

She served on several governmental advisory committees, including the Advisory Committee to the Domestic Policy Review of Industrial Innovation, the Special Advisory Committee to the Commissioner on Patent Office Procedure and Practice, the United States Delegation to the Diplomatic Conference on the Revision of the Paris Convention for the Protection of Industrial Property, several Advisory Committees to the Office of Technology Assessment, and the State Department Advisory Committee on International Intellectual Property.

Other volunteer activities included membership on the board of trustees of the Philadelphia College of Pharmacy and Science, the Patent Policy Board of the State University of New York, the National Board of the Medical College of Pennsylvania, the board of directors of Research Corporation, and the Yale Chemistry Department Advisory Committee.

She is a member of the Advisory Council of George Mason University School of Law, the board of directors of New York University

Law Alumni Association, and the Advisory Council of the PTC Research Foundation of Franklin Pierce Law School. She is a trustee of the National Invention Center, a director of the Judiciary Leadership Development Council, a director of the United States Patent Model Foundation, and an advisor to the Board of the Foundation for a Creative America. She serves on the executive committee of the Prettyman-Leventhal American Inns of Court.

Articles written before her accession to the bench include: *Toward Economic Recovery: University/Industry Cooperation*, IDEA, J. of L. & Tech. 25 (2), 77 (1984); *The Patent System and Industrial Innovation*, in Innovation & the Am. Econ. (Franklin Inst. Press, 1980); *Proposed Revisions in the Patent Law*, in Legal Rts. of Chem. & Eng'rs, Am. Chem. Soc'y (1977); *What the Patent Attorney Needs from a Patent Information Point of View*, with Erick I. Hoegberg, in J. of Chem. Info. & Computer Sci. *18*, 83 (1978); *Non-Binding Conciliation Between Japanese and American Companies*, IDEA, J. of L. & Tech. (Winter 1976).

In 1984 she was nominated by President Ronald Reagan to be a Circuit Judge of the United States Court of Appeals for the Federal Circuit. She was confirmed by the Senate on February 27, 1984, was commissioned on February 28, 1984, and took the oath of office and assumed her judicial duties on May 7, 1984. She has given talks to bar associations, scientific societies, law schools, and at special events including the bicentennial celebration of the patent and copyright laws; some of these talks have been published. In addition, she serves as a member of the Commission for the Judiciary Office Building.

Her awards include the Wilbur Cross Medal of the Yale University Graduate School; the Award for Outstanding Contributions to International Cooperation of the Pacific Industrial Property Association, and the Jefferson Medal of the New Jersey Patent Law Association.

STAFF OF JUDGE NEWMAN

SECRETARIES:
Kathleen S. Nogaki . . . . May 14, 1984—Mar. 15, 1985
Kathleen C. Galiano . . . Mar. 18, 1985—Oct. 20, 1986
Carolyn E. Lynch . . . . . Nov. 24, 1986—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Wallman, Kathleen M. H.	1984-85	Arnold & Porter 1200 New Hampshire Ave., NW. Washington, DC 20036
Karl, Darrel C.	1984-86	Finnegan, Henderson, Farabow, Garrett & Dunner 1300 I St., NW. Washington, D.C. 20005-3315
Tegfeldt, Jennifer A.	1985-87	Fitzpatrick, Cella, Harper & Scinto 1001 Penn. Ave., NW. Washington, DC 20004
Linck, Nancy J.	1986-87	Cushman, Darby & Cushman 1615 L St., NW. Washington, DC 20036
Morgan, Ethel L.	1987-88	Federal Energy Regulatory Commission 825 North Capitol St., NE. Washington, DC 20426

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Tramposch, Albert G.	1987-88	The John Marshall Law School Center for Intellectual Property Law 315 South Plymouth Ct. Chicago, IL 60604
Lincoln, Steven F.	1988-89	Heller, Ehrman, White & McAuliffe 333 Bush St. San Francisco, CA 94104
Dickson, Mark K.	1988-90	Townsend & Townsend 1 Market Plaza Steuart Street Tower San Francisco, CA 94105
Canelias, Peter S.	1989-present	
Alexander, Jay I.	1990-present	

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Morgan, Ethel L.	1985*	Pace University Law School
Burgoon, Richard P.	1987*	Franklin Pierce Law Center
Nelligan, Mark C.	1987*	Franklin Pierce Law Center
Jones, Huw R.	1988*	Franklin Pierce Law Center
Bodwell, Erica P.	1989*	Franklin Pierce Law Center
Blundall, George W.	1990*	Franklin Pierce Law Center

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*Semester full time.

Jean Galloway Bissell

JUDGE JEAN GALLOWAY BISSELL

Jean Galloway Bissell was born on June 9, 1936, in a small town, Due West, South Carolina. Her parents were Robert S. Galloway, a state legislator and publisher of the Associate Reformed Presbyterian, and Clara (Agnew) Galloway. On June 11, 1969, she married Gregg C. Bissell. They had no children.

Jean Bissell's early schooling was in her hometown, including two years at Erskine College. She graduated magna cum laude from the University of South Carolina in 1956 with a B.S. degree, was elected to Phi Beta Kappa, received her LL.B. degree in 1958, magna cum laude, from the University of South Carolina School of Law, and was admitted to the South Carolina bar in 1958. She was the associate editor and business manager of the South Carolina Law Review and chief justice of the Order of Wig and Robe.

Judge Bissell received honorary doctor of law degrees from Converse College (1976) and Furman University (1987). On September 30, 1988, the South Carolina College of Business Administration at the state university gave her its Distinguished Alumnus Award. First in her class at law school, she was selected to become an associate, later a partner, in the Greenville, South Carolina, law firm headed by Clement F. Haynsworth, Jr., later Chief Judge of the United States Court of Appeals for the Fourth Circuit. She was in the private practice of law in Columbia (1971-1976) until becoming general counsel for the South Carolina National Corporation and the South Carolina National Bank in 1976. She was also an adjunct professor and lecturer of law at the University of South Carolina School of Law for twelve years.

Appointed as a Circuit Judge for the United States Court of Appeals for the Federal Circuit by President Reagan in 1984, she served on the court in Washington, D.C., from September 14, 1984, until her untimely death on February 4, 1990, in Washington. She is buried in Due West, South Carolina. Judge Bissell was a Presbyterian and for ten years was a trustee of the General Synod of the Associate Reformed Presbyterian Church.

Jean Bissell, an avid reader, was always interested in libraries and was a trustee of several libraries in South Carolina. In 1973 she received the Distinguished Service Award of the South Carolina Library Association. She was on the advisory council of the state library, received the first Annual Friend of Libraries Award in South

Carolina in 1976, is listed in *Who's Who in America*, and served with distinction as a member of the Judicial Conference Committee on the Judicial Branch. On March 13, 1990, the conference adopted a resolution of regret upon her passing, commending her judicial service and her "comprehensive knowledge of legal and commercial matters."

The judicial career of Judge Bissell was all too brief. She brought to the court broad experience gained in the practice and teaching of law, in the leadership of a major banking corporation, and in activities as a board member or trustee of numerous civic and educational institutions where her practical experience served the court well.

A memorial session was held by the court on May 8, 1990, followed by a reception in the Tayloe House sponsored by the Federal Circuit Bar Association. The tributes paid to her on that occasion were many and each highlighted her even judicial temperament, dedication to her work, her sincere interest in other people, and her love for Erskine College in South Carolina, which had been for generations an abiding interest of her church and family. A building there is named for her father. She received the Sullivan Award from Erskine College on May 20, 1989.

Judge Bissell's opinions were models of clarity and demonstrated her mastery of the facts and law in each case before her. Her colleagues were unanimous in their admiration for her grace and dignity on the bench, her modest confidence and good humor, lack of abrasiveness, keen mind, poise, sincerity, and absolute and complete dedication to the Federal Judiciary as a vital institution for support of a free society and nation. She was a hard worker and a productive appellate judge. She was a good listener but was always able to make her own valuable contribution to judicial decision making. In a short time Judge Bissell established an enviable reputation, and her judicial colleagues and the bar are one in regret that their association could not have been longer.

STAFF OF JUDGE BISSELL

SECRETARY: Vivian Luhrs . . . . Sept. 17, 1984—Mar. 23, 1990

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Rosenberg, Charles	1984-85	Poms, Smith, Lande & Rose 2121 Avenue of the Stars Los Angeles, CA 90067
Quillin, George E.	1984-86	Finnegan, Henderson, Farabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Capria, Mary Ann	1985-87	Jones, Day, Reavis & Pogue 1450 G St., NW. Washington, DC 20005
Tewes, R. Scott	1986-87	Kilpatrick & Cody 100 Peachtree St. Atlanta, GA 33043
Duberstein, Douglas R.	1987-88	Hogan & Hartson 555 13th St., NW. Washington, DC 20004
Paulson, Mark G.	1987-89	Cushman, Darby & Cushman 1615 L St., NW. Washington, DC 20036
Jones, Neil C.	1988-90	Hughes & Luce 1717 Main St. Dallas, TX 75201

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Dukes, Mark C.	1989-90	Dority & Manning 700 East North St. Greenville, SC 29601

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Jacobs, Steve B.	1985*	University of South Carolina
Rivera, Chrispin M.	1985*	University of California School of Law, Los Angeles
Steinberg, Robert	1986	Georgetown University Law Center
Silfin, Ira E.	1987*	Yeshiva University Cardozo School of Law
Springer, Ann Lauren	1988	American University Washington College of Law
Patashnick, Scott	1988*	Franklin Pierce Law Center
Fox, Steven N.	1989*	Franklin Pierce Law Center
Shafran, Nina	1989	The George Washington University National Law Center

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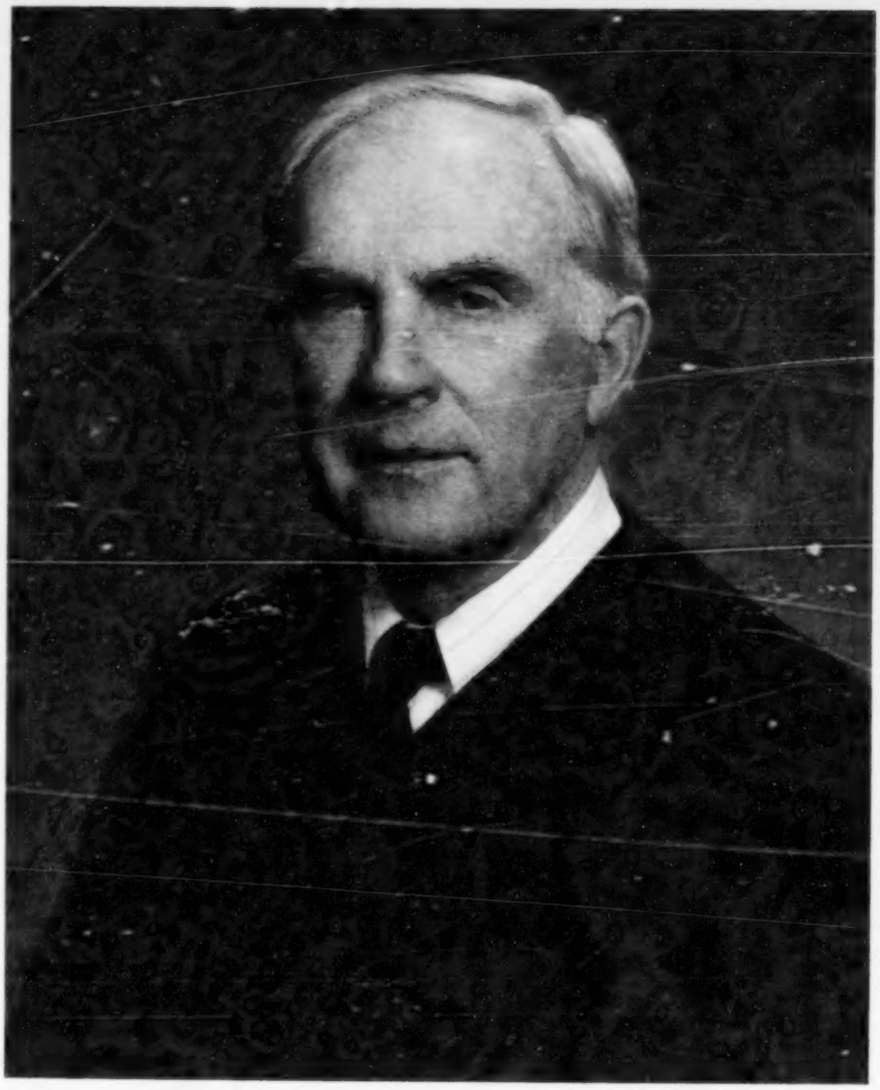
*Semester full time.



Glenn L. Archer, Jr.

JUDGE GLENN L. ARCHER, JR.

Glenn L. Archer, Jr., was born March 21, 1929, in Densmore, Kansas, a small farming community in the northwestern part of the state. Ten years later, his family moved to Topeka, Kansas, where he was educated in the public junior and senior high schools. After completing his secondary education, Judge Archer was awarded a four-year academic scholarship by Yale University. In 1951, he graduated with a Bachelor of Arts degree from Yale, where he majored in English Literature.

Judge Archer entered the George Washington University Law School in the summer of 1951 and graduated with a Juris Doctor (with honors) degree in 1954. During law school Judge Archer was a member of the board of editors of the George Washington Law Review, Phi Alpha Delta legal fraternity, and the Student Bar Association. He also participated actively in university affairs, including serving as president of the George Washington Student Council and of his social fraternity, Sigma Nu.

After law school graduation and upon being admitted to the bar of the District of Columbia in October 1954, Judge Archer received a direct commission as a first lieutenant in the Judge Advocate General's Office of the U.S. Air Force. He served as a staff judge advocate at Arnold Engineering Development Center in Tullahoma, Tennessee, from 1954 to 1956. In that capacity, Lieutenant Archer provided the legal review for the award and administration of construction, research and development, and supply contracts entered into by the Air Force and its contractor-operator for the facility. In addition, Lieutenant Archer acted as defense counsel in courts-martial and provided legal assistance to military personnel. During that service, Lieutenant Archer was assigned for special duties to the Air Research and Development Command headquarters in Baltimore, Maryland.

Judge Archer returned to Washington in December 1956 to enter private practice as an associate in the law firm of Hamel, Park and Saunders (subsequently merged into Hopkins & Sutter). In 1960, he became a partner of that firm. Judge Archer specialized in federal taxation and corporate law during his twenty-five years of private practice. He was an active member of the Section of Taxation of the American Bar Association, being elected as a member of the Council, secretary, and assistant secretary, and serving in officer capacities on various committees.

In the fall of 1981, President Reagan nominated Judge Archer to be Assistant Attorney General for the Tax Division, Department of Justice, and he was confirmed by the United States Senate in December 1981. As Assistant Attorney General under two Attorneys General, Judge Archer directed a staff of over 600, including 320 attorneys. The Tax Division conducted and was responsible for all tax refund, tax collection, and related civil tax litigation in the courts of the United States. It also had supervision and responsibility over criminal tax investigations and prosecutions, including prosecutions by the Tax Division's attorneys and by some ninety-five United States attorneys' offices. In recognition of his outstanding service, Judge Archer received the Justice Department's highest award, the Edmund J. Randolph Award, in March 1984.

After more than thirty years of experience in the law as an Air Force officer, a private practitioner, and as an Assistant Attorney General of the United States, President Reagan nominated Judge Archer in October 1985 to be a Circuit Judge of the United States Court of Appeals for the Federal Circuit. He was confirmed by the United States Senate and took his oath of office as a Circuit Judge in December 1985.

STAFF OF JUDGE ARCHER

SECRETARY: Mary A. Benson . . . . . . Dec. 26, 1985—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Radke, Terrance J.	1985-86	Weingarten, Schurgin, Gagnebin & Hayes One State St. Boston, MA 02109
Gordon, Marian R.	1985-86	Federal Trade Commission 1919 M St., NW., Room 544 Washington, DC 20554
Farney, Wm. Bryan	1986-87	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Brooks, Anne E.	1986-88	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Donofrio, John	1987-89	Kirkland & Ellis 655 15th St., NW. Washington, DC 20005
Atkinson, William M.	1988-90	Bell, Seltzer, Park & Gibson 1211 East Morehead St. Charlotte, NC 28234
Herbst, Jeffrey A.	1989-90	Latham & Watkins 555 South Flower St. Los Angeles, CA 90071
Leslie, Mark R.	1990-present	

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Dintzer, Kenneth	1990-present	

STUDENT INTERNS:	**Part-time During a Semester Unless Indicated**	**Law School**
Breakstone, Robin M.	1986	The George Washington University National Law Center
LaCorte, Brian W.	1986 1987	The George Washington University National Law Center
Cohen, Daniel G.	1986 1987	The George Washington University National Law Center
Arnhold, Katharina P.	1987	The Catholic University of America Columbus School of Law
Viti, Kim A.	1987 1988*	The George Washington University National Law Center
Mastrostefano, Sherry	1988	The George Washington University National Law Center
Whiteford, Wendy A.	1990*	University of California Hastings College of the Law
Jackson, Lauris Ann	1990*	Emory University School of Law

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*Semester full time.

STUDENT INTERNS: *(Cont'd)*	**Part-time During a Semester Unless Indicated**	**Law School**
Babcock, Brenton R.	1990	Georgetown University Law Center

Haldane Robert Mayer

JUDGE HALDANE ROBERT MAYER

Haldane Robert Mayer was born on February 21, 1941, in Buffalo, New York. He spent most of his youth in Lockport, New York, where he lived with his family, Haldane Rupert and Myrtle Kathleen (Gaude) Mayer and brother, Charles. He attended parochial school as a young child and public schools as an adolescent. At Lockport Senior High School he achieved academic distinction, excelled as a miler on the track team, and was elected class president. During his summer vacations he was a camp counselor and worked on a farm.

In 1959, Judge Mayer was appointed to the United States Military Academy at West Point by Representative William E. Miller. Under the tutelage of West Point's legendary coach, Carleton R. Crowell, he was a stalwart on West Point's cross-country team and its indoor and outdoor track teams, where he was a distance runner. His personal best mile was run in 4:10. The curriculum at West Point in that era was essentially prescribed for all cadets with emphasis on mathematics, science, and engineering, and he was awarded a Bachelor of Science degree in 1963.

Upon graduation from West Point, Judge Mayer was commissioned as a second lieutenant of Infantry in the Regular Army of the United States. He attended the Infantry Officer, Airborne, and Ranger schools before reporting for his first assignment with the 101st Airborne Division. He served first as a platoon leader under the command of one of the Army's brightest and most promising young officers, James E. Torrence, who was highlighted in Neil Scheehan's book, *A Bright Shining Lie*. By all objective indicia, this company became, and was recognized as, the finest in the division. He completed his airborne assignment as battalion air operations officer while Torrence, who tragically was later killed in Vietnam, was the brigade operations officer. Judge Mayer was also trained as a jump master and made twenty-three parachute jumps from military transport airplanes and helicopters.

In 1965, after attending the John F. Kennedy Special Warfare Center in North Carolina for training in counterguerrilla and commando operations, and studying Vietnamese at the Defense Language Institute in Monterey, California, then First Lieutenant Mayer was assigned as an advisor to a Ranger battalion in Vietnam. He participated in combat operations in the central and southern part of that country during his tour of duty. His battalion was the only one in the theater without a base camp and was on continual maneuvers from sector to sector. He was awarded a Bronze Star Medal, Combat Infantry Badge, Ranger Combat Badge, and various campaign and service ribbons for his efforts, and was promoted to captain.

Upon his return from Vietnam in 1966, Judge Mayer married Mary Anne McCurdy of Huntsville, Alabama, whom he had met two years earlier when she was an undergraduate at what is now Jacksonville State University. They moved to Monterey, California, where Judge Mayer served as an electronics engineer and project officer on research and development projects for the Army and in contract administration and dispute resolution at Fort Ord and the Hunter-Liggett test facility near San Luis Obispo. He also served as commander of a company of 400 soldiers stationed at the two military installations.

In 1968, Judge Mayer took extended leave from the Army to attend law school at the Marshall-Wythe School of Law of the College of William and Mary in Virginia. He served as editor-in-chief of the William and Mary Law Review and was inducted into Omicron Delta Kappa, the national leadership association. He graduated first in his class and received the Juris Doctor degree in 1971, in which year he was also admitted to the bar of Virginia.

Upon graduation from law school, Judge Mayer served as a law clerk to Judge John D. Butzner, Jr., of the United States Court of Appeals for the Fourth Circuit in Richmond, Virginia, from 1971 to 1972. He was the first Regular Army officer to clerk for a federal judge. As such he was assigned to the court as an active duty officer on military orders.

Following the clerkship, Judge Mayer, by this time a major and having transferred from the Infantry to the Judge Advocate General's Corps upon admission to the bar, returned to the traditional Army. In 1972-1973, he completed coursework and a thesis and was awarded a masters level diploma from the Judge Advocate General's School at the University of Virginia School of Law. From there, he reported to the largest and busiest law office in the Army, at Fort Knox, Kentucky, where he served variously as chief defense counsel, chief of criminal justice administration, and deputy and acting staff judge advocate from 1973 to 1975. As chief defense counsel he was responsible for the lawyers who defended the accused at courts martial in this 40,000-person military community. He defended or supervised the defense of those charged with common law felonies and military offenses. As the chief of justice administration he had similar responsibilities on the prosecution side.

While officially assigned as the deputy staff judge advocate, Judge Mayer in fact acted mostly as the staff judge advocate, a position normally encumbered by officers of higher rank and greater experience. However, at the request of the commanding general the Judge Advocate General authorized Judge Mayer to serve in this exceptional assignment. He administered a law office of eighty persons, including more than thirty-five lawyers. Among his responsibilities were advising the command during civil disturbances in a major city and during military assistance to civilian communities in the aftermath of devastating tornadoes; advising the administration and staff doctors at the general hospital; advising the school board; supervising police activities and coordinating with federal law enforcement agencies and prosecutors; labor relations; contracting for goods and services; administering the criminal justice and federal tort claims systems; providing legal assistance to active and retired service members; and implementing the Vietnam amnesty program.

Two children were born to the Mayers at Fort Knox, Anne Christian, in 1973, and Rebecca Paige, in 1975. In the latter year, Judge Mayer resigned his commission in the Regular Army and was recommissioned in the Army Reserve. He served until retiring in 1985 as a lieutenant colonel, a total of twenty-two years, Active and Reserve. During this phase of his career, he was certified as a military judge. In addition to his awards and decorations for service in Vietnam, he also earned a Meritorious Service Medal and an Army Commendation Medal with Oak Leaf Cluster.

When he left the active Army in 1975, Judge Mayer entered private law practice with the firm of McGuire, Woods & Battle in its Charlottesville, Virginia, office. The firm was Virginia's second largest with its main office in Richmond. He engaged in a broad range of civil litigation and trial practice, including civil rights, wrongful death, medical malpractice, labor, contract, real estate, pension and profit sharing, and libel and slander cases. At the same time, he was a lecturer in trial advocacy at the University of Virginia School of Law.

In 1977, Judge Mayer was selected by the Chief Justice of the United States, Warren E. Burger, to be his Special Assistant. As the senior lawyer on the staff of the Chief Justice, his duties required him to work in close cooperation with the law clerks to the Chief Justice and to other Justices, as well as with the other Justices and officers of the Court and officials at the Administrative Office of the United States Courts and the Federal Judicial Center. His service to the Chief Justice included participation in the review of petitions for certiorari, research and drafting of memoranda and opinions, providing views on cases during the evolution of the decision-making process, and coordinating the activities of members of his staff in the interest of efficiency and timeliness.

Judge Mayer's professional relationship with the Chief Justice, and with other Justices, was of a confidential nature, involving primarily judicial and legal matters. However, there were certain supervisory and managerial responsibilities attendant upon the office. Among these, for example, was responsibility for the preparation of reports on the petitions for certiorari filed with the Court, which was accomplished by the law clerks for five of the Justices "pooled" for this limited purpose under his supervision. He also oversaw the activities of the Conference Coordinator, who was responsible for the regular conferences of the Justices. He participated in some matters involving the Congress and executive agencies. For example, among the tasks he performed was serving as the personal representative of the Chief Justice in the establishment of the United States Foreign Intelligence Surveillance Courts.

After more than three years at the Supreme Court, Judge Mayer returned to private law practice. He was admitted to the bar of the District of Columbia, and joined the firm of Baker & McKenzie, the world's largest. In its Washington office, he embarked on a corporate and litigation practice.

No sooner was he established with the firm, when he was asked to serve as the deputy to the first presidentially appointed and confirmed Special Counsel of the recently created United States Merit Systems Protection Board, Alex Kozinski, later a judge on the United States Court of Appeals for the Ninth Circuit. He served in that capacity and for a short time as Acting Special Counsel by designation of the President until President Reagan appointed him to the United States Claims Court in December of 1982.

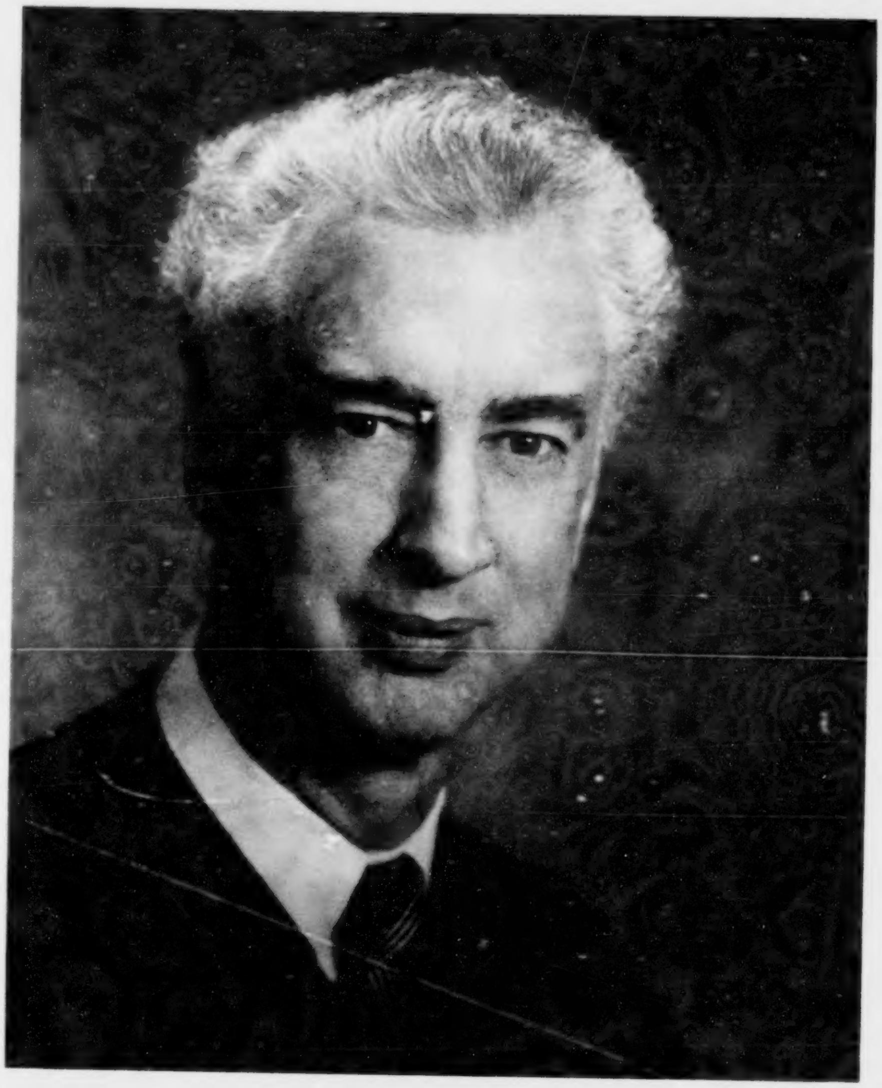
On June 15, 1987, the President appointed Judge Mayer to the United States Court of Appeals for the Federal Circuit, and he assumed the duties of the office on June 19, 1987. The formal investiture took place on July 9, 1987, and fittingly was presided over by Chief Justice Burger, the person responsible for bringing Judge Mayer to Washington in the first place.

At the ceremony, Judge Eugene R. Sullivan, later Chief Judge of the United States Court of Military Appeals, said of Judge Mayer: "In large part, he was shaped by the Army and West Point. 'Duty, Honor, Country' is West Point's motto. Judge Mayer will not shirk from doing his duty; he will choose a tougher right rather than the easier wrong even though he'd be a lone dissenter. He will uphold the honor of this court with integrity as he has throughout his life. He will serve his country as he has before, only this time it is in the high position of a circuit judge. 'Duty, Honor, Country.' Those qualities are in his heart."

STAFF OF JUDGE MAYER

SECRETARIES:	Beverly J. Martin	Apr. 13, 1987—May 19, 1989
	Patricia L. Massey	May 22, 1989—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Schaengold, Michael J.	1987-88	Sutherland, Asbill & Brennan 1275 Penn. Ave., NW. Washington, DC 20004-2404
Long, Lisa M.	1987-88	Fried, Frank, Harris, Shriver & Jacobson 1001 Penn. Ave., NW. Washington, DC 20004
McGinty, Kathleen A.	1988-89	Senator Albert Gore, Jr. United States Senate Russell Bldg. Washington, DC 20510
O'Donnell, Michael R.	1988-89	Riker, Danzig, Hyland & Scherer One Speedwell Ave. Morristown, NJ 07960
Miller, Elizabeth A.	1989-90	Kirkland & Ellis 655 15th St., NW. Washington, DC 20005
Scherkenbach, Frank E.	1989-present	
Maher, Anne Marie	1990-present	



Paul Redmond Michel

JUDGE PAUL REDMOND MICHEL

Paul R. Michel was born February 3, 1941, in Philadelphia, Pennsylvania, son of Lincoln M. (1911-1972) and Dorothy (Kelley) Michel (b. March 31, 1909), both from Glen Ridge, New Jersey. His father was executive vice president of the Reliance Insurance Company in Philadelphia until 1967 and, later, of the Excess Treaty and Management Company, a New York City reinsurance firm similar to Lloyd's of London. Paul Michel's mother, author of numerous articles and columns, was a Phi Beta Kappa graduate of Smith College in 1931. His father graduated from Williams College in Williamstown, Massachusetts, in 1932. Paul Michel also went to Williams College, majoring in political science and graduating in June 1963, followed by law school at the University of Virginia where he graduated in June 1966. Ever since, he has been in government service.

While still in law school, he was hired by the newly elected District Attorney of Philadelphia, Arlen Specter. In March and June 1967, he was sworn in as an Assistant District Attorney and a member of the bar of the Supreme Court of Pennsylvania. He took a leave of absence to serve in the Army Reserve. After completing basic training as an enlisted man, he was commissioned a second lieutenant in Civil Affairs and underwent six years of part-time training in the military government of occupied nations. After returning to the District Attorney's Office, he headed first the Motions Division and then the Adult Prosecution Division until 1972 when he was named Deputy District Attorney for Investigations. In that position, he directed a nineteen-month special investigating grand jury probing alleged corruption among state and city officials at high levels.

This work led to his appointment by Leon Jaworski as an Assistant Special Watergate Prosecutor in March 1974. He directed what was known as the Hughes-Rebozo investigation into a presidential slush fund allegedly maintained by Charles "Bebe" Rebozo, President Nixon's banker friend, and Rosemary Woods, the President's secretary, with cash from Howard Hughes and other multimillionaires.

In 1975-1976, he was an assistant counsel to the new Senate Intelligence Committee where he helped supervise investigations, prepare public hearings and frame legislative recommendations concerning certain practices of questionable legality directed at U.S. citizens by the CIA, FBI, IRS, and NSA.

In April 1976, he was appointed deputy chief of the Public Integrity Section of the Justice Department, newly formed by then Assistant Attorney General Dick Thornburgh. He directed the two-year "Koreagate" investigation into alleged illegal cash payments to over 100 Members of Congress, traveling twice to Korea, first to help negotiate a Mutual Prosecution Assistance Agreement and, later, to depose Tong Sun Park during January 1978. Pursuant to the agreement, Park was returned to the United States for testimony before the congressional ethics committees and a federal grand jury. Various prosecutions and reforms followed.

In July 1978, then Deputy Attorney General Benjamin R. Civiletti appointed Paul Michel an Associate Deputy Attorney General. In this post, Michel helped Civiletti, and Civiletti's successor, Judge Charles B. Renfrew, supervise the U.S. attorneys, the FBI, the Law Enforcement Assistance Administration and other units of the Department. From 1978-1981, Michel also coordinated the government's domestic counterterrorism program, monitoring terrorist incidents such as airline highjackings and serving as vice chair of the Executive Group to Combat Terrorism. During this period, he was also in charge of the drafting of a proposed legislative charter for the FBI. Although it was never enacted into law, much of the proposal was later implemented as Attorney General guidelines or internal FBI directives. He also helped draft Attorney General guidelines on the conduct of various types of investigations and testified frequently before the judiciary committees of the House and Senate on the guidelines and the proposed FBI charter. From December 1979, and through February 1980, Attorney General Civiletti designated him Acting Deputy Attorney General, the second ranking official in the Department of Justice.

In April 1981, newly elected U.S. Senator Arlen Specter asked Michel to serve once again as one of his top advisors. From then until his appointment to the court, March 4, 1988, Paul Michel was counsel and administrative assistant to Senator Specter. During these years, he helped frame legislative proposals on court reform, superpower summits, arms control, the war powers act, crime control, prison reform, counterterrorism, industrial revival and international trade. He and Senator Specter co-authored an article on career criminals for the *Annals of the American Academy of Political and Social*

Science. In 1987-1988, he was involved in an extensive review of the legal interpretation of the Anti-Ballistic Missile Treaty of 1972.

Judge Michel's appointment to the court allowed him to pursue an interest in intellectual property law derived from his uncle, George B. Turner (1911-1982), until his death a partner at Cravath, Swaine & Moore in New York City, who specialized in patent and antitrust matters. Judge Michel's brother, Peter (b. February 11, 1943), president of Brinks Home Security, Inc., and a former White House domestic policy aide from 1971-1973, and from 1973-1975 an official at the Department of Housing and Urban Development, also influenced Judge Michel's interest in the United States Government and commitment to a federal career. In addition, Judge Michel's study of legal issues affecting the Federal Government reflected his work with the inspector general system concerning government contracts and benefit programs, his work on the Cuban-Haitian immigration emergency in 1980, including supervising security at five refugee camps and matters such as mass demonstrations in Washington and removal of federal officials, on which he worked with successive counsel to the President.

On June 19, 1965, Paul Michel married Sally Ann Clark of Los Altos, California (b. July 13, 1941), by whom he has two grown daughters, Sarah (b. October 5, 1967) and Margaret (b. July 2, 1969). The marriage ended in divorce in 1987. On December 2, 1989, he married Dr. Elizabeth Morgan (b. July 9, 1947). Judge Michel's new wife and stepdaughter, Hilary, are the subject of numerous articles, TV specials, books and movies concerning the need for better protection of children who are victims of child abuse. During 1990, Hilary and her mother resided in New Zealand. Dr. Morgan and Judge Michel are members of St. Alban's (Episcopal) Church in Washington, D.C., where they were married and where they both have taught Sunday school.

After being raised with his three brothers (Mark, Peter, and Timothy) in Wayne, Pennsylvania, a suburb of Philadelphia where he lived from 1945 to 1965, and being educated in public schools there, Judge Michel developed an attachment to Virginia. Ever since writing a college paper on Thomas Jefferson's correspondence with John Adams, Judge Michel has studied the legal and political philosophy of the university's founder. In addition to attending law school at the

University of Virginia, Judge Michel resided in McLean, Virginia, from 1974-1989. His presidential commission identifies him as "of Virginia." Currently, however, he resides in Washington, D.C.

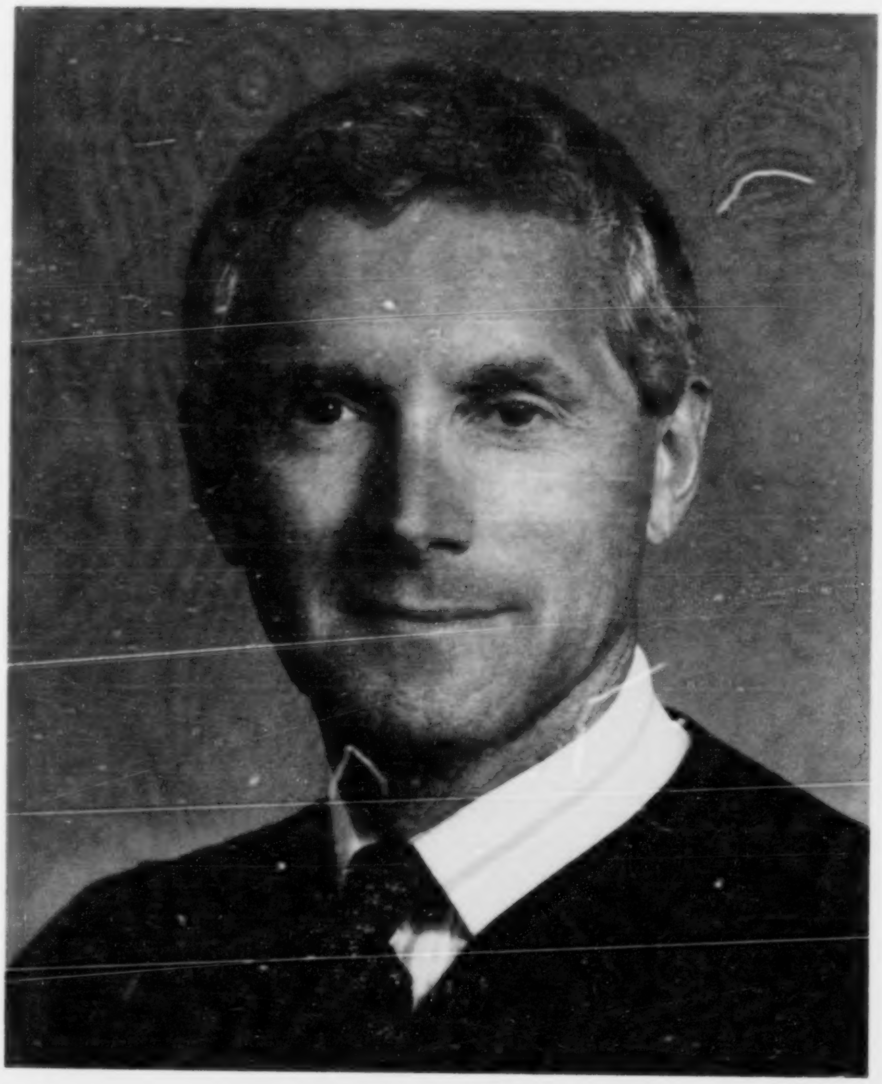
Judge Michel, who was the least senior member of the court from his appointment in 1988 until 1990, has since entered the middle range of seniority. He has lectured widely to lawyers' groups and judged numerous moot courts and demonstration appellate arguments, including for the American Intellectual Property Law Association and the Giles S. Rich Moot Court Competition.

STAFF OF JUDGE MICHEL

SECRETARY: Barbara B. Florence . . . . Apr. 4, 1988—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Stanley, Richard L.	1988-88	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Smith, James D.	1988-89	Arnold, White & Durkee 400 One Bering Park 750 Bering Dr. Houston, TX 77057
Rice, Margaret M.	1988-89	Shaw, Pittman, Potts & Trowbridge 2300 N St., NW. Washington, DC 20037
Koclanes, Peter G.	1989-89	Simpson, Thacher & Bartlett 425 Lexington Ave. New York, NY 10017
Ascue, Denitta D.	1989-90	Rogovin, Huge & Schiller 1250 24th St., NW. Washington, DC 20037-1124
Lauroesch, Mark W.	1989-90	Finnegan, Henderson, Farrabow, Garrett & Dunner Franklin Square Bldg. 1300 I St., NW. Washington, DC 20005-3315
Lapiana, John K.	1990-present	

LAW CLERKS: *(Cont'd)*	**Period of Clerkship**	**Address as of mid-1990**
Haungs, Michael J.	1990-present	



S. Jay Plager

JUDGE S. JAY PLAGER

S. Jay Plager, lawyer, administrator, and educator, graduated from the University of North Carolina in 1952. A philosophy major, he attended Chapel Hill on a Navy scholarship in the prestigious Holloway Fellows Program. Upon graduation, Plager was commissioned an ensign, United States Navy, and began his active duty service. Three years later, upon completion of his active duty, Plager joined the Naval Reserve where he spent sixteen years, ending his service with the rank of commander.

In 1955, Plager followed his family to Florida where he attended the University of Florida College of Law. He graduated from the University of Florida first in his class, with high honors, Phi Beta Kappa, Phi Kappa Phi, Order of the Coif, and as editor-in-chief of the Florida Law Review. In 1959 he accepted a Charles Evans Hughes Fellowship at Columbia University School of Law where he completed the post-graduate LL.M. degree in law.

Upon graduation from law school, Plager was recruited for a law faculty appointment at his alma mater. In the past twenty-five years, he has taught at the University of Florida, University of Illinois, University of Wisconsin, and Indiana University-Bloomington Schools of Law; he was a Visiting Scholar at Stanford University School of Law and at Cambridge University in England.

During that time, Plager's public service activities included chair (and earlier member) of the city of Gainesville (Florida) Planning Commission (1962-1963); member, city of Urbana (Illinois) Planning Commission (1966-1970); special counsel, Northeastern Illinois Metropolitan Area (Metropolitan Chicago) Planning Commission (1965-1967); and member, Zoning Committee, Illinois State Bar Association (1966-1970).

Plager has always been interested in the preservation of our country's natural resources and the protection of the environment, and to that end served as counsel to the Florida Department of Water Resources (1960-1961); member, National Air Pollution Manpower Development Advisory Committee, U.S. Environmental Protection Agency (1971-1975); member, Federal Hearing Panels on a national noise abatement program sponsored by the U.S. Environmental Protection Agency (1971); chair and project director, Illinois Task Force on Noise, Illinois Institute for Environmental Quality (1974-1977); and as consultant on a National Airport Noise Abatement Program, U.S. Environmental Protection Agency (1974-1977).

In 1977, Plager was appointed Dean of the Indiana University-Bloomington School of Law, where he served as Dean for seven years. While at Indiana he was active in state bar activities, and served on the board of directors of the Indiana Continuing Legal Education Forum (1977-1984) and the Indiana Bar Foundation (1977-1984). He is also a former member of the House of Delegates, Indiana State Bar Association (1977-1984).

In 1986, Plager accepted appointment in Washington as counselor to the Under Secretary of the Department of Health and Human Services. While at HHS, he co-chaired the Task Force on Medical Liability and Malpractice, which published a report setting the national agenda for response to the malpractice crisis.

In 1987, Plager was appointed associate director of the Office of Management and Budget in the Executive Office of the President. In that capacity he had oversight budget responsibility for approximately half of the federal budget, covering the Departments of Education, Labor, HHS, Veterans, and a number of smaller agencies. In 1988, he was nominated by President Reagan and confirmed by the Senate as the Administrator of the Office of Information and Regulatory Affairs within the Office of Management and Budget. In this position, he was responsible for oversight of the federal regulatory programs of the major federal agencies, as well as the paperwork review and information resource management programs of the Federal Government. He served as Executive Director of the Task Force on Regulatory Relief that then-Vice President Bush chaired.

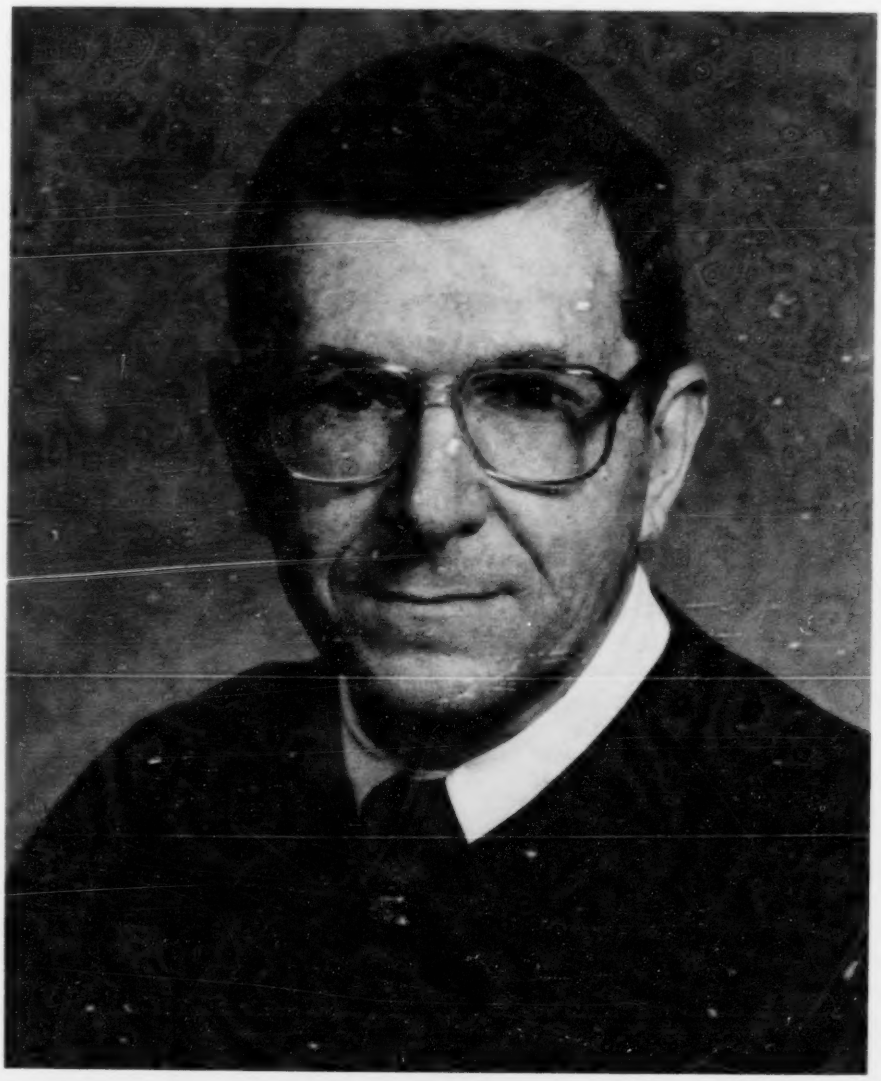
Plager continued to serve as Administrator of OIRA in the Bush Administration. In 1989 he was nominated by President Bush and confirmed by the Senate as Circuit Judge, U.S. Court of Appeals for the Federal Circuit, the position he currently holds. In addition to his service on the court, Judge Plager is also a council member, American Bar Association Section of Administrative Law and Regulatory Practice; member, then special counsel of the Administrative Conference of the United States; and a member, Prettyman-Leventhal American Inn of Court.

Judge Plager is married to Ilene H. Nagel, professor of law and Commissioner, U.S. Sentencing Commission. He has three children: Anna, manager, Natural Resources Department, State of Alaska; David, assistant professor of Pediatric Ophthalmology, Indiana University Medical Center; and Daniel, vice president, Citibank, New York.

STAFF OF JUDGE PLAGER

SECRETARY: Donna L. Boelsterli . . . . Jan. 29, 1990—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Kaplan, Lawrence	1990-90	Willian Brinks Olds Hofer Gilson & Lione 455 N. Cityfront Plaza Dr. Chicago, IL 60611
Wieder, Bruce	1990-present	
Blackman, Scott	1990-present	



Alan D. Lourie

JUDGE ALAN D. LOURIE

Alan D. Lourie was born in Boston, Massachusetts, on January 13, 1935, the first son of Joseph and Rose (Hurwitz) Lourie. He grew up in nearby Brookline, Massachusetts, and attended public schools there, graduating from Brookline High School in 1952. He then attended Harvard College, where he majored in chemistry and was active in the Harvard band, playing first trombone. Upon receiving his A.B. degree in 1956, he went to the University of Wisconsin, from which he received the degree of Master of Science in organic chemistry in 1958. He then worked as a chemist for the Monsanto Chemical Company in St. Louis, Missouri, from 1957 to 1959.

In 1959, he moved to Philadelphia where he married the former L. Elizabeth D. Schwartz, whom he had known when he was a student at Harvard and she a student at Wellesley College. He also began work at Wyeth Laboratories in Radnor, Pennsylvania as a chemist, later moving into a position as a literature scientist and then as a patent liaison assistant. He also began part-time work on a Ph.D. in organic chemistry at the University of Pennsylvania. That work was in due course completed and Judge Lourie received his degree in 1965, by which time he had passed the examination of the United States Patent Office to become a patent agent and accepted a position as patent agent with the then Smith Kline and French Laboratories in Philadelphia.

The newly degreed Dr. Lourie, while continuing his work at Smith Kline, entered Temple Law School in 1965 to pursue evening study for a law degree. That was completed in January 1970. Following that final completion of ten years of part-time education while working professionally during the day, Judge Lourie rose through the ranks at what had become SmithKline Corporation and then SmithKline Beckman Corporation and served first as patent attorney and ultimately as vice president of Corporate Patents and Trademarks and Associate General Counsel.

He was active in professional organizations, serving as president of the Philadelphia Patent Law Association in 1984-1985, member of the board of directors of the American Patent Law Association in 1982-1985, and treasurer of the Association of Corporate Patent Counsel in 1987-1989. He held various committee chairmanships in the American Intellectual Property Law Association, American Bar Association, and Pacific Industrial Property Association. He served on the board of directors of Intellectual Property Owners. He was active in trade associations, particularly the Pharmaceutical Manufacturers Association, where he served as chairman of the Patent Committee of the Law Section for five years. This occurred during the time when the Drug Price Competition and Patent Term Restoration Act of 1984 was being developed and he played a key role in advising individuals in both the private sector and government concerning that legislation. He has since written and spoken widely, in this country and abroad, concerning the patent term restoration aspects of that law.

He was also chairman in 1988-1989 of the U.S. side of a patent task force on the U.S.-Japan Business Council with a goal of attempting to reconcile differences of opinion between industry people in the two countries concerning details of their respective patent laws.

Judge Lourie also worked closely with government officials on other aspects of United States and foreign patent law prior to his appointment to the bench. He advised government and private sector individuals on the process patent legislation that was finally enacted in 1988 and on patent harmonization. He served as a member of the United States delegation to the Diplomatic Conference on the Revision of the Paris Convention in 1982 and 1984. He was vice chairman of the Industry Functional Advisory Committee on Intellectual Property Rights for Trade Policy Matters of the Department of Commerce and the Office of the U.S. Trade Representative. This group regularly worked with government officials to assist in the negotiations of the Uruguay Round of the General Agreement on Tariffs and Trade and in bilateral discussions with other countries on patent matters.

He was also active in advising private and governmental groups on patent laws in other countries, and visited China, Japan, Canada, and West Germany for that purpose.

For many years, Judge Lourie was active in the Harvard-Radcliffe Club of Philadelphia, serving on its Executive Committee and as a chairman of a local Schools Committee interviewing applicants to the college. From time to time, he played trombone in community orchestras and has been an occasional golf and tennis player and more recently a jogger. His outside interests generally have been music, reading, sports, and current affairs.

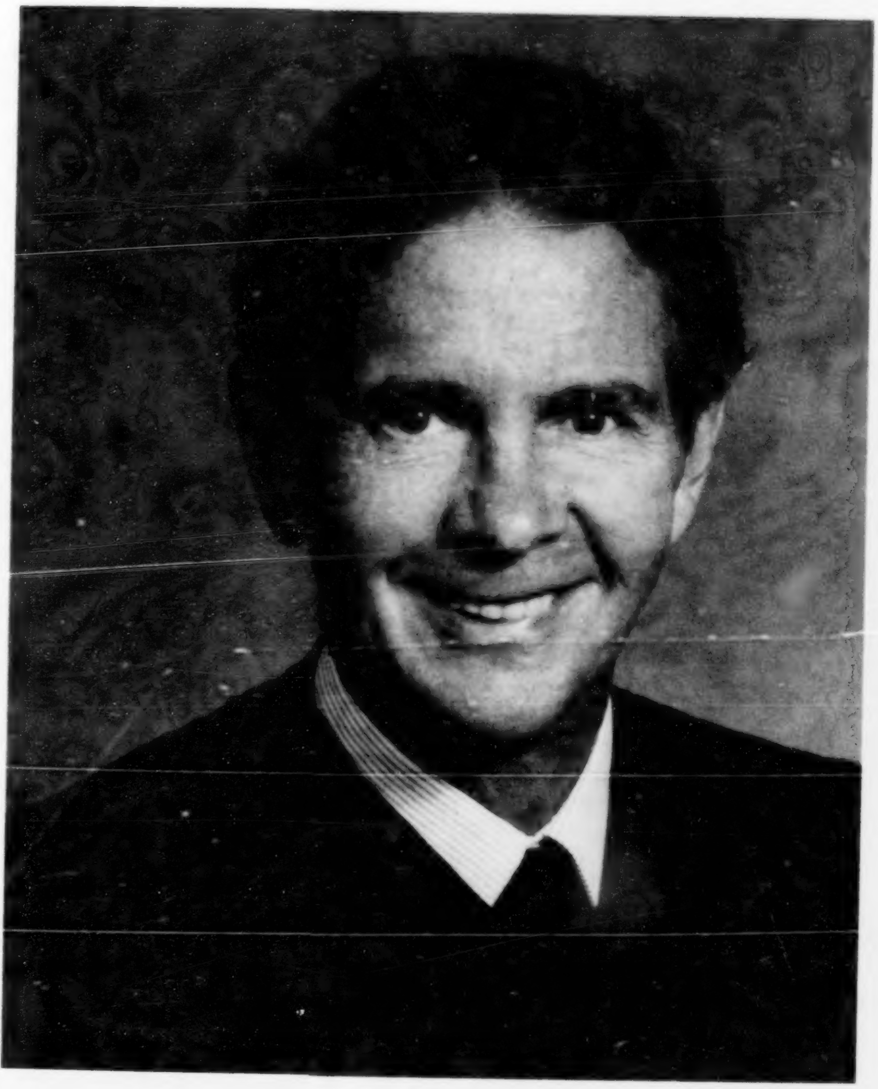
Judge Lourie was nominated to the Court of Appeals for the Federal Circuit by President Bush on January 25, 1990, his appointment having been supported by many patent attorneys and executives from industry and the private bar. His nomination was confirmed by the Senate on April 5, 1990, and his commission signed by the President on April 6. He was sworn in as a judge on April 11, 1990.

He and his wife Liz, who taught French for many years, have two girls. Deborah L. Rapoport of Rochester, New York, is a neurobiologist who graduated from Wellesley College in 1984 and received an M.S. degree in neurobiology from the University of Rochester in 1990. Linda S. Lourie, of New York City, is a museum curatorial assistant who graduated from Harvard-Radcliffe in 1987 and is working on her M.A. in Fine Arts from New York University. Deborah is married to Dr. Aaron P. Rapoport, a physician serving a fellowship in hematology. The Louries have two granddaughters, Julie and Laura Rapoport.

STAFF OF JUDGE LOURIE

SECRETARY: Betty A. Bunch . . . . . . May 7, 1990—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Barrow, Kenneth S.	1990-present	
Picollo, Joseph	1990-present	



Raymond C. Clevenger, III

JUDGE RAYMOND C. CLEVENGER, III

Raymond C. Clevenger, III, was born on August 27, 1937, in Topeka, Kansas, the son of R. Charles Clevenger (1909-1975) and Mary Margaret (Ramsey) Clevenger (1911-1986). His father was born in Williamsburg, Kansas, where his grandfather was the president of the Williamsburg State Bank. His mother was born in Eldorado, Kansas, where his maternal grandfather was the proprietor of the Ramsey Ranch, situated eleven miles north of Eldorado on Highway 77 in DeGraff, Kansas. R. Charles Clevenger spent his entire career in banking and at his death was the chairman of the board of First Topeka Bankshares, Inc.

Raymond Clevenger attended the public schools in Topeka, Kansas, through his sophomore year in high school. He then attended and graduated from Phillips Academy, Andover, Massachusetts, in 1955. He spent his freshman year in college at Princeton University, transferring to Yale University at the beginning of his sophomore year. He graduated magna cum laude and Phi Beta Kappa from Yale College in 1959. During the academic year 1959-1960, he served as a Carnegie Teaching Fellow in the History Department at Yale University. From 1960 to the autumn of 1963, Mr. Clevenger was employed in the general banking division of the Morgan Guaranty Trust Company of New York. He attended the Yale Law School and graduated magna cum laude and Order of the Coif in 1966. After graduation from law school, he served as a law clerk for Mr. Justice Byron R. White at the United States Supreme Court.

In September of 1967, Mr. Clevenger joined the Washington, D.C., law firm of Wilmer, Cutler & Pickering as an associate. From 1972 to 1974, he worked in the London, England, office of that firm, and was admitted to the partnership of the firm on January 1, 1974. For the following twenty-three years, Mr. Clevenger enjoyed a diverse practice in federal administrative law. In January of 1990, President Bush nominated him to the United States Court of Appeals for the Federal Circuit. After Senate confirmation, he took his oath of office on May 3, 1990.

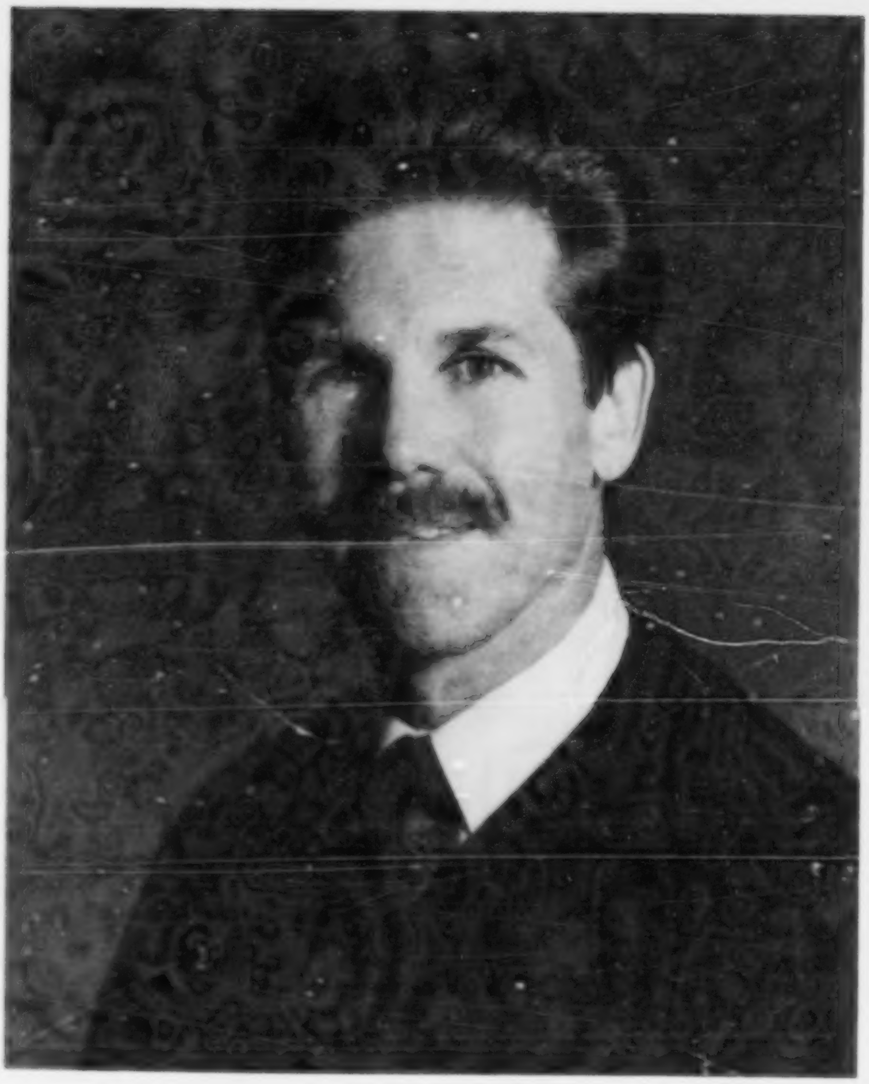
On September 9, 1961, Raymond Clevenger married Celia F. Faulkner, who had been born and raised in Washington, D.C., and was graduated from Vassar College in 1958. They are the parents of Winthrop Tate Clevenger, born in 1965. Winthrop is a graduate of Phillips Academy and Vassar College. They also are the parents of Peter Ramsey Clevenger, born in 1967. Peter is a graduate of Concord

Academy and attends Yale University. Judge Clevenger's marriage ended in divorce in 1987.

STAFF OF JUDGE CLEVENGER

SECRETARY: Judith D. Woolley . . . . June 11, 1990—present

LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Strobos, Jurriaan	1990-present	
Karaffa, Grace S.	1990-present	



Randall R. Rader

JUDGE RANDALL R. RADER

On April 21, 1949, in Hastings, Nebraska, Randall R. Rader was born to Raymond A. Rader and Gloria R. (Smith) Rader. Raymond, a coach, dreamt of basketball stardom for his eldest son. Gloria, a music teacher, envisioned a creative career for her first tenor. Randy disappointed both.

On June 12, 1990, President George Bush nominated Judge Randall R. Rader as a Circuit Judge for the United States Court of Appeals for the Federal Circuit. On August 14, 1990, Judge Rader assumed the duties of that office. At the time of his appointment, Randall Rader was a trial judge on the United States Claims Court.

Judge Rader tried cases for nearly two years on the Claims Court. Appointed by President Ronald Reagan, Judge Rader undertook service on this important national trial court on September 23, 1988. After one year, Judge Rader's challenging docket was current. In two years he made significant contributions to many areas of Claims Court jurisprudence.

Judge Rader became the first Claims Court judge in history to serve on a Judicial Conference Committee. In 1989, Chief Justice Rehnquist appointed him to serve on the Judicial Branch Committee. The committee sent the judge to represent the judiciary before the American Bar Association's Committee on Judicial Evaluation. To test the value of the ABA policies, Judge Rader sought a confidential evaluation from every attorney who had appeared in his courtroom. These attorneys sent their anonymous evaluations and suggestions for improvement to the Claims Court Clerk. This confidential process ensured candor. From this experience, Judge Rader obtained many helpful recommendations to improve the Claims Court's service to the public.

The Claims Court's Chief Judge also appointed Judge Rader to the court's advisory committee. In this capacity, the judge often delivered speeches to acquaint the public with the jurisdiction of the Claims Court. He also initiated improvements in the court's administration and relationship with the bar. In particular, Judge Rader helped streamline resolution of the Vaccine Compensation cases.

Before assuming this bench (as opposed to the bench he had warmed for several basketball teams), Judge Rader had served nearly nine years as a counsel on the United States Senate Judiciary Committee. During those years, he served as chief counsel of the Constitution

Subcommittee and Minority chief counsel of the Patents, Copyrights, and Trademarks Subcommittee. These positions offered him many opportunities to participate extensively in enactment of intellectual property, crime, court reform, civil rights, and other important legislation. During Judge Rader's tenure with the Senate Judiciary Committee, the Federal Bar Association honored him as its "Outstanding Younger Federal Lawyer" in 1983. In 1981-1982, he participated in enactment of the Federal Courts Improvement Act which established the Federal Circuit and the United States Claims Court.

For five years beginning in 1975, Judge Rader served in staff positions in the House of Representatives. At different times, he worked on Ways and Means Committee legislation and on Interior Committee legislation.

Judge Rader received his legal training at the George Washington University National Law Center where he graduated with honors. He earned his B.A. degree in English Literature from Brigham Young University where he graduated magna cum laude. Neither institution offered him a scholarship for athletics or music.

Judge Rader married the former Sheryl Fluckiger in 1974. They have four children, Larke, Sam, Lisa, and Andrew. The couple adopted three of their children.

Although the judge did not fulfill his parents' expectations, he never quit trying. He still aspires to be the first point guard for the Boston Celtics who can hit high C.

STAFF OF JUDGE RADER

SECRETARY:	Mary Catherine O'Connor	Aug. 14, 1990—present

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LAW CLERKS:	**Period of Clerkship**	**Address as of mid-1990**
Bryan, Matthew R.	1990-present	
Westergard, David	1990-present	

PART III

ORGANIZATION AND OPERATIONS

EXTRA-JUDICIAL ACTIVITIES

During the court's first eight years, its judges have contributed much to the administration of justice beyond their normal duties as judges of the court. In so doing, they have recognized that the court does not function in isolation, but as part of the country's judicial system. Hence, they have seen the maintenance and improvement of that system as both critical and deserving of their time and attention.

Judges of the court have served on the Judicial Conference of the United States, on its Executive Committee, and on the Advisory Committee on Codes of Conduct, the Committee on the Bicentennial of the Declaration of Independence, the Committee on the Bicentennial of the Constitution, the Committee on Court Administration, the Ad Hoc Committee on Cameras in the Courtroom, the Ad Hoc Committee on the Inns of Court, the Committee on the International Appellate Judges Conference, the Committee on the Judiciary, the Commission on the Judiciary Office Building, and on the Faculty and Board of the Federal Judicial Center.

Judges of the court gave scores of speeches to bar groups, law schools, university graduating classes, and the like, and contributed numerous articles to various legal publications. In addition to such "extra" judicial activities, judges of the court added to their own heavy judicial work by sitting with other courts of appeals, each of which had certified to the Chief Justice a need for assistance. During its first eight years, the court was assisted by twenty-eight judges of other courts (twenty-three of the twenty-eight in 1990) who sat with the court on a total of 101 days. *See* table E of the appendices. Two judges conducted trials in the district courts, again in response to a certified need.

The court held ninety-six monthly administrative conferences in its first eight years. Under the governing Standard Operating Procedures, the Chief Judge circulated an agenda at least three working days before each conference. Any judge could place additional items on the agenda before the meeting. The Chief Judge circulated the minutes within two days after each meeting.

Listed here are but some of the highlights concerning the organization and operation of the Federal Circuit. For further details, your attention is invited to sections which follow.

THE OFFICE OF THE CLERK

Francis X. Gindhart, Clerk

George E. Hutchinson was appointed as the first Clerk of the United States Court of Appeals for the Federal Circuit. He previously served as the Clerk of the Court of Customs and Patent Appeals, one of the predecessor courts. Other employees of that court together with employees of the United States Court of Claims, the other predecessor court, were appointed to the remaining positions in the Clerk's Office. Francis X. Gindhart was appointed the second Clerk upon Mr. Hutchinson's retirement in 1985. The remaining members of the original staff are Diane M. Frye, now the Chief Deputy Clerk; Pamela J. Twiford, now the Financial Deputy and Annual Judicial Conference Administrator; Spencer C. Greene, Charles Ricks and James Benjamin, Deputy Clerks; James Hall and Carl Scott, Courtroom Deputies; and Philip Fobbs and Joseph Fobbs, Mail Clerks. Dorothy I. Myers, the first Chief Deputy Clerk, also retired in 1985. Margaret Y. Makino, who served as secretary to Circuit Judge Shiro Kashiwa until his retirement, later served in the Clerk's Office until her own retirement in 1989. Other Clerk's Office employees have moved on to positions in the courts: Betty Bunch and Mary Catherine O'Connor to circuit judges' secretaries; W. Richard Sienkiewich, Aristia Karas and Kathleen M. O'Connor to the United States Claims Court staff. Elizabeth J. Carroll, a docketing supervisor, accepted a position as a teacher in the District of Columbia Public Schools.

The Clerk's Office serves as the gateway to and from the court. Appeals and petitions are first presented to the Clerk's Office for filing and docketing. Briefs and appendices, and motions, are also filed there and examined for procedural sufficiency before they are sent to the court. The Clerk's Office also manages the oral argument schedule. Some procedural rulings have been delegated to the Clerk.

The court's docket is maintained publicly in the Clerk's Office. The docket is a chronological record of the filings and actions in every appeal. The docket summarizes the information contained in the notices, correspondence, motions, and orders in each appeal file. The briefs and appendices in each appeal are also available to the public. The automated information system of the Clerk's Office provides a party index, generates the statistics published by the court and provided to the Administrative Office of the United States Courts, and produces a wide variety of case management reports.

The Clerk's Office also maintains the roll of attorneys admitted to practice before the court.

Judicial Workload

Information about the workload of the U.S. Court of Appeals for the Federal Circuit is published regularly. The court provides data to the Administrative Office of the United States Courts for publication in *Federal Judicial Workload Statistics*, a semiannual report (quarterly before 1989) on the business of the federal courts. The latter information also appears in the *Annual Report of the Director of the Administrative Office of the U.S. Courts*. In addition, since 1988, the court has published its own report, now issued annually: *The First Two Thousand Days* (1988), *The Seventh Year* (1989), and *The Eighth Year* (1990). The court's reports contain detailed information about filings and dispositions, processing times, and caseload changes over time. The impact of the various types of cases within the court's jurisdiction upon the public, the bar, and the court is also analyzed.

Judicial workload profiles for the regional courts of appeals and a national circuit profile based on the regional circuits are published by the Administrative Office of the U.S. Courts in *Federal Court Management Statistics*. These profiles do not include the workload of the Federal Circuit. The comparable judicial workload profile for the Federal Circuit for the period 1985 to 1990 is contained in the accompanying tables. The judicial workload profile addresses overall workload statistics, actions per active judge, actions per panel, median times, and other workload per judgeship.

The court's workload arises from a wide variety of sources. The yearly filings from each source are also listed in an accompanying table.* The busiest filing year was 1985, the year in which the appeals arising out of the infamous PATCO strike were filed. The most important change in filings is the relative increase in appeals from the district courts, as these are the most difficult appeals and take the longest time to decide.

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*These tables do not include entries in the Prisoner and Criminal categories because no such appeals are within the court's jurisdiction. The All Other Civil category includes appeals from the United States district courts, the Court of International Trade, the Claims Court, and the Court of Veterans Appeals. The Administrative category includes all other appeals and petitions for review. Thus, for the categories in which the court deals with matters similar to those before the regional courts of appeals, the data are comparable.

U.S. COURT OF APPEALS—JUDICIAL WORKLOAD PROFILE

FEDERAL CIRCUIT				TWELVE MONTH PERIOD ENDED JUNE 30					
				1990	**1989**	**1988**	**1987**	**1986**	**1985**
OVERALL WORKLOAD STATISTICS	APPEALS FILED	Total		1,467	1,417	1,299	1,340	1,290	2,506
		Prisoner		–	–	–	–	–	–
		All Other Civil		552	569	539	459	506	499
		Criminal		–	–	–	–	–	–
		Administrative		915	848	760	881	784	2,007
		Percent Change In Total Filings Current Year		Over Last Year . . .	3.5				
				Over Earlier Years . . .		12.9	9.5	13.7	-41.5
	APPEALS TERMINATED	Total		1,393	1,436	1,349	1,565	2,025	1,534
		Consolidations & Cross Appeals		139	119	88	97	118	78
		Procedural		574	642	498	540	640	583
		ON THE MERITS	Total	660	675	763	928	1,267	873
			Prisoner	–	–	–	–	–	–
			Other Civil	242	266	268	240	244	249
			Criminal	–	–	–	–	–	–
			Administrative	418	409	495	688	1,023	624
			Percent by Active Judges	71.6	84.0	81.0	83.0	85.0	89.0
	PENDING APPEALS			709	635	654	704	929	1,664
[1]ACTIONS PER ACTIVE JUDGE	Terminations on the Merits			283	225	254	309	427	262
	Procedural Terminations			25	31	27	38	39	18
	Written Decisions	Total		94	75	85	103	141	87
		Signed		41	38	44	54	69	59
		Unsigned		26	37	41	49	72	28
		Without Comment		28	0	0	0	0	0

[1] Includes only judges active during the entire 12 month period

U.S. COURT OF APPEALS—JUDICIAL WORKLOAD PROFILE

FEDERAL CIRCUIT				TWELVE MONTH PERIOD ENDED JUNE 30					
				1990	1989	1988	1987	1986	1985
			Number of Judgeships/ Number of Panels	12/4.0	12/4.0	12/4.0	12/4.0	12/4.0	12/4.0
			Number of Sitting Senior Judges	8	7	6	6	5	5
			Number of Vacant Judgeship Months	36	25	20	26	14	3
ACTIONS PER PANEL	APPEALS FILED		Total	367	354	325	335	323	627
			Prisoner	—	—	—	—	—	—
			All Other Civil	138	142	135	115	127	125
			Criminal	—	—	—	—	—	—
			Administrative	229	212	190	220	196	502
	APPEALS TERMINATED		Total	348	359	337	391	506	384
			Consolidations & Cross Appeals	35	30	22	24	29	20
			Procedural	148	160	124	135	160	146
		ON THE MERITS	Total	165	169	191	232	317	218
			Prisoner	—	—	—	—	—	—
			Other Civil	61	67	67	60	61	62
			Criminal	—	—	—	—	—	—
			Administrative	104	102	124	172	256	156
	PENDING APPEALS			177	159	164	176	232	416
MEDIAN TIME			Median Time From Filing Notice of Appeal To Disposition	6.8	7.1	6.8	7.9	8.7	6.9
OTHER WORKLOAD PER JUDGESHIP			Applications for Interlocutory Appeals	1	1	1	1	1	1
			Pro Se Mandamus Petitions	1	1	0	0	0	0
			Petitions for Rehearing	11	14	13	15	18	11

ANNUAL FILINGS BY SOURCE OF JURISDICTION

Source	1983	1984	1985	1986	1987	1988	1989	1990	TOTAL
AGR									0
BCA	31	60	57	66	77	83	96	84	554
CIT	21	37	35	35	39	56	68	39	330
CLM	80	155	227	144	118	146	112	172	1,154
COM	2				5	2			9
CVA								2	2
DCT	175	202	201	277	247	301	340	308	2,051
DVA								5	5
GAO									0
ITC	3	7	17	14	11	18	11	8	89
MSPE	247	534	1,796	579	676	538	590	687	5,647
PTO	143	137	137	125	112	119	151	131	1,055
RIT	21	15	36	50	55	36	49	31	293
TOTAL	723	1,147	2,506	1,290	1,340	1,299	1,417	1,467	11,189

Complaints of Judicial Misconduct or Disability

The complaint procedure established in 28 U.S.C. § 372(c) has been implemented by court rules. The original Rules for Processing Complaints of Judicial Conduct (1982) have been replaced by the Rules of the United States Court of Appeals for the Federal Circuit Governing Complaints of Judicial Misconduct or Disability (1987). The present rules correspond to the *Illustrative Rules Governing Complaints of Judicial Misconduct and Disability*, published by the Federal Judicial Center. The rules are available upon request.

As there is no judicial council in the Federal Circuit within the meaning of the judicial misconduct and disability statute, the statutory duties of the judicial council are performed by the active circuit judges of the court. Moreover, the Federal Circuit has no statutory role in matters involving the judicial misconduct or disability of the judges of the courts whose judgments are reviewed in the courts of appeals. Unlike the regional circuits, the Federal Circuit has no administrative responsibility under any statute for any trial courts.

The court reports on the filing of complaints to the Administrative Office of the United States Courts. From its founding in 1982 through mid-1990, some thirty-seven complaints were filed. Ten of the complaints were repetitive. Most were filed by losing pro se litigants who did not understand that the statute expressly excludes their dissatisfaction with the court's decision as a basis for complaining. Other complaints addressed the "lead case" procedure adopted by the court to handle the massive influx of air traffic controller cases after the PATCO strike and the alleged role of a circuit judge in a widely publicized child custody battle between his fiance and her ex-husband. All but one of the complaints have been dismissed as moot, frivolous, or directed to the merits of a case, or the action of the court was found to have been proper. In one complaint, a judge was advised to refrain from one aspect of the conduct complained of and so agreed. Nine dismissals were reviewed by the active circuit judges, and in every instance the initial actions of the Chief Judge or another judge acting in lieu of the Chief Judge were affirmed or the petition was dismissed. One complaint against all of the judges was initially reviewed in banc and found to be unsupported. In three complaints, additional relief was sought of the Judicial Conference of the United States, but no jurisdiction was found for further review.

Rules of Practice

Every appellate party is provided at no charge with a copy of the court's publication, *Rules of Practice Before the United States Court of Appeals for the Federal Circuit*. This publication contains the current Federal Rules of Appellate Procedure applicable to Federal Circuit practice, the court's own implementing rules known as Federal Circuit Rules, Practice Notes providing helpful guidance to appellate lawyers, the *Guide for Pro Se Petitioners and Appellants*, and forms. It is in looseleaf format. The court's rules are in the *United States Code Annotated*, published by West Publishing Company, and in *United States Code Service*, published by Lawyers Cooperative Publishing Company. The *Rules of Practice* is also distributed to those attending the court's annual judicial conference. The guide is also distributed at the court's request by the Merit Systems Protection Board with its decisions.

The *Rules of Practice* was first published in 1988, replacing two publications, *Rules of the United States Court of Appeals for the Federal Circuit* and the *Procedural Handbook*, which were initially issued in 1982 when the court opened. The local rules had been reissued in 1985 and again in 1987, and other amendments to the local rules became effective in 1987. The *Procedural Handbook* had been reissued in 1984. The *Rules of Practice* was revised once in 1988, was both revised and reissued in 1989 and 1990, and an exhaustive index was added in 1990. The guide was initially issued in 1987 and has since undergone several revisions.

The *Rules of Practice* incorporates the pertinent rules for the conduct of the business of the court and its operating procedures, in compliance with 28 U.S.C. § 2077(a). The court's Standard Operating Procedures, which cover a wide range of in-house minutiae, are not published.

Beginning with the original rules in 1982, the court's Advisory Committee has provided invaluable counsel in the development of the local rules and subsequent amendments to the rules. Starting in 1989, rules changes have required public notice and comment under the Rules Enabling Act, as amended by the Judicial Improvements and Access to Justice Act (Pub. L. No. 100-702). The court has provided the public notice required by the Act and has received comments on proposed rules changes. Many such comments have been incorporated in the rules finally adopted.

Memorial Sessions

Circuit Judge Oscar Davis, an original member of the court, passed away on June 19, 1988. He was memorialized in a special session of the court on October 5, 1988, reprinted at 866 F.2d LXXXVII.

Senior Circuit Judge Philip Nichols, Jr., also an original member of the court, passed away on January 25, 1990. He was memorialized in a special session of the court on April 6, 1990, reprinted at 910 F.2d LXXI.

Circuit Judge Jean Galloway Bissell, who served on the court from September 14, 1984, passed away on February 4, 1990. She was memorialized in a special session of the court on May 8, 1990, reprinted at 916 F.2d LXXIX.

THE ADMINISTRATIVE SERVICES OFFICE

Ruth A. Butler, Administrative Services Officer

The Administrative Services Office (ASO) was established in 1980 under the United States Court of Customs and Patent Appeals. At that time, and until the creation of the United States Court of Appeals for the Federal Circuit in 1982, there were four positions: Administrative Services Officer, Clerical Assistant, Printing and Records Management Clerk, and Assistant Printing and Records Management Clerk. In 1982 an Assistant Administrative Services Officer was appointed.

Just as the responsibilities of the entire court have grown since 1982, so have those of the Administrative Services Office. In 1982, it was decided by the court that the printing and distribution of opinions would be accomplished by the Administrative Office Printing Facility in Forestville, Maryland, after proofreading and processing by the ASO. In order for the Administrative Office to agree to this arrangement, it was agreed that the Federal Circuit would assign one of its employees to that area to assist in the increased workload. An employee of the ASO staff was then assigned to the Administrative Office in Forestville. In 1985, it was decided that the court could no longer distribute opinions to all interested parties due to the cost of the printing of opinions. At that time our employee was moved back to the court and the printing of opinions was done in-house on our machines. The court decided that it would go out of the subscription business. The task was becoming too large for the size of the office due to an increasing interest in the court's opinions and the increased responsibilities of the ASO. This required locating a vendor to take over the selling of opinion subscriptions to the public. There are currently at least two organizations that receive copies of the court's opinions for the purpose of selling them to interested parties. The court is not involved in the process and no money is received by the court.

The ASO has the responsibility of supplying publishers, government agencies, court libraries, the United States Claims Court, and our court with all published opinions, unpublished opinions, unpublished rule 36 judgments, and published orders, ensuring that all receive any errata that may come out after the issue date. The staff of the ASO has also become cashiers, responsible for the copying and selling of court hearing tapes and opinions to the general public, a service previously accomplished by the Clerk's Office. This service is on an individual request basis for a particular opinion or hearing tape, in contrast to a subscription service where an interested party pays an annual fee and receives copies of all of the court's opinions.

The ASO is responsible for keeping an up-to-date inventory on all equipment as well as all furniture located in the court. The office is also responsible for removing excess furniture and equipment from individual chambers to storage or to the General Services Administration.

Prior to the courts' merger, Court of Claims chambers were equipped with Wang word processing equipment on the secretaries' desks only. The CCPA had Lanier equipment. It was the responsibility of this office to survey the market and advise the Chief Judge on the best solution for making all chambers compatible. It was decided to purchase Wangs for the former CCPA chambers. In 1985-1986, the ASO arranged and supervised the wiring of chambers so that the secretary, law clerks, and judges were supplied with networked word processors. Networked word processors means that the word processors within the chambers were linked to each other and all could view and type on the same work product. In 1989, a computer strictly for use with Westlaw and Lexis services was installed in chambers of each judge. A further advance was made in early 1989 when laser printers were brought into chambers, reducing repairs and increasing quality and productivity. At the end of fiscal year 1989, it was decided by Chief Judge Markey that chambers should be equipped with networked computers. Computers, as opposed to word processors, have much more advanced user capabilities and each system can be made to fit the needs of the individual chambers. It was the ASO's responsibility to assess the court's initial needs and purchase equipment, software, consultation, training, and wiring services accordingly. In all cases, it was the ASO's responsibility to provide support where needed, i.e., ordering updated software and overseeing repair and maintenance of equipment. The court has authorized the purchase of laptop (portable) computers for judges when they so desire.

The Clerk's Office had its first computer installed in September 1985. Since that time eleven additional computers have been installed and the entire office has been networked. The Library, Administrative Services, Senior Technical Assistant, and Motions Staff Attorney offices have all been "computerized." Each chambers now has the option of being able to access Westlaw and Lexis from each computer located in chambers.

The increasing role of the ASO requires maintaining frequent contact with GSA, outside contractors, and the Claims Court. The ASO is responsible for issuing orders, with the approval of the Chief Judge, for all construction and electrical work and overseeing all contracted work and renovations, ensuring that specifications and deadlines are met.

In 1987, the ASO, working with the Claims Court, was responsible for the constructing and equipping of the gym for use by all building employees and the Federal Judicial Center employees. Use of the gym has grown annually since its opening in 1987. The gym was updated and renovated in 1990 with assistance and suggestions from Judge Plager. A healthy work force is essential to efficient operation of the court and reduces absences for sick leave.

A Health Unit, staffed by a nurse from 8:45 a.m. to 5:15 p.m., Monday through Friday, is located in the building, and services both courts and the Federal Judicial Center. Its services include physical examinations, allergy shots, health awareness information, and general emergency treatment. Although the nurses are compensated by the Department of Labor, funds are provided for this purpose from our annual appropriation, along with funding from the Administrative Office of the U.S. Courts for the Claims Court and funding from the Federal Judicial Center. The ASO includes this amount in the annual budget figures for this purpose.

In 1988, the court obtained the services of Court Security Officers (CSO) under the U.S. Marshals Service. The ASO is the chairperson for the building's security committee, ensuring that all the security needs of the court are met. This involves notifying CSOs of any visitors, visiting judges, contractors, new employees, etc., who will be entering the building, especially before or after regular working hours, notifying the security officers of special events in courtrooms and/or any extra security needs for special ceremonies, and having the Marshals Service run a security check on all contractors working in the building, all new employees in the cafeteria, and others as required.

In 1989, under the direction of Judge Nies (now Chief Judge), the cafeteria was reopened in the Tayloe House. The ASO is the contract manager for the building, dealing with the manager of the cafeteria. This entails dealing with GSA on purchasing and maintenance of cafeteria equipment and working with the manager of the cafeteria regarding his building maintenance needs.

The current employees of the ASO are: Ruth A. Butler, Administrative Services Officer, October 1, 1982 to present, who joined the staff of the Court of Customs and Patent Appeals in December 1972; Donna L. Raeder, Assistant Administrative Services Officer, October 4, 1982 to present, previously with the D.C. Circuit Clerk's Office; Regina R. Schade, Administrative/Financial Clerk, October 1, 1982 to present, joined the staff of the Court of Customs and Patent Appeals in October 1980; Phillip A. Hare, Printing and Records Management Clerk, May 4, 1987 to present, transferred from the United States Claims Court; and Jimmy Daniel, Jr., Assistant Printing and Records Management Clerk, who came to the court on August 13, 1990, from the Administrative Office, U.S. Courts, Personnel Division. Previous employees in the office since 1982 have been: Emanuel I. Graham, Printing and Records Management Clerk, October 1, 1982 until his retirement on June 29, 1990, joined the Court of Customs and Patent Appeals in June 1976; Joseph L. Johnson, Assistant Printing and Records Management Clerk, October 1, 1982 to June 2, 1986, retired on disability; Victor A. English, Assistant Printing and Records Management Clerk, December 2, 1985 to September 26, 1986; and Vincent A. Williams, Assistant Printing and Records Management Clerk, September 29, 1986 to March 19, 1987.

Other individuals who served the court with distinction in the years 1982-1990 were Charles L. Leath, John A. McDowell, and W. Eugene McLeod, all of whom implemented policies regarding daily building maintenance and control of garage parking.

In order to allow the judges' staffs and all other personnel of the court to devote their time to the speedy administration of justice, the Administrative Services Office has taken on a support role, providing all personnel payroll, supplies, budget, printing of opinions and all other materials, renovations, and furnishing other needs of the court.

Further duties of the ASO are summarized as follows: Works with the Chief Judge in formulating the annual budget of the court for submission to Congress. In 1988, the Administrative Services Officer began accompanying the Chief Judge and the Clerk to the annual congressional budget hearings. She works with the Chief Judge from the formulation of the budget through end-of-year money status. With the approval of the Chief Judge, the ASO is responsible for all purchases of the court, receipt of all invoices, preparation of all vouchers for the Chief Judge's signature, preparation of the monthly obligation sheet indicating the status of the court's appropriation, and all court functions pertaining to appropriated funds. The ASO works closely with newly appointed judges in the selection and purchase of furniture and furnishings, interviewing secretaries, and the renovations of chambers. The ASO works with contractors in the bidding of jobs throughout the court for renovations, ensuring that contractors meet time and service specifications, and supervises all functions of the office. She supervises and monitors closely the work of the Assistant Administrative Services Officer, Administrative/Financial Clerk, and the two Printing and Records Management Clerks.

In order to be of assistance to other members of the "court team" in making the most efficient and knowledgeable use of equipment, employees of the ASO have attended many training sessions offered by the Federal Judicial Center and other training organizations for computers, computer software, personnel workshops, opinion processing, voucher processing, telephone systems, and copier maintenance. They are also able to process inquiries about the new Federal Employees Retirement System and other problems relating to employee pay status and tenure.

THE BUDGET

Ruth A. Butler, Administrative Services Officer

The United States Court of Appeals for the Federal Circuit, like the United States Supreme Court, the United States Court of International Trade, and the Federal Judicial Center, prepares, justifies, and manages its own budget. All other courts and units within the judiciary are funded within the budget of the Administrative Office of the United States Courts.

Each year, the court prepares a budget reflecting funds needed to operate in the next fiscal year. The court is directly accountable to the Congress for its expenditures. The court keeps the Administrative Office of the U.S. Courts informed through the process of formulating its budget. Once Congress has approved the court's appropriation, all disbursements are administered by the Chief Judge.

The Chief Judge annually submits a Statement to the Committee on Appropriations of the House of Representatives and the Finance Committee of the United States Senate. The statement is the court's request and justification for funds for the next fiscal year. The Chief Judge appears before the House Subcommittee to discuss the statement and answer questions from Members of the Subcommittee.

The fiscal year begins October 1 and ends September 30. All moneys spent are approved by the Chief Judge. Upon approval, purchase orders are issued and signed by the Administrative Services Officer. Vouchers for payment are issued by the Administrative Services Officer and signed by the Chief Judge. All checks, except those constituting compensation, are signed by the Clerk of the court.

The court works within the guidelines of the Administrative Office of the U.S. Courts and all personnel actions are sent to that office for processing. Salaries of judges and staff are distributed by the Administrative Office, employing funds from the court's appropriation.

The court informs the Administrative Office monthly of funds obligated during the previous month and the current unobligated balance.

The Administrative Services Officer keeps the Chief Judge aware of the funds available at all times.

All operational needs of the court must be met from its annual appropriation. Those needs include building rent to GSA, cost of security officers, all telephone services, maintenance contracts, supplies, stationery, travel, furniture, equipment and books for the judges and the library. The court has never requested an appropriation greater than that required to meet the known needs of the court. Yet, careful management has enabled the court to return substantial funds to the Treasury at the end of each fiscal year of its life to date.

Within the areas under its control, the Federal Circuit has cost the taxpayer less to operate than any other circuit court of appeals, including those with fewer judgeships. Among items not within its control is a rental payment set unilaterally by the General Services Administration (GSA). Though it occupies substantially less space than do many circuits, the court pays the second highest rent to GSA. When that mandatory rental figure is included, the court is fifth in line in total expenditures. With that rental deleted and notwithstanding inclusion of other mandatory figures, the court has each year been at the bottom or second to the bottom of the list of disbursements by each of the thirteen circuit courts of appeals.

The court's annual budget began in fiscal year 1983 (October 1, 1982) with a figure of $4,406,000 increasing annually to the fiscal year 1990 figure of $8,830,000. The majority of the annual increase is due to mandatory inflationary factors, increases in rent and maintenance costs.

THE LIBRARY

Patricia M. McDermott, Librarian

The library of the United States Court of Appeals for the Federal Circuit took the place of the joint library of the United States Court of Claims and United States Court of Customs and Patent Appeals on October 1, 1982. The library's mission, stated simply, is to serve the reference and research needs of the judges of both the U.S. Court of Appeals for the Federal Circuit and the U.S. Claims Court.

Library Collection

To accomplish its mission, the library maintains a collection which reflects the jurisdiction of both courts. Thus, in addition to the standard federal legal materials, the collection includes treatises and reporters devoted to intellectual property, federal taxation, international trade, and government contracts. Of historical importance are: the complete collection of the *Code of Federal Regulations* dating to the first such compilation in 1938; the complete *Congressional Record* and its predecessors, the *Congressional Globe* and the *Congressional Debates*, in a combination of hard copy and microform, dating to 1789; and the *United States Code*, all editions since 1935. The library receives over ninety law reviews and periodicals. Finally, the library maintains a collection of legislative histories, the earliest being a compilation relating to the original Tucker Act of 1855.

Reference and Research Services

As indicated earlier, the library serves the judges and staff of the Federal Circuit and the Claims Court. Pursuant to rule 54 of the Rules of the Court of Appeals for the Federal Circuit, the library is open to members of the bar of the Federal Circuit and the Claims Court, government attorneys, staff of the Federal Judicial Center and the Administrative Office of the United States Courts, and pro se litigants in both courts. Thus, noncourt personnel may use the library between the hours of 9 a.m. and 5 p.m., Monday through Friday. A coin-operated photocopier is available for the convenience of the bar.

The staff provides standard reference services, which include: locating specific materials in the collection; explaining how to research through the *Code of Federal Regulations* and the *Federal Register*; compiling legislative histories; searching Lexis, Westlaw, Nexis and Dialog; locating needed materials in other libraries, and arranging to obtain them on interlibrary loan. The staff also maintains a file of articles relating to the Federal Circuit and the Claims Court. Access to this file is provided through a bibliography compiled through the use of Procite, a bibliographical software package. This software permits searching the bibliography by author, title, and subject key words. Currently, this bibliography contains over 500 articles.

Automation

Library automation falls into two categories: computer-assisted legal research (CALR) and automation of library functions.

CALR was first introduced in the courthouse with the installation of Lexis in the Office of the Senior Technical Assistant of the CCPA. The library staff assumed responsibility for overseeing and assisting with the use of Lexis on October 1, 1982. Contract negotiations for CALR services conducted with both Lexis and Westlaw by the Administrative Office of the U.S. Courts in 1982 resulted in the award of the contract to Westlaw. Consequently, by early 1983 the staff shifted gears to manage the transition to Westlaw. Quite a furor erupted within the judiciary when Lexis was withdrawn and replaced with Westlaw. However, both Lexis and Westlaw became available by the beginning of 1984 and remain available at present.

Initially, access to CALR was provided through two terminals installed in the library. By the end of 1988, a personal computer was installed in the chambers of each circuit judge through which both Westlaw and Lexis could be searched. Access to these systems includes the use of Shepard's citations, as well as Auto-cite and Insta-cite.

Automation of library functions has been accomplished in the areas of cataloging and circulation.

In 1984, the library joined the On-line Computer Library Center (OCLC), a system containing records of the cataloging of libraries, large and small, across the United States, Canada, and the United Kingdom. Tapping into this system has facilitated the cataloging and classification of the library's treatise collection. Participation in OCLC permits the library to locate other libraries which own books or periodicals which we can request through the interlibrary loan system.

In 1989, the library staff developed an on-line circulation system through the use of DBASE III+. Each item borrowed from the library is entered into this system. Use of the system enables the staff to generate statistical reports of the number and types of materials which circulate, as well as the ability to generate monthly overdue notices.

In addition to these specialized applications, the library introduced the use of word processing in the form of Multimate in 1984 and is currently in the process of switching to Wordperfect. Lotus 1-2-3 is utilized for budgetary tracking.

The library staff continues to evaluate the application of automation to library functions.

Library Staff

Prior to October 1, 1982, the library staff consisted of two professional librarians, one designated as the librarian of the Court of Claims and one the librarian of the Court of Customs and Patent Appeals. Beginning October 1, 1982, the staff consisted of three positions, Circuit Librarian, Assistant Circuit Librarian, and Library Technician.

The following individuals have served on the library staff:

Circuit Librarian, October 1, 1982 - present:

Patricia M. McDermott, A.B. St. Joseph's College, 1975;
M.L.S. Drexel University, 1980;
J.D. George Mason University, 1991.

Assistant Librarian, October 1, 1982 - present:

David J. Lockwood, B.A. State University of New York College at Fredonia, 1974;
M.L.S. University of Maryland, 1982.

Library Technicians:

D'Borah K. Hart, October 1, 1982 - February 9, 1990;
B.S. University of Maryland, 1979.

John D. Moore, May 26, 1987 - July 13, 1990;
B.A. University of Maryland, 1977.

Anne L. Salzberg, November 22, 1988 - present;
A.B. Bryn Mawr College, 1981;
M.A. George Washington University, 1990.

Martha Scheel, April 4 - May 27, 1983;
B.A. Northwestern University, 1971.

Carol McClintock, March 7 - June 17, 1988;
B.A. George Mason University, 1974;
M.L.S. The Catholic University of America, 1982.

The library staff, while continuing to meet the growing demands of its patrons, has lagged behind all other circuit courts in the growth of its staff. In fact, it ranks last among circuit libraries in the ratio of library staff to judicial officers.

In 1980, the Judicial Conference of the United States accepted a formula of one library staff position for every six judicial officers. Based on this formula, the court library should have seven positions. The currently authorized five positions represent a staffing at seventy-one percent of the approved staffing formula. The staff has done yeoman's service in meeting the research needs of the court and its staff.

Staff Professional Activities

Both the Librarian and the Assistant Librarian are members of the American Association of Law Libraries (AALL) and the Law Librarians Society of Washington, D.C. (LLSDC). In addition to attending programs sponsored by LLSDC, the Librarian and Assistant Librarian attend, with the court's financial support, the annual meeting of the AALL.

The Librarian's professional activities have included:

- President, Federal Law Librarians Special Interest Section, LLSDC, 1983-1984;
- Staff, *Law Library Lights*, Newsletter of LLSDC, 1982-1985;
- Chair, Membership Committee, LLSDC, 1985-1986;
- Chair, Nominations Committee, LLSDC, 1988;
- Member, Program Planning Committee, AALL Annual Meeting, 1985-1986;
- Co-author, chapter on Federal Income Taxation, *Specialized Legal Research* (Little, Brown, 1988).

The Assistant Librarian's professional activities have included:

- Author, "New Federal Courts," *Law Library Lights*, November 1982;

- Author, "Six Score and Six Years Ago . . . ," *Law Library Lights*, July 1986;
- Member, Nominations Committee, LLSDC, 1989;
- Member, Program Committee, "New Frontiers at 50," The Washington Conference marking the 50th anniversary of the LLSDC, 1989.

THE OFFICE OF THE SENIOR TECHNICAL ASSISTANT

Melvin L. Halpern, Senior Technical Assistant

The Office of the Senior Technical Assistant (STA) is an integral part of the court's staff. The STA position existed in the CCPA as Chief Technical Advisor, and it is expressly authorized by statute.

Section 715 of title 28 of the *United States Code* states that the Chief Judge of the Federal Circuit, with the approval of the court, "may appoint a senior technical assistant [STA] who shall be subject to removal by the chief judge with the approval of the court." The STA, in turn, "with the approval of the court, may appoint necessary technical assistants in such number as the Director of the Administrative Office of the United States Courts may approve, but in no event may the number of technical assistants . . . exceed the number of circuit judges in regular active service . . . ." As a practical matter, the hiring of technical assistants is limited by the court's budget, and in that regard the court must request congressional approval before increasing the number. When the court started, there was one technical assistant (TA) in addition to the STA; as of June 30, 1990, there were two TAs, one of which is designated Deputy STA, and a third has been approved.

The STA's office exists in addition to, and separate from, the judges' law clerks, i.e., the two law clerks typically employed by each active judge and one law clerk typically employed by each senior judge. The law clerks, who were designated "assistant technical advisors" at the CCPA,* serve in the traditional roles that law clerks have filled in courts of appeals for years. Of course, many of the law clerks have technical degrees, and in that regard they can assist their judges in technical as well as legal matters. A law clerk is directly responsible to the individual judge who hires him or her.

The STA's office, on the other hand, is responsible to all the judges, collectively, in the sense that any of the judges can utilize that office for its designated duties. Though under the direct supervision of, and occasionally given court-related projects by the Chief Judge, the office is available to assist all the judges on any legal or technical matter that may arise in any field of law within the court's jurisdiction. Thus, a judge might ask the STA's office to assist in reviewing a case before oral

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*See G. Rich, *A Brief History of the United States Court of Customs and Patent Appeals*, at 118-22 (1980).

argument, or to do legal research pertaining to a particular case, or to draft a memorandum for the judge's review.

Probably the most important aspect of the STA's office has been its participation in the court's process of trying to avoid conflict and confusion in published opinions. After a panel approves the author's opinion, but before it is published, the opinion is circulated for comments by the remaining judges and the STA's office on any arguable inconsistencies or confusion with prior published opinions. The author and panel can then consider those comments to see if they agree with them and if a change in the opinion is needed.

The STA's office also serves on the Evaluation Committee, together with the Clerk of the court. That committee reviews briefly each of the briefs on appeal in a case and fills out an appropriate "screening sheet" that is forwarded with the briefs to the panels. The screening sheet denotes the issues involved in the case and recommends whether the opinion should be published, whether there should be oral argument, and whether there should be an expanded panel. On all of these matters, of course, the panel makes the final decision.

The Office of the STA also assists the Office of the Motions Staff Attorney (MSA) in its work on stay motions, particularly in patent cases. When such motions are filed, the STA will assist the MSA by reviewing the probability of success factor applicable to stay motions. The MSA might then use that assessment in recommending a grant or denial of the motion to that month's motion panel.

Other aspects of the STA's office include these: (1) providing legal and technical assistance to law clerks, on an informal basis; (2) monitoring the court's compliance with its Affirmative Action Plan and serving as the Equal Employment Opportunity Coordinator; (3) helping the library maintain a suitable compilation of science and technical materials; and (4) serving as a liaison between law schools and the various chambers of the court in the recruitment of law clerks for the chambers. (The hiring of law clerks, though, is the distinct responsibility of the individual chambers.)

Because the STA's office offers technical *and* legal assistance, the technical assistants have always had both legal degrees and technical backgrounds. Melvin L. Halpern has been the Senior Technical Assistant since August 29, 1983. He has a law degree, a B.S. in chemistry, and an M.S. in organic chemistry. In addition, he has had varied legal experience, having worked as an examiner at the United States Patent and Trademark Office (PTO), a patent agent for the Department of the Navy, a law clerk at the United States Court of Claims, an attorney at a law firm involved primarily in antitrust and other nonpatent litigation, and an attorney at the Antitrust Division of the Department of Justice. His predecessor, Sherman Winters, was Chief Technical Advisor at the CCPA from December 1979 until it ceased its existence in October 1982; he then continued as Senior Technical Assistant at the Federal Circuit until July 1983. He has a legal degree and a B.S. in chemistry, and he had a patent background in the government, including a two-year stint as Assistant Technical Advisor to Judge Donald E. Lane of the CCPA (1976-1978), before becoming Chief Technical Advisor in 1979. He is presently a member of the PTO Board of Patent Appeals and Interferences.

The STA has tried to employ in his office at least one technical assistant with a biology background and one with an electrical engineering background. The present technical assistants, both of whom have law degrees, are Janet I. Stockhausen (Deputy STA) and MaryAnn Lastova. Ms. Stockhausen, with a background in biology/chemistry, came to the court in 1988 from a patent law firm. Ms. Lastova has a background in electrical engineering and was a primary examiner at the PTO before coming to the court in 1989.

Previous technical assistants at the Federal Circuit include: John Dana Hubbard, whose technical background is biology/chemistry, who came to the court in 1982 from a patent law firm and left in 1985 to go to a corporation's patent law department; John G. Shudy, whose technical background is electrical engineering, who came to the court in 1984 from a patent unit in the Department of the Navy and left in 1986 to go to a corporation's patent law department; Harrie R. Samaras, whose background is biology/chemistry, who came to the court in 1985 from the PTO (where she was a patent examiner) and left in 1988 to become Judge (now Chief Judge) Helen W. Nies's law clerk at the Federal Circuit (she left the court in the summer of 1990 to join a private firm); and Jameson Lee, whose background is electrical engineering, who came to the court in 1986 from a private law firm and left in 1989 to go to a different private law firm (he is now an attorney in the Solicitor's Office of the PTO).

The STA's office has had three secretaries. Joyce Bergin was the first, having transferred to the position from the corresponding slot at the CCPA. In 1984, she left to devote more time to her family and was succeeded by Barbara Florence. Ms. Florence became Judge Paul R. Michel's secretary in 1988. She was succeeded by the present secretary, Adrienne M. Parker.

Finally, until late 1989, the STA's office supervised an internship program with Brigham Young University. The internship program was a carryover from the CCPA. The interns worked at the court for a semester or a summer during their undergraduate years. A main objective was to expose the interns to work in a federal appeals court. They performed various tasks in the STA's office, the Clerk's office, and the library. Those tasks included docketing, citation checking, and researching legislative history. The interns included: Mark Arnett (fall 1983); Justin Seamons (summer 1984); Brian Bertineau (summer 1984); Margaret Ullman (fall 1984); Karen Barnes (winter 1985); Stan Christensen (spring 1985); Andrew Scoggins (summer 1985); Nathan Jones (spring 1986); Steven Ashford (summer 1986); Vicki Huebner (spring 1987); Michael Armstrong (summer 1987); and Derek Stotts (fall 1988). In 1989, management of the program was transferred to the Clerk's office.

THE OFFICE OF THE MOTIONS STAFF ATTORNEY

Eleanor M. Thayer, Motions Staff Attorney

From the creation of the court in 1982 until October 1984, the motions which were filed were directed to a preassigned motions panel of three judges that was constituted differently each month, and rotated on a monthly basis. The preassigned "lead" judge reviewed the motions papers, prepared draft orders, and distributed the drafts to the other members of the panel for votes. After two years of using this procedure, the court determined to form the Office of the Motions Staff Attorney to give the judges more time to read briefs, prepare for oral arguments, and write opinions in cases appealed on the merits.

On October 29, 1984, Helen Kane became the court's first Motions Staff Attorney (MSA). She was assisted by the MSA secretary, Susan Hughes. Richard Beutel succeeded Ms. Kane and served the office from September 1985 to April 1986. On May 27, 1986, Eleanor M. Thayer became the MSA, assisted first by MSA secretary, Adrienne M. Parker, and second by Earline T. Coleman.

The original system of rotating preassigned motions panels on a monthly basis with a designated lead judge continues. Under the present system, however, the MSA serves as a conduit for the flow of paper. The MSA reviews the motions papers, performs research, prepares draft orders, and discusses each motion with each motions panel judge, who is presented with all motions papers. Except when the Clerk of the court acts on certain prescribed noncontroversial procedural motions, Fed. Cir. R. 27(d), or when an assigned merits panel of judges acts on motions, all motions flow through the office of the MSA pending formal final approval of prepared orders by panel members.

What is a motion? It is simply a written request by a party asking the court to do something. Within this ambit, the court receives requests for leave to proceed in forma pauperis, to extend the time for filing a brief, to dismiss an appeal for lack of jurisdiction, or for a stay of an injunction pending appeal. A motion is a request that requires a ruling, or, occasionally, an explanation. In recent years when computer records have been kept, we know that more than 2,500 motions are filed each year.

The parties' use of motions is a double-edged sword. On the one hand, motions can serve to hone the issues on appeal, to avoid unnecessary litigation, and to prevent abuse of the judicial process. For example, a timely filed motion to dismiss for lack of jurisdiction that results in dismissal before briefing and argument conserves the resources of all concerned. On the other hand, motions can be used to effect delay, to harass the opposition, and to impede the judicial process. For example, a motion to dismiss, which automatically suspends the briefing schedule, based on an alleged procedural defect in the appendix or in a brief, will create delay and drain the resources of the court. In general, however, motions practice is a positive factor in the appellate process. For Federal Circuit practitioners, familiarity with Fed. R. App. P. 27 and Fed. Cir. R. 27 is presumed.

PART IV

EXTRA-JUDICIAL SUPPORT

FOUNDING OF THE FEDERAL CIRCUIT BAR ASSOCIATION

Douglas B. Henderson, Esq.

The Federal Circuit Bar Association actually grew out of the old Court of Claims Committee of the Bar Association of the District of Columbia, which had functioned for many years as the bar's liaison with the court and provided splendid occasions for the bench and bar to socialize together.

With the merging of the United States Court of Claims and the United States Court of Customs and Patent Appeals and the founding of the United States Claims Court, I set up a new committee under the structure of the Bar Association of the District of Columbia which was called the United States Court of Appeals for the Federal Circuit Committee. This committee got off to a good start and functioned well with a substantial membership. However, many members who wanted to belong to the committee were not members of the District of Columbia bar, and this created some concern, even though the District of Columbia Bar Association agreed that nonmembers of the D.C. bar could join the bar association and thus participate in the committee's activities, and a number of out-of-town lawyers did follow that procedure. During this same time frame, Chief Judge Howard T. Markey also commented that it seemed inappropriate for a national court to have its principal bar committee as an arm of a local bar association. Thus, after the expiration of my term as chairman of the Federal Circuit Committee of the District of Columbia Bar Association, I held several preliminary meetings to which I invited active and interested members of the bar. These included many who had been active in the old Court of Claims bar and many others who were active in the various patent bar associations. After several meetings in which we discussed the pros and cons of having a new bar association and whether we would simply be duplicating the efforts of others, we decided that a bar association would be appropriate. We set up an informal group to organize the bar which was called Friends of the Federal Circuit. The friends included:

David V. Anthony
Robert W. Barker
David Busby
David M. Cohen
Scott P. Crampton
Howard D. Doescher
Donald R. Dunner
Charles Gholz
Jack C. Goldstein
Barry W. Graham
Marion E. Harrison
Douglas B. Henderson

Charles A. Hobbs
Frances L. Horn
Fred Jacob
Melvin F. Jager
Sheldon Karon
Clarence T. Kipps, Jr.
Richard H. Kjeldgaard
Steven C. Lambert
Harry F. Manbeck
Herbert H. Mintz
Richard Murray
Scott E. Pickens
James L. Robart
Thomas D. Rosenwein
Nancy Schaefer
Stuart E. Schiffer
Harvey G. Sherzer
Evangeline W. Swift
Roger D. Taylor
Andrew P. Vance
Robert D. Wallick
E. Thomas Wheelock
Glen A. Wilkinson

We determined that the best thing to do was to set up an efficient bar association using the relatively small group of individuals who represented a cross-section of the bar. Once we had our bar association set up, we would then open the membership to others. This seemed to work very well. By December 12, 1984, the work of the founders had been completed and the organization was formed with the first slate of duly elected officers:

Nancy Schaefer of Chicago, Illinois, as President;
Robert D. Wallick of Washington, D.C., as President-elect;
Jack C. Goldstein of Houston, Texas, as Secretary;
David M. Cohen of Washington, D.C., as Treasurer.

The membership of the Association was opened to all lawyers practicing before the United States Court of Appeals for the Federal Circuit. We were fortunate that at the same time we were founding our Bar Association, George E. Hutchinson, Clerk of the United States Court of Appeals for the Federal Circuit and previously Clerk of the United States Court of Customs and Patent Appeals, who was well respected and recognized throughout the country as a singularly outstanding federal court clerk, retired from his position with the Federal Circuit and consented to become our Executive Director. This has benefited the Bar Association enormously. Mr. Hutchinson who served for some years with no pay, and then with token pay, administers a well-organized and efficient Bar Association of 1,500 dues-paying members.

The Constitution and By-Laws were adopted on February 13, 1985, and were amended on April 1, 1986. On April 19, 1985, the Association was incorporated in the District of Columbia as a nonprofit organization under section 501(c)(6) of the Internal Revenue Code. Its stated purposes are:

(a) To improve and facilitate the administration of justice in the United States Court of Appeals for the Federal Circuit.

(b) To maintain and raise the standards of proficiency, integrity, and ethics in the practice of law before the Federal Circuit, including fostering continuing legal education.

(c) To assist, as requested by the Federal Circuit, in planning and holding the Annual Federal Circuit Judicial Conference; in proposing qualified persons for membership in the Federal Circuit's Advisory Committee established pursuant to 28 U.S.C. § 2077(b); in maintaining and expanding the Federal Circuit's library; and in performing such other tasks and activities as may be requested.

(d) To undertake such other activities as are appropriate to enhance the status and effectiveness of the Federal Circuit.

FEDERAL CIRCUIT BAR ASSOCIATION, 1985-1986

Nancy Schaefer, President

When the Court of Appeals for the Federal Circuit was established, my partner, Thomas D. Rosenwein, began editing a monthly newsletter under the auspices of the Litigation Section of the American Bar Association. The newsletter analyzed decisions by predecessor courts, predicted the direction of the new court, commented on current decisions, and offered practice hints.

The newsletter was of great interest to trial judges who, in areas such as patents, suddenly looked to the new court, not the regional circuits, for guidance. It was of great interest to practitioners who were able to locate easily the decisions of the court which had implications for all areas of practice. The newsletter also was of interest to legal scholars as they followed the decisions of the new court.

One day a call was received from Douglas B. Henderson asking if we were interested in attending a meeting to be held in Washington, D.C., to discuss whether a bar association should be established for the Court of Appeals for the Federal Circuit. Thomas D. Rosenwein, our partner Sheldon Karon, and I attended this and later meetings of the group which was debating this issue, a group called the Friends of the Court of Appeals for the Federal Circuit.

After many discussions, we agreed that a bar association should be established. One of the primary goals of the Association was to ensure the nationwide participation of members of the bar of a court with nationwide jurisdiction. Another goal was to ensure the participation of lawyers from all the various practice areas which comprise the court's jurisdiction. We also intended to serve the court by providing pro bono and amicus curiae assistance on request. We intended to become active in judicial selection and to provide a vehicle for communication between bench and bar. We intended to further the spirit of open dialogue which was fostered by the broad-based annual judicial conferences of the CCPA and the Court of Claims.

I was asked to be the first president of the new Bar Association and accepted with the support and encouragement of my former firm, Karon, Morrison & Savikas.

The members of the first board of directors were Harry Manbeck, Jr., Andrew P. Vance, David Busby, Scott P. Crampton, Steven C. Lambert, James L. Robart, Evangeline W. Swift, Clarence T. Kipps, Jr., Marvin Garbis, and Douglas B. Henderson.

The first officers were:

Nancy Schaefer, President;
Robert D. Wallick, President-elect;
David M. Cohen, Treasurer;
Jack C. Goldstein, Secretary.

We all worked hard that year to obtain members and then to devise meetings and programs which would meet the needs of our geographically diverse membership with its diverse interests.

With the devoted work of our first board and committee chairs, membership rose from an initial 317 members in May 1985 to approximately 1,200 by the end of the year. With Roy Hofer's help and with the cooperation of Chief Judge Markey, Judges Daniel Friedman and Helen W. Nies (now Chief Judge), and Chief Judge Loren Smith of the Claims Court, we held a very successful program in Chicago with 350 attendees. The group met first to hear discussions of matters of common interest and then met in practice area groups. We had significant attendance from the Merit Systems Protection Board under Evangeline Swift's and Martin Baumgaertner's guidance. The International Trade group, under the guidance of Andrew P. Vance's partner, Robert E. Burke, was so engrossed in their meeting that they nearly had to be evicted as the day ended. The patent and tax groups had excellent sessions as well.

We also had our first annual meeting that year and various programs and dinners with the able assistance of J. Gary McDavid and William T. Bullinger.

The greatest pleasure of that year, a year in which everyone worked very hard, was the building of a new institution and working with wonderful people to do it.

FEDERAL CIRCUIT BAR ASSOCIATION, 1986-1987

Robert D. Wallick, President

Responsibility for the stewardship of our fledgling Association passed from President Nancy Schaefer and the initial board of directors to me and the second-year board—some new and many continuing—on July 1, 1986. George Hutchinson assumed increased responsibilities as the Association's Executive Director. The Association's membership continued to grow in its second year.

Preparation for the new year had begun earlier, during the Federal Circuit's Judicial Conference in the spring. Committee chairs had met with the incoming board, and several substantive committees met with their members.

The Association's focus continued to be upon our membership and finances, appointments to vacancies on the court, significant jurisdictional and procedural issues relating to the court and practice before it, and expanding the Association's activities. The Association sponsored a fall dinner, with Chief Judge Howard T. Markey as our featured speaker.

Regional continuing legal education programs were held in Phoenix, Arizona, and Boston, Massachusetts, each in conjunction with a special session of the Federal Circuit sitting in the host city. The Phoenix program, held in the Wrigley Mansion overlooking the grounds of Frank Lloyd Wright's Arizona Biltmore Hotel, included a spirited discussion of Indian claims.

During the year, preparations were laid for the Association's first George Hutchinson Writing Competition, offering a $1,000 award for the best student essay on a selected topic. In addition, the Association played an active role, both through its Judicial Selection Committee and its board, in the review of, and Senate hearings on, nominations to the court.

Officers of the Association for 1986-1987 were:

Robert D. Wallick, President;
Jack C. Goldstein, President-elect;
Evangeline W. Swift, Treasurer;
Herbert H. Mintz, Secretary.

FEDERAL CIRCUIT BAR ASSOCIATION, 1987-1988

Jack C. Goldstein, President

The Association held its annual dinner at the Sheraton Washington Hotel on October 21, 1987, in honor of the fifth anniversary of the Federal Circuit. The speaker was Assistant Attorney General Stephen J. Markman. Afterward Donna Lee Kennon was surprised to receive a plaque in appreciation of her service to the Association.

Under the chairmanship of Clarence T. Kipps, Jr., the Association's Judicial Selection Committee continued to interview and investigate Federal Circuit nominees and to make recommendations to the Association's board. Following that procedure, the Association wrote Senate Judiciary Committee Chairman Joseph R. Biden, Jr., on February 23, 1988, in support of the nomination of Paul R. Michel. Since it thereafter appeared that a number of vacancies might soon exist on the

Federal Circuit, the Association's Judicial Selection Committee began to seek out well-qualified candidates to recommend to the Administration.

On February 29, 1988, a regional meeting at the Hyatt Regency Dallas featured a reception in honor of Chief Judge Howard T. Markey and Senior Judge Phillip B. Baldwin; a luncheon with an address by Chief Judge Markey; and simultaneous CLE programs on government contract law, MSPB law, patent law, and tax law. The government contract and MSPB programs were planned by Marshall J. Doke, Jr., and Paula A. Latshaw, respectively, who were subsequently elected to the Association's board.

The Association's annual meeting was held on May 12, 1988, at the Washington Hilton Hotel, and the speaker was District of Columbia Circuit Judge Kenneth W. Starr, who later became Solicitor General. As a touching surprise, the Association gave Judge Oscar H. Davis a plaque commemorating his fifty years of distinguished government service, first as an attorney and then as a judge.

On June 23, 1988, the Association held a reception at the Tayloe House for the Judicial Branch Committee of the Judicial Conference of the United States.

The Association's officers for 1987-1988 were:

Jack C. Goldstein, President;
David M. Cohen, President-elect;
Evangeline W. Swift, Treasurer;
Herbert H. Mintz, Secretary.

FEDERAL CIRCUIT BAR ASSOCIATION, 1988-1989

David M. Cohen, President

During the year, the Association sponsored the first Mini-Conference devoted entirely to the Federal Circuit. The conference was held in Annapolis, Maryland, in December 1988 and was designed to focus upon the court and its procedures rather than on substantive law in the various areas of the court's jurisdiction, which is the principal theme of the court's annual judicial conferences. The Mini-Conference was attended by ninety attorneys from various parts of the country and four judges of the court. Materials relating to the court were distributed in advance for the participants, and the entire day was devoted to a discussion, in small groups, of these materials. Subjects covered were the jurisdiction of the court, its rules, and several matters directed to an attorney's practice before the court. Over ten changes to the court's rules came as a direct result of this Mini-Conference.

The Association's annual dinner in October featured Justice Antonin Scalia as speaker, and Douglas B. Henderson, the founder of the Association, was presented with a crystal set.

The first two portraits to be commissioned, one of Chief Judge Eugene Worley of the United States Court of Customs and Patent Appeals (CCPA) and the other of Chief Judge Howard T. Markey, last Chief Judge of the CCPA and first Chief Judge of the Federal Circuit, were presented at a special session of the court.

Continuing the practice of holding a regional meeting outside Washington, D.C., the Association went to New York City in March 1989 where discussions centered on judicial selection and judicial salaries. Judge Harold Tyler, chair of the Judicial Selection Committee of the American Bar Association, was the featured luncheon speaker.

The annual meeting of the Association was again held on the eve of the court's Annual Judicial Conference, with counsel to the President, C. Boyden Gray, as the luncheon speaker.

Officers for the year were:

David M. Cohen, President;
Andrew P. Vance, President-elect;
Jerald S. Howe, Treasurer;
Evangeline W. Swift, Secretary.

FEDERAL CIRCUIT BAR ASSOCIATION, 1989-1990

Andrew P. Vance, President

The highlight of the 1989-1990 year of the Federal Circuit bar was the revitalization of its committees, the continued growth of its membership, and the varied activities in which the bar engaged.

The fall was highlighted by the annual dinner in November at which Justice Anthony M. Kennedy gave a thoughtful, interesting, and challenging talk. Later in November, the Association held its second annual fall/winter conference at the Sheraton Inner Harbor Hotel in Baltimore where the bench and the bar had an excellent opportunity to interact. The theme of the conference was "The Role of the Federal Circuit in the Federal Judicial System." Judge Joseph F. Weis, Jr., chairman of the Federal Courts Study Committee, was the luncheon speaker. Another successful seminar was held in Chicago in April. The theme there was "The Impact of the Federal Circuit on the Various Areas of the Court's Jurisdiction." Chief Judge Markey gave the luncheon address.

The bar was actively involved in hearings held by the Federal Courts Study Committee with the president and president-elect appearing before the committee's hearings in New York and Washington, speaking in favor of the integrity and maintenance of the court's separate budget. The bar was also active before the Senate Judiciary Committee with regard to nominations to fill vacancies on the court.

The Bar Association was proud to present portraits of Judges Giles S. Rich and Oscar H. Davis to the court, followed by receptions. It also ordered a new portrait of Chief Judge Howard T. Markey to be presented upon his relinquishment of the chief judgeship.

The Association was pleased to host a reception for the European patent judges attending a meeting in Washington of European and American judges, as well as hosting the receptions following the memorial services for Judges Philip Nichols, Jr., and Jean Galloway Bissell.

The George Hutchinson Writing Contest produced an excellent essay by Howard A. Kwon, a student at the Marshall-Wythe School of Law of the College of William and Mary, and an honorable mention to Gregory J. Kirsch, a law student at the Washington University School of Law. Mr. Kwon was present to receive his award of $1,000 at the Association's annual meeting in May.

An important decision was taken by the board to begin publication of its own journal, replacing the newsletter hitherto published in conjunction with the American Bar Association. The winning essay and the one awarded honorable mention in the Writing Contest are being considered for inclusion in the journal.

The Bar Association filed an amicus brief in *Aerojet-General Corp. v. Machine Tool Works, Oerlikon-Buehrle, Ltd.*, 895 F.2d 736, 13 USPQ2d 1670 (Fed. Cir. 1990) (in banc). Finally, the annual meeting was highlighted by an afternoon seminar on "Improving Appellate Advocacy Before the CAFC." That seminar helped to attract the Association's largest annual meeting to date.

The officers of the Association for 1989-1990 were:

Andrew P. Vance, President;
Clarence T. Kipps, Jr., President-elect;
Jerald S. Howe, Jr., Treasurer;
Evangeline W. Swift, Secretary.

Each of the above was ably assisted by the Executive Director, George E. Hutchinson.

THE FEDERAL CIRCUIT ADVISORY COMMITTEE

Donald R. Dunner, Esq.

The legislation establishing the Court of Appeals for the Federal Circuit was signed into law on April 2, 1982. Although by law the court was not set to open its doors to hear its first case until October 1, 1982, the ink was barely dry on the President's signature on the bill establishing the court before former Chief Judge Howard T. Markey took steps to implement the provisions of 28 U.S.C. § 2077(b)[1] by appointing fourteen members[2] to what was then known as the Advisory Committee on Rules of the Court of Appeals for the Federal Circuit.

The statutory function of the Advisory Committee is to make recommendations to the court concerning its rules of practice and internal operating procedures. Since the fledgling court at that point had neither rules nor operating procedures in place, Chief Judge Markey lost no time in putting the Advisory Committee members to work assisting the court in achieving that goal. Accordingly, on April 16, 1982, less than six months before the court was to begin its deliberations, Chief Judge Markey provided the new committee members with a first draft of proposed rules and requested the completion of the committee's final rule proposals by July 15, 1982.

With little time to fulfill its mandate, the Advisory Committee convened, unanimously selected Donald R. Dunner as its chairman, began its deliberations, met three additional times, generated no less than three inches of correspondence and commentaries, and produced a final work product for the court's consideration on August 3, 1982, only nineteen days behind the original deadline set by the Chief Judge.

On August 24, 1982, the court sent its final draft of the rules to the printer, having adopted a substantial segment of the Advisory Committee's proposals. On that same day, the court requested comments from the Advisory Committee on a draft of its proposed new *Procedural Handbook*, which was expected to go into effect on October 1, 1982, the date the court's rules were to be placed in operation. The Advisory Committee responded on a timely basis and, as those practicing before the Federal Circuit know, the court met its deadline date and both the rules and *Procedural Handbook* were available to the bar well prior to the court's October 1, 1982 starting date.

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[1] Section 2077(b) provides that:

> Each court, except the Supreme Court, that is authorized to prescribe rules of the conduct of such court's business under section 2071 of this title shall appoint an advisory committee for the study of the rules of practice and internal operating procedures of such court. The advisory committee shall make recommendations to the court concerning such rules and procedures. Members of the committee shall serve without compensation, but the Director may pay travel and transportation expenses in accordance with section 5703 of title 5.

[2] The original fourteen members were: Ernest C. Baynard, III, Eugene L. Bernard, David Cohen, H. Stuart Cunningham, Donald R. Dunner, John I. Heise, Jr., John B. Jones, Jr., Clarence T. Kipps, Jr., Stanley H. Lieberstein, Joseph E. Lombardi, Joseph F. Nakamura, Frank T. Peartree, Michael Stein and Andrew P. Vance.

While these early 1982 activities of the Advisory Committee were carried out under the mandate of 28 U.S.C. § 2077(b), the committee had no formal structure until October 10, 1984. On that date, Chief Judge Markey signed an order formally establishing the Advisory Committee and reciting in some detail the composition of the committee, its term, and its function.[3]

Whereas the original committee had fourteen members, the committee was now to have fifteen members[4] "of its bar and representatives of tribunals from which the court receives appeals," the selection of which was, to "the extent feasible," to "reflect the diversity and national scope of the court's jurisdiction."

The committee, which was now to be known as the Advisory Committee of the United States Court of Appeals for the Federal Circuit, had its functions spelled out specifically:

> The Advisory Committee shall advise the court respecting its rules and procedures, including procedures governing expenditure of non-appropriated funds.
>
> The Advisory Committee will review communications addressed to it and containing suggestions, comments, criticisms, and recommendations relating to the court, shall retain in confidence the source of such communications, and shall transmit to the court its advice, if any, resulting from such communications. The Committee shall exercise its discretion in determining which, if any, of such communications should be transmitted to the court, with or without its comments.

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[3] A copy of the court's order is appended hereto as Appendix A.

[4] The newly appointed 15 members included all of the original 14 members, except Mr. Baynard, and two new members, Jack C. Goldstein and Nancy Schaefer. Since then, Michael Stein, Joseph F. Nakamura, and John I. Heise, Jr., have been replaced, respectively, by Lyn M. Schlitt, Fred E. McKelvey, and Jeffrey M. Glosser.

The court's October 10, 1984 order also spelled out the terms of the Advisory Committee members as being limited to not more than two consecutive three-year terms. Since the October 10, 1984 order formally establishing the Advisory Committee required the committee to advise the court respecting its rules and procedures, the committee met on January 14, 1985, to adopt its rules and to plan its future. What evolved from that meeting was a detailed set of rules and procedures[5] and a unanimously elected slate of officers (Donald R. Dunner, chairman; Andrew P. Vance, vice-chairman).

Since then, the Advisory Committee has been extremely active. It has on a number of occasions evaluated the court's proposals of additional rule changes and has made a number of proposed rule changes of its own. Equally, if not more significantly, it has served as a conduit between members of the bar and the court to encourage and facilitate dialogue between the court and its bar. Indeed, on a number of occasions, with the court's blessing, it has served as an effective vehicle for those wishing to comment on the court's activities but who seek anonymity in the process. In the eight years of its existence, the Advisory Committee has generated two full banker's boxes of correspondence and related work product. That quantity and the quality of its work product have served both the court and its bar well and it no doubt will continue to do so in the years to follow.

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[5] *See* Appendix B hereto.

Appendix A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

In accord with 28 U.S.C. § 2077(b), the court herewith establishes an Advisory Committee, the organization and functioning of which will be governed by the following:

1. *COMMITTEE*

The court shall appoint fifteen (15) members of its bar and representatives of tribunals from which the court receives appeals to a committee to be known as the Advisory Committee of the United States Court of Appeals for the Federal Circuit. To the extent feasible, the Committee membership shall reflect the diversity and national scope of the court's jurisdiction.

2. *FUNCTION*

The Advisory Committee shall advise the court respecting its rules and procedures, including procedures governing expenditure of nonappropriated funds.

The Advisory Committee will review communications addressed to it and containing suggestions, comments, criticisms, and recommendations relating to the court, shall retain in confidence the source of such communications, and shall transmit to the court its advice, if any, resulting from such communications. The Committee shall exercise its discretion in determining which, if any, of such communications should be transmitted to the court, with or without its comments.

3. *CHAIR*

The Chair shall be selected by the members of the Committee.

4. *TERMS*

The term of service as Chair shall be three years. A person may serve as Chair for no more than two consecutive terms.

The term of service as a member of the Committee shall be three years. A member may serve two consecutive terms.

The initial appointments to the Committee shall be for staggered terms, with 5 being for three years, 5 for two years, and 5 for one year.

5. ***FACILITIES***

The court shall make available to the Committee the facilities assigned to it in the National Courts Building for the conduct of Committee meetings and Committee functions.

6. ***MEETINGS***

The Committee shall meet at the call of the Chair or the court.

FOR THE COURT

10 Oct. '84
Date

/s/ Howard T. Markey
Howard T. Markey
Chief Judge

Appendix B

RULES AND PROCEDURES OF THE ADVISORY COMMITTEE OF THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ARTICLE I

Name

The name of this Committee shall be the Advisory Committee of the Federal Circuit Court of Appeals.

ARTICLE II

Objects

The objects of the Committee shall be to review and study all suggestions, comments and recommendations relating to practice, procedure and/or rules of the Court of Appeals for the Federal Circuit and to make recommendations to the Court for its consideration. The identity of all communications to the Committee shall be kept confidential, if requested.

ARTICLE III

Officers and Membership

1. The affairs of the Committee shall be conducted by fifteen members selected by the Court, each of whom shall hold office for three years, except for the terms set at the first election. Initially, five members shall be appointed for one year, five for two years, and five for three years. Subsequent appointments shall be for three years.

2. The officers of the Committee shall be a Chair and a Vice-Chair. These officers shall be elected, by majority vote, at a meeting to be held at approximate one-year intervals. The Vice-Chair shall perform the duties of the Chair either at the Chair's request or when the Chair is unable to do so.

ARTICLE IV

Sub-Committees

This Committee may provide for such sub-committees as it may deem necessary, from time to time.

ARTICLE V

Meetings

The meetings of the Committee shall be held at the Court at such time(s) as designated by the Chair. Special meetings may be called upon the written request of five active members to the Chair specifying the purpose for such meeting. The presence of eight active members at any meeting shall constitute a quorum.

ARTICLE VI

Elections

All elections shall be by ballot or voice vote. The officers elected shall enter immediately upon their duties and shall hold office until their successors are elected or appointed. In case of a vacancy in any office, it shall be filled by the Committee at its next regular meeting, but such officer shall hold office only for the balance of the remaining term of the vacancy.

ARTICLE VII

Amendments

These by-laws may be amended by a two-thirds vote of the active members present at any regular meeting of the Committee, provided notice of the proposed amendment be given in writing at a previous regular meeting, and notice of the same be also given by the Chair in the notice of the meeting.

ARTICLE VIII

Presiding Officer

The Chair, or in his absence the Vice-Chair, or in the absence of both of them, any member selected by the Committee in the presence of a quorum, shall preside and call the meetings to order.

At each meeting of the Committee, the order of business shall be as set forth in an agenda distributed by the Chair. The usual parliamentary rules and orders shall govern all meetings of the Committee, except in cases otherwise provided for by these Committee by-laws.

ARTICLE IX

Committee Records

The Chair shall keep the records of all meetings and business of the Committee, shall issue notice of all meetings, and generally perform the duties of Secretary as well as Chair.

ARTICLE X

Committee Procedure

The Committee shall receive and consider all communications respecting practice, procedures and/or rules of the Court, and study and discuss the merits thereof. All worthy communications from the Committee shall be transmitted by the Chair to the Chief Judge of the Court.

THE FEDERAL CIRCUIT JUDICIAL CONFERENCE — A MODEL OF SUCCESS

Donald R. Dunner, Esq.

On May 31, 1990, approximately 1,500 conferees, consisting of members of the Federal Circuit's bar, numerous judges and various VIPs, assembled in the main ballroom of the Washington Hilton Hotel to listen to Chief Judge Howard T. Markey's Eighth Annual State of the Court Address; Clerk Frank Gindhart's fourth update on the court's rules and procedures; a panel discussion focusing on a crisis in section 337 proceedings before the International Trade Commission; an informative talk on "How Lawyers Get Into Trouble" by a key executive of a legal malpractice insurance company; a fascinating luncheon speech by the humorist, Art Buchwald, following the best sirloin steak luncheon $50 can buy; thereafter breaking up into multiple break-out sessions keyed to the various facets of the court's diverse areas of interest. Thus concluded the eighth of what fairly must be regarded as the largest and most successful judicial conference ever convened in the country, all under the inspired leadership of Chief Judge Markey. One could hardly have predicted the dramatic and continuing success of these judicial conferences in 1963 when the first Court of Claims Judicial Conference convened, or even in 1973 when the first Court of Customs and Patent Appeals Judicial Conference was held little more than a year after Judge Markey was appointed Chief Judge of that court. It was in October 1973 that Chief Judge Markey wrote his first letter to the members of what was ultimately to become the core Planning Committee of the eight Federal Circuit Judicial Conferences.

The initial Planning Committee of the Federal Circuit Judicial Conference was selected to ensure representation from all segments of the legal disciplines within the court's jurisdiction. Thus, the committee included members of the patent bar (Eugene L. Bernard, James F. Davis, Donald R. Dunner, and Frank L. Neuhauser); members of the Claims Court bar (Ernest C. Baynard, III, John I. Heise, Jr., John B. Jones, Jr., and Clarence T. Kipps, Jr.); the International Trade bar (David Busby and Harvey A. Isaacs); the government (Richard H. Abbey, Gerald H. Bjorge, David M. Cohen, Vito J. DiPietro, Theodore D. Peyser, Michael T. Schmitz, Michael H. Stein, and Evangeline W. Swift); and the courts (Hon. Joseph V. Colaianni, Hon. Joseph E. Lombardi, Hon. James F. Merow, and Hon. John P. Wiese).

The composition of the Planning Committee has remained relatively constant, with modest changes being made through the years to reflect changing professional assignments. Similarly constant has been the actual modus operandi of the Planning Committee for each of the eight judicial conferences which the Federal Circuit has held. Invariably, an initial Planning Committee meeting of approximately two hours' duration is held in the courthouse ordinarily about four months prior to the anticipated date of the judicial conference. The agenda items are then discussed in turn, with those involving the luncheon speaker and the program consuming the lion's share of discussion. Following appointment of committee chairs by Chief Judge Markey, the meeting then adjourns and is followed one to two months later by a second and final planning meeting to finalize all agenda items, including the most important selection of program topics and speakers.

As will be seen from the program transcripts which are annually published in *Federal Rules Decisions*, all of the eight Federal Circuit Judicial Conferences have followed a similar format. Promptly at 9 a.m. on the morning of the conference day, Chief Judge Markey has convened the conference with what has become to be known as his State of the Court Address, preceded by a judicious sampling of the humor for which he has become so well known. This State of the Court Address has then been followed by a brief rules update presentation by the Clerk of the court which, in turn, has been followed by a two-hour morning plenary session, the content of which has been selected on the basis of its interest to at least most of the segments of the court's bar. The conclusion of the plenary session has initiated what has been colloquially referred to as an "attitude adjustment" period, during which guests and VIPs are briefly entertained. A luncheon capped with a typically excellent luncheon speaker has followed, with the conference culminating in break-out sessions keyed to the various segments of the court's jurisdiction and ending between 4 p.m. and 5 p.m.

It is not an exaggeration to say that the Federal Circuit Judicial Conferences have all been enormously successful. That fact is readily apparent from the consistently high attendance at each of the conferences, as the following table will illustrate:

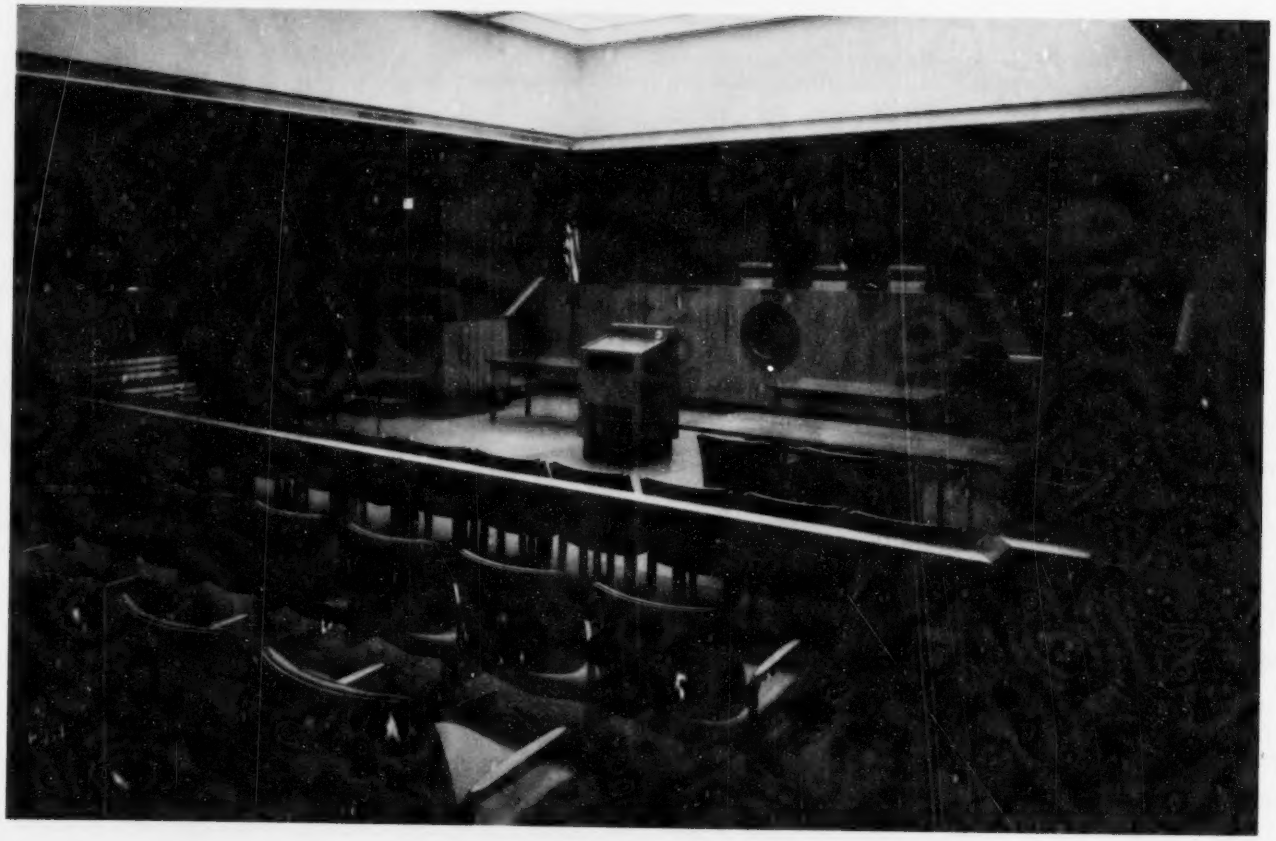
Year	*Registration*
1983	1,293
1984	1,281
1985	1,250
1986	1,179
1987	1,385
1988	1,153
1989	1,305
1990	1,515

One may ask why all of these conferences have been so successful, no doubt eclipsing in attendance all other judicial conferences held in the United States. There are several answers to this question: First and foremost, the program quality and speaker selections have been almost uniformly superb, with something of significant interest to every segment of the court's bar and, secondly, the price is right. From the very inception of these conferences, it has been an established goal to provide the best quality conference at the lowest possible price consistent with not foreclosing any member of the court's bar from attending. This goal has been consistently achieved, beginning with a $35 registration fee at the first Federal Circuit Judicial Conference in 1983 and culminating with a still quite reasonable fee of $50 for the 1990 Judicial Conference. What is remarkable, however, is that those modest fees have been more than adequate to cover not only all of the normal costs of a judicial conference, including mailings, handouts, name tags, and the like, but an invariably high-quality luncheon which itself is a memorable aspect of each conference.

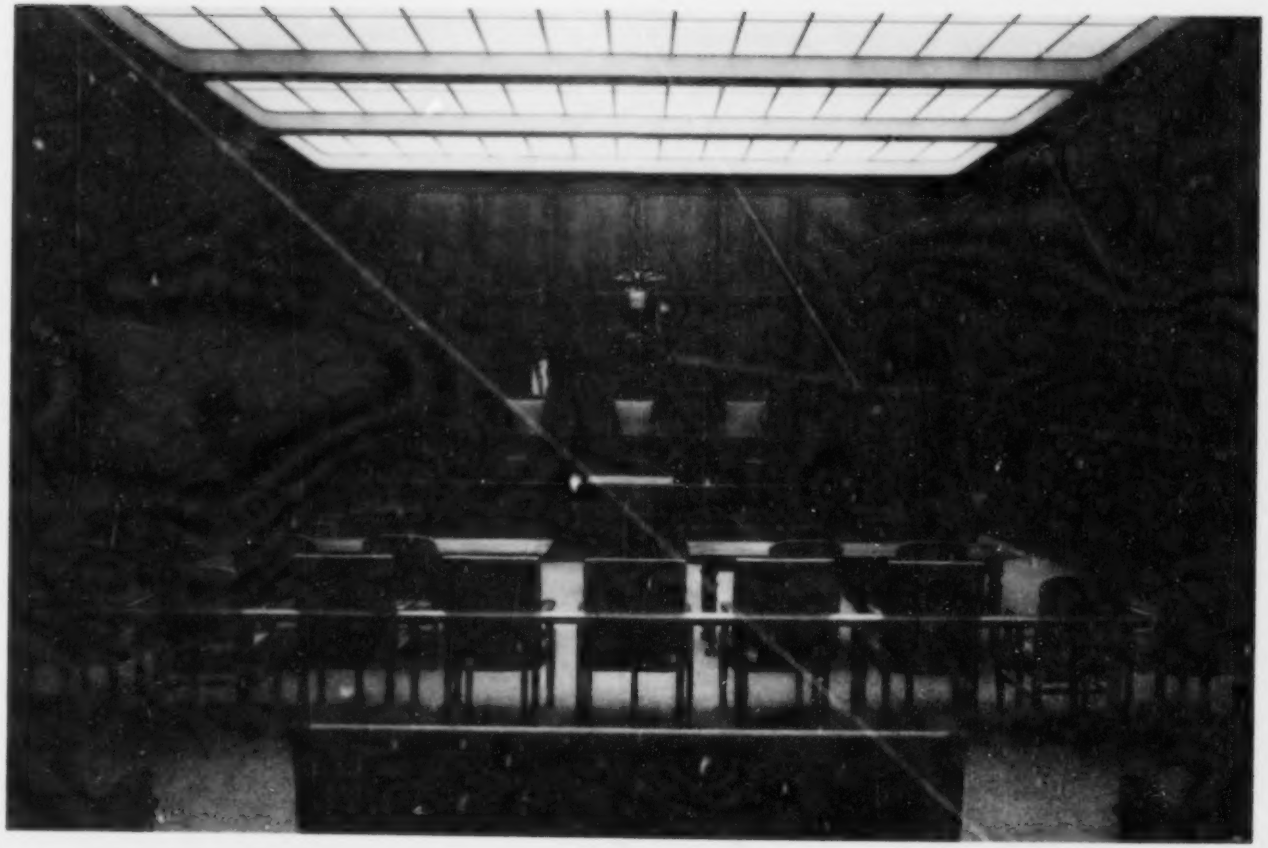
It is of interest to note that almost as much care goes into the selection of the luncheon fare as into the program itself. Approximately one month prior to each conference, Chief Judge Markey, the Clerk of the court, and a small delegation from the Planning Committee convene at the site of the conference hotel to sample three or four variations of each course of the proposed luncheon. Luncheon courses are selected following brief but animated discussions, the end result of this process being a slightly overweight luncheon selection subcommittee and more than a thousand contented conferees.

What is the future of the Federal Circuit Judicial Conference? Federal Circuit rule 53 requires that the judicial conference "shall be held annually." Each year, however, the Planning Committee professes to have run out of program ideas. Each year, there is, accordingly, resulting concern about the ability to continue the unbroken success of these judicial conferences. Each year, that concern is conclusively demonstrated to have been unwarranted by still another successful conference. No doubt the cycle will continue for years to come.

Courtroom 1



Courtroom 2



Courtroom 3

PART V

DISCUSSION OF JURISDICTION AND HIGHLIGHTED CASES

DISCUSSION OF JURISDICTION AND HIGHLIGHTED CASES

By Melvin L. Halpern[*]

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[*] Senior Technical Assistant (STA), Court of Appeals for the Federal Circuit. The author thanks the Honorable Marion T. Bennett, Senior Circuit Judge, Court of Appeals for the Federal Circuit, for his specific suggestions and overall guidance in preparing this Discussion. Special thanks are also owed to members of the STA staff (Janet Stockhausen, MaryAnn Lastova, and Adrienne Parker) and other members of the "court team" (Dorothy Butts, Jeffrey Mills, Patricia Donovan, Mark Dukes, Barbara Florence, Patricia McDermott, and David Lockwood) for their assistance.

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INTRODUCTION

The jurisdiction of the United States Court of Appeals for the Federal Circuit (Federal Circuit) is prescribed generally by section 1295 of title 28, *United States Code*. Subsection (a) thereof gives the Federal Circuit exclusive jurisdiction, *inter alia*:

(1) of an appeal from a final decision of a federal district court if the jurisdiction of that court was based, in whole or in part, on 28 U.S.C. § 1338, i.e., on a civil action arising under any Act of Congress relating to patents;

(2) of an appeal from a final decision of a federal district court if the jurisdiction of that court was based, in whole or in part, on the Little Tucker Act (i.e., 28 U.S.C. § 1346, which gives the district court original jurisdiction concurrent with the Claims Court of any claim against the United States for less than $10,000 founded on the Constitution, an Act of Congress, an executive agency regulation, or a contract with the United States);

(3) of an appeal from a final decision of the United States Claims Court;

(4) of an appeal from a decision of (A) the Board of Patent Appeals and Interferences (Patent Board) of the United States Patent and Trademark Office (PTO) with respect to patent applications and interferences, (B) the Commissioner of the PTO or the Trademark Trial and Appeal Board (Trademark Board) regarding application for registrations of marks, or (C) a district court to which a case decided at the Patent Board was directed pursuant to 35 U.S.C. §§ 145-146, instead of being appealed directly from the Patent Board to the Federal Circuit;

(5) of an appeal from a final decision of the United States Court of International Trade;

(6) to review a final determination of the United States International Trade Commission (ITC), relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930;

(7) to review, by appeal on questions of law only, determinations of the Secretary of Commerce under U.S. note 6 to subchapter X of chapter 98 of the Harmonized Tariff Schedule of the United States (relating to importation of instruments or apparatus);

(8) of an appeal under section 71 of the Plant Variety Protection Act (7 U.S.C. § 2461);

(9) of an appeal from a final order or final decision of the Merit Systems Protection Board (MSPB), pursuant to section 7703(b)(1) and 7703(d) of title 5; and

(10) of an appeal from a final decision of an agency board of contract appeals (BCA) pursuant to section 8(g)(1) of the Contract Disputes Act of 1978 (41 U.S.C. § 607(g)(1)).

28 U.S.C. § 1295(a) (1988) (statutory language paraphrased above). (Also, the court has jurisdiction in cases involving the General Accounting Office Personnel Appeals Board and the Trust Territory of the Pacific Islands. *See* note 21, *supra*, part I herein, M. Bennett, *The United States Court of Appeals for the Federal Circuit—Origins.*)

In general, section 1295(a) and 38 U.S.C. § 4092 (1988) (which gives the Federal Circuit jurisdiction over appeals from the Court of Veterans Appeals and rulemaking of the Veterans' Administration, i.e., Department of Veterans Affairs, *see* note 60, *infra*), give the court virtually exclusive jurisdiction, nationwide in scope, in certain fields of law. Those fields include international trade, federal personnel, patents, government contracts and other claims for money against the Federal Government, and veterans affairs. The universe of tribunals from which appeals come to the court is some 117, comprising ninety-four district courts, the Court of International Trade, the Claims Court, the Court of Veterans Appeals, twelve BCAs, the Patent Board, the Trademark Board, the PTO Commissioner, the MSPB, the ITC, and (under specific statute) the Secretaries of Agriculture, Commerce, and Veterans Affairs. All judgments of those tribunals are appealable exclusively to the court, except (1) those of the MSPB in most discrimination cases and (2) those of the district courts in all nonpatent and non-Little Tucker Act cases.[1]

In addition to dealing with its virtually exclusive jurisdiction fields, the court frequently confronts issues from other areas of the law. That is because the jurisdiction granted the court is over "cases," not "issues." Because the court decides all issues raised in any appeal within its jurisdiction, it often must resolve issues arising in the context of areas not within its exclusive jurisdiction, *e.g.*, those related to federal antitrust violations, state trade secret and unfair competition laws, federal tort claims, and state contract laws. Also, the court resolves numerous evidentiary and procedural issues typically arising in federal litigation, *e.g.*, discovery and jury questions. Consequently, the court is neither more nor less "specialized" than any other appeals court. All follow the Federal Rules of Civil and Appellate Procedure as well as Supreme Court guidance. That the substantive jurisdictional grants to the court and to the regional circuits are in different areas of law does not make one "specialized" and the other "general," the grant to each being neither limited to one field nor universal. No federal court is a court of general jurisdiction in the traditional sense, the Federal Government enjoying only limited power under the Constitution.

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[1] Much of what is contained in this and the ensuing three paragraphs is taken from *The First Two Thousand Days, Report of the United States Court of Appeals for the Federal Circuit, 1982-1988*, by Chief Judge Howard T. Markey (hereinafter *The First Two Thousand Days*).

Of course, the Federal Circuit differs from its sister circuits in that it is a national court. As such, it has a responsibility for contributing to uniformity and clarity in national law. That concept, however, was not new in 1982. The court's predecessors, the Court of Claims and the Court of Customs and Patent Appeals, fit that description. What was jurisdictionally new in 1982 was the reach for reliability in assigning to one court certain appeals from all district courts in the land and from the MSPB, over which the twelve regional circuits had previously been exercising and sharing jurisdiction.

The court has been acutely conscious of the heavy responsibility imposed by its grant of virtually exclusive jurisdiction in certain areas of law. The necessary rarity of Supreme Court review and the absence of peer-court decisions effectively give the court the last word in those areas. That keeps fresh in the court's mind the aphoristic warning of Justice Jackson, "We are not last because we are infallible, we are infallible because we are last."

Remembering that, and fueled by the legal decisions of its two predecessor courts (which the Federal Circuit has adopted as binding precedent), the court has attempted to fulfill its responsibility in all of its legal areas. We will leave to scholars the matters of determining the degree of the court's success in that regard and otherwise analyzing its work. We attempt, in sections I-IX that follow, only to provide a flavor of that work by generally describing the types of cases the court reviews and highlighting *some* of the developments of the past eight years. Our discussion will cover jurisdictional and merits issues in appeals from: (I) district courts and the PTO in patent cases; (II) the MSPB; (III) the PTO in trademark cases; (IV) the Claims Court; (V) district courts in Little Tucker Act cases; (VI) BCAs; (VII) the Court of International Trade and the ITC; (VIII) the Court of Veterans Appeals rulemaking by the Secretary of Veterans Affairs; and (IX) the Secretaries of Commerce and Agriculture in matters specified in subsections (7) and (8) of section 1295(a). We also include a brief section, X, on frivolous appeals.

We caution the reader that this "Jurisdiction and Highlighted Cases" section of the court's history is not designed to be, nor should it be treated as, a treatise on the various legal areas the court adjudicates. Given the limited time devoted to this project, even to attempt to have been exhaustive in our endeavor or otherwise to label this as a "treatise" would, in the words of the court's predecessor, be "*chutzpah* to the n*th* degree." *Weir v. United States*, 474 F.2d 617, 620 (Ct. Cl.), *cert. denied*, 414 U.S. 1066 (1973). An even greater folly would be for counsel to rely on and cite it in the presentation of cases before the court. In that regard, *the court strongly discourages attorneys from citing this part of the court's history as support for propositions in submitted briefs.*[2]

I. APPEALS FROM THE PTO AND DISTRICT COURTS IN PATENT CASES

A. *Jurisdiction*

The new court inherited the patent work of the United States Court of Customs and Patent Appeals (CCPA). Thus, it handles appeals: (1) from the PTO Board of Patent Interferences and the PTO Board of

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[2] As a supplement to this history, the reader is referred to: *The United States Court of Claims, A History, Parts I* (1976) and *II* (1978) (*Part II* hereinafter referred to as *Court of Claims History*); and *A Brief History of the United States Court of Customs and Patent Appeals* (1980).

Appeals, 35 U.S.C. § 134;[3] and (2) from the District Court for the District of Columbia when a patent applicant chooses to pursue his case there (instead of at the PTO Boards) after an adverse PTO decision, 35 U.S.C. §§ 145-146.

In addition, section 1295(a)(1) of 28 U.S.C. (1988) states that the Federal Circuit shall have exclusive jurisdiction:

> of an appeal from a final decision of a district court . . . if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, except that a case involving a claim arising under any Act of Congress relating to copyrights, exclusive rights in mask works, or trademarks and no other claims under section 1338(a) shall be governed by sections 1291, 1292, and 1294 of this title . . . .

Section 1338 in turn provides the district courts with original jurisdiction "of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trade-marks . . . . [or] . . . asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trade-mark laws." 28 U.S.C. § 1338 (1988). Thus, the Federal Circuit has jurisdiction of final decisions in district court cases whenever a patent claim, i.e., a claim "arising under any Act of Congress relating to patents," is present. The parameters of Federal Circuit jurisdiction in that regard have been the subject of a number of Federal Circuit, and in one instance Supreme Court, decisions.[4]

In *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422, 223 USPQ 1074 (Fed. Cir. 1984), the Federal Circuit in an in banc decision dealt at length with the court's jurisdiction over appeal of a nonpatent claim unaccompanied by appeal of a patent claim.

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[3] Until November 8, 1984, the PTO utilized a Board of Appeals, which reviewed adverse patentability determinations by patent examiners, and a Board of Patent Interferences, which determined priority of invention between inventors whose inventions were identical or essentially identical. However, by amendment effective on that date, the Board of Appeals and the Board of Patent Interferences were combined into a single PTO Board, the Board of Patent Appeals and Interferences (Patent Board).

[4] The Federal Circuit also deals with patent issues in: (1) appeals from the ITC in proceedings under ¶ 337 of the Tariff Act of 1930, 19 U.S.C. § 1337 (1988) (see § VII.B., *infra*); and (2) appeals from the Claims Court when it is alleged that the Federal Government is utilizing a patented process, product, etc. (see § IV.D.2., *infra*).

Atari had filed a complaint in district court (in Illinois) containing seven counts, only one of which, count II, was for patent infringement. Count I was for contributory copyright infringement, count III was a federal claim for unfair competition under section 43 of the Lanham Act, 15 U.S.C. § 1125(a), and counts IV-VII were under Illinois law for deceptive trade practices (count IV), fraud (count V), unfair competition (count VI), and misappropriation (count VII). The district court's jurisdiction of all federal claims (counts I, II, and III) was based on 28 U.S.C. § 1338, and its jurisdiction of the state claims (counts IV-VII) was pendent.

The district court preliminarily enjoined JS & A from contributory copyright infringement. Atari then moved for an order separating patent count II "for trial and judgment," and the district court issued an order granting Atari "leave to separate [c]ount II." JS & A then appealed the preliminary injunction order on contributory copyright infringement, and Atari moved to transfer the appeal to the Court of Appeals for the Seventh Circuit, alleging lack of jurisdiction in the Federal Circuit.

The issue before it was phrased by the Federal Circuit this way: "whether this court has jurisdiction over an appeal from an order preliminarily enjoining contributory copyright infringement when: (1) the jurisdiction of the district court over the action was based in part on 28 U.S.C. § 1338; (2) the pleadings allege a nonfrivolous, continuing claim for patent infringement; and (3) the district court has ordered separation of the patent claim." 747 F.2d at 1427, 223 USPQ at 1077.[5] Amicus curiae briefs, divided evenly respecting the proposed result, were submitted by: the Bar Association of the District of Columbia; the Committee on Patents of the Association of the Bar of the City of New York; the Boston Patent Law Association; the American Intellectual Property Law Association; the Bar Association of the District of Columbia; the Patent, Trademarks, and Copyright Section of the Virginia State Bar; the Orange County Patent Law Association; the Committee on Law and Technology of the Boston Bar Association;

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[5] The finality of the appealed order was not at issue. Though the Federal Circuit generally has jurisdiction only of "final" decisions, it was not disputed in the case that that includes, under 28 U.S.C. § 1292(a)(1), (c)(1), jurisdiction over an interlocutory appeal from a preliminary injunction order.

the Ad Hoc Committee of Antitrust Lawyers; and the United States Copyright Office.

The Federal Circuit, after analyzing the statutes involved, the legislative history, and other applicable evidence of Congress' intent, held that there was jurisdiction to decide the appeal. The "controlling fact," stated the court, was that "the district court's jurisdiction of the case was and still is based in part on § 1338." 747 F.2d at 1429, 223 USPQ at 1079. That is what gave the Federal Circuit jurisdiction and, once it had jurisdiction, it decided that it could resolve an appeal of the nonpatent claims:

> Congress recognized that non-patent claims might accompany a patent claim in a single complaint. It could have provided appellate jurisdiction in this court only over judgments entered on the patent claim. It did not. It designed and enacted a statute that provided jurisdiction in this court over appeals from decisions in "cases" in which the district court's jurisdiction "was based, in whole *or in part*, on Section 1338."

Id. (emphasis in original). *See also* discussion of *United States v. Hohri*, section V, *infra*.

Atari lectured to the court "on our need to exercise 'modesty' in assessing our jurisdiction." 747 F.2d at 1427, 223 USPQ at 1077. The court responded by stating that "[m]odesty" is "in the eye of the advocate," and it mentioned decisions in eleven cases in which "this court determined that it did not have jurisdiction." *Id.* The court, moreover, was fully aware of the importance of the question presented; that is why it invited submission of supplemental briefs from the parties and briefs amicus curiae from interested persons and organizations. The court made clear that its role—as with any court—is to accommodate what the statute states and Congress intended. To that end, it believed itself obliged to hold that it had jurisdiction over the case but that it would decide the nonpatent (copyright) issues involved using the discernible law of the Seventh Circuit. The use of regional circuit law in the latter regard is a practice that the Federal Circuit has consistently followed when confronted either with nonpatent substantive law issues or with procedural issues not unique or pertaining to patent law.

A different aspect of Federal Circuit jurisdiction was explored in *Wyden v. Commissioner of Patents & Trademarks*, 807 F.2d 934, 231 USPQ 918 (Fed. Cir. 1986) (in banc). The "patent claim" there was not the traditional patent infringement type, and the issue arose as to whether it was a claim arising under an Act "relating to patents."

The appeal in *Wyden* was from a decision of the District Court for the District of Columbia granting a motion for summary judgment of the PTO Commissioner and denying a petition of Stephen Wyden. Mr. Wyden had petitioned the Commissioner to overturn the action of the PTO Director of the Office of Enrollment and Discipline, who had failed to award Wyden a passing grade on the examination for registration to practice before the PTO.

The threshold issue, stated the court, "to be cleared in every case, whether or not challenged by a party [is our jurisdiction]." 807 F.2d at 935, 231 USPQ at 919. Here, the court noted, at least one of Wyden's major claims arose under 35 U.S.C. § 32, which, together with section 31 "are the statutory provisions in the organic patent law which pertain to the registration in the PTO of agents and attorneys, which is a prerequisite to their practicing in the PTO in patent matters, their discipline, and removal from the register." 807 F.2d at 935, 231 USPQ at 920. In that regard, the majority opinion was in "full agreement" with this statement of the Court of Appeals for the District of Columbia in *Jaskiewicz v. Mossinghoff*, 802 F.2d 532, 231 USPQ 477 (1986):

> An action for review of a decision of the Commissioner of the Patent and Trademark Office disciplining an attorney pursuant to 35 U.S.C. § 32 arises under an Act of Congress relating to patents. Therefore, jurisdiction in the District Court is based at least in part on 28 U.S.C. § 1338, and appellate review of that court's decision is granted exclusively to the Federal Circuit by 28 U.S.C. § 1295(a).

802 F.2d at 536-37, 231 USPQ at 481.

Chief Judge Markey, though, dissented. His opinion revealed a strong belief that Congress did not intend to have the claim involved covered under the grant of exclusive jurisdiction given to the Federal Circuit. He was particularly concerned with the opinion's effect on other statutes related in some way to patents but which, he believed, do not provide a basis for patent appeals to the court. He stated:

> Seizing upon the naked phrase "relating to patents" as a basis for its assertion of jurisdiction never granted it by the Congress, the court disturbingly finesses the effect of its decision on untold future appeals involving other statutes, and on future panels of this court, with "[we] express no opinion [as to other statutes not before us]." I can discern no principled basis

> for distinguishing § 32 from any other section of Title 35 governing Patent and Trademark Office (PTO) administration . . . or from any of the many statutes listed in Part III [of the Chief Judge's dissent], *infra*, each of which "relates to patents" as much and often *more* than § 32 does. The end result of the court's action here, whether desired by one or all judges, is to place the entire administration of the PTO under review by this court. The result is also to sweep into the jurisdiction of this court numerous petitions and statutes now within the jurisdiction of our sister circuits.

807 F.2d at 937-38, 231 USPQ at 921 (emphasis in original).

Christianson v. Colt Indus. Operating Corp., 822 F.2d 1544, 3 USPQ2d 1241 (Fed. Cir. 1987), was another significant jurisdictional opinion, although this time not decided in banc. It addressed the "arising under" language in 28 U.S.C. § 1338. In particular, it involved whether patent invalidity allegations raised in defense to a trade secret counterclaim create a district court action in whole or in part "arising under" the patent laws.

Colt sued Springfield for patent infringement and also sought a preliminary injunction against performance of Springfield's contract to sell certain rifles to El Salvador, alleging unauthorized use of Colt's trade secrets. Colt joined its former employee, Charles Christianson, as a defendant to the suit, believing that he divulged trade secrets to Springfield; however, the suit was subsequently dropped as to him. In a separate suit, Christianson sued Colt under the federal antitrust laws and later added a count of tortious interference with contractual relationships. The two suits were consolidated for discovery and trial, but shortly thereafter, the patent suit was settled. That left pending in district court only the Christianson antitrust/tortious interference suit.

Colt filed a counterclaim in that suit, alleging, *inter alia*, that Christianson improperly used Colt's trade secrets. Christianson answered the counterclaim with an allegation, *inter alia*, that Colt concealed vital information in its patents, in violation of the patent laws, specifically 35 U.S.C. § 112, paragraph 1, and is now improperly asserting the information as trade secrets.[6] The district court granted Christianson's motion for summary judgment, stating that because Colt's patent disclosures did not satisfy the enablement or best mode requirement of 35 U.S.C. § 112, paragraph 1, the patents were invalid and any claim of trade secrecy based on the undisclosed information was likewise invalid. The district court certified the ruling for immediate appeal under 28 U.S.C. § 1292(b) and Fed. R. Civ. P. 54(b).

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[6] 35 U.S.C. § 112, ¶ 1 (1988), states:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Colt appealed to the Federal Circuit, but Christianson filed a motion to transfer to the Court of Appeals for the Seventh Circuit (Seventh Circuit). Christianson argued that the Federal Circuit lacked jurisdiction because his antitrust action was not one "rising under" the patent laws. His motion was granted. Subsequently, though, the Seventh Circuit retransferred the case to the Federal Circuit, holding that the case "arises under" the patent laws. On retransfer back to the Federal Circuit, Christianson moved to dismiss. The Federal Circuit agreed with Christianson that jurisdiction lies in the Seventh Circuit but it decided that the interests of justice require reaching a decision on the merits as opposed to dismissing the appeal or again transferring to the Seventh Circuit. It therefore decided the merits, "[n]otwithstanding a strong sense of discomfort occasioned by our view of our jurisdiction." 822 F.2d at 1560, 3 USPQ2d at 1253.

On review, the Supreme Court agreed with the Federal Circuit that it does not have jurisdiction because the action is not one "arising under" the patent statute for purposes of 28 U.S.C. § 1338(a). The Court stated that section 1338 jurisdiction should extend "only to those cases in which a well-pleaded complaint establishes either that federal patent law creates the cause of action or that the plaintiff's right to relief necessarily depends on resolution of a substantial question of federal patent law, in that patent law is a necessary element of one of the well-pleaded claims." 486 U.S. 800, 809 (1988). Because patent law did not in any sense create Christianson's antitrust or intentional interference claim, and it was not "a necessary element of one of the well-pleaded [antitrust] claims," the Court decided that jurisdiction was with the Seventh Circuit. It then vacated the Federal Circuit decision on the merits, reasoning that once the Federal Circuit

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That paragraph embodies an "enablement requirement" (as to making and using the invention), a "written description" requirement, and a "best mode" requirement.

determined there was no jurisdiction, it should have either dismissed the case or retransferred it to the Seventh Circuit.[7]

In *Aerojet-General Corp. v. Machine Tool Works, Oerlikon-Buehrle, Ltd.*, 895 F.2d 736, 13 USPQ2d 1670 (1990) (in banc), the Federal Circuit addressed the above-quoted jurisdictional test of *Christianson*, in the context of determining whether "arising under" jurisdiction can be based on a nonfrivolous compulsory patent counterclaim. Pre-*Christianson* cases had indicated in dicta that Federal Circuit jurisdiction can be based on such a counterclaim. *Christianson* itself did not involve a patent counterclaim, but the jurisdictional test it used had to be considered, because, as mentioned above, it contains language concerning a "well-pleaded *complaint*." In light of that language, the issue facing the Federal Circuit in *Aerojet* was whether a counterclaim could be the basis of "arising under" and, hence, Federal Circuit jurisdiction. The answer was yes:

> We find no conflict . . . between a proper application of the well-pleaded complaint rule and our holding that this court has appellate jurisdiction when a nonfrivolous well-pleaded compulsory patent law counterclaim is present in a case originally and properly filed in the district court.
>
> It is apparent from their unanimous opinion that the Justices [in *Christianson*] did not intend to make a rigid application of the well-pleaded complaint rule a Procrustean bed for this court's jurisdiction. The Court cited its own prior statement in *Merrell Dow Pharmaceuticals Inc. v. Thompson* [citation omitted] (1986) that "determinations about federal jurisdiction require sensitive judgments about congressional intent, judicial power, and the federal system." 108 S. Ct. at 2173 n.2, 7 USPQ2d at 1113 n.2. Indeed, the Court has long held: "If the history of the interpretation of judiciary legislation teaches us anything, it teaches the duty to reject treating such statutes as a wooden set of self-sufficient words." *Romero v. International Terminal Operation Co.*, 358 U.S. 354, 379 [remaining citation omitted] (1959); *see also Franchise Tax Bd. v. Construction Laborers Vacation Trust*, 463 U.S. 1, 20 [remaining citation omitted] (1983) (jurisdictional legislation interpreted "with an eye toward practicality and necessity").

Id. at 741, 13 USPQ2d at 1674-75.

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[7] The Court also stated that the decision of the transferor court should become law of the case. Application of that rule in *Christianson* would have forced the Seventh Circuit to keep the case when it was originally transferred there by the Federal Circuit, and, hence, prevented the transfer-retransfer situation that developed.

B. *Standard of Review*

The Federal Circuit reviews PTO Board decisions under a "clearly erroneous" standard for fact findings and an erroneous standard for legal questions. *See, e.g., In re Caveney,* 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985). It has applied the same standard in nonjury trials from district courts, pursuant to rule 52(a) of the Federal Rules of Civil Procedure. *See, e.g., Panduit Corp. v. Dennison Mfg. Co.,* 810 F.2d 1561, 1565, 1 USPQ2d 1593, 1594-95 (Fed. Cir.), *cert. denied,* 481 U.S. 1052 (1987). The Supreme Court in that case had instructed the Federal Circuit to explain more clearly, *inter alia,* whether it utilized rule 52 in reviewing certain of the district court's fact findings. 475 U.S. 809, 810-11, 229 USPQ 478, 479 (1986). On remand, the Federal Circuit reaffirmed that it had used that standard not only in the case at bar but, also, consistently in the past.

C. *Resolving Conflicts and Rectifying Misconceptions*

A primary objective of creating the Federal Circuit was to promote uniformity in administering the patent laws. Though applying the same national statutory law, the various courts of appeals were often treating the same question inconsistently, with the result that a patent holder could expect different results in different forums. *See The First Two Thousand Days, supra* note 1, at 2-4. That consequence in turn often prompted lawyers to spend many years and client dollars "forum shopping," *id.,* a result that became particularly troublesome to patentees after *Blonder-Tongue Laboratories, Inc. v. University of Ill. Found.,* 402 U.S. 313, 169 USPQ 513 (1971). That case made it clear that a holding of patent invalidity in one decision generally precluded the patentee from asserting the patent against a different infringer. In contradistinction, a holding of patent validity against one infringer typically does not preclude a different infringer from challenging the patent's validity. As a result, infringers were often willing to risk infringement of a patent previously upheld in litigation, in the hope that a different court in another circuit, often dealing with the same issue of patentability as did the previous court, would declare the patent invalid.

The situation was particularly troublesome in the area of nonobviousness, a statutory requirement for patentability under 35 U.S.C. § 103 since 1952. That section prohibits one from obtaining a patent "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103 (1988). Regarding section 103, these conflicts had existed among the courts of appeals prior to the creation of the Federal Circuit: (1) some, but not all, courts of appeals required that, for an invention to be nonobvious, a synergistic effect must be associated with the invention; (2) some courts of appeals held that nonobviousness is a question of law, reviewable on appeal from a bench trial free of the "clearly erroneous" standard of review applicable to findings of fact (Fed. R. Civ. P. 52(a)); other courts held that nonobviousness is a fact question; (3) courts were split on whether the nonobviousness of a patented design should be evaluated from the viewpoint of (a) "an ordinary intelligent man" or (b) an "ordinary designer"; and (4) in some courts of appeals, a prima facie case of obviousness of a claimed chemical compound, based on similar structures disclosed in prior art references, could be rebutted by evidence of new and expected properties; in other courts, however, no such rebuttal evidence was allowed. *See generally* Markey, *The Phoenix Court*, 10 APLA Q.J. 227, 231-35 (1982).

Those conflicts in the nonobviousness area have been addressed by the Federal Circuit. This court has made it clear that: (1) an absence of "synergism" has no place in evaluating nonobviousness, although the presence of a synergistic effect, either alone or together with other objective criteria of nonobviousness (*e.g.*, long-felt need, commercial success), is a factor weighing in favor of nonobviousness, *see, e.g.*, *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983); (2) nonobviousness is a question of law, although it depends on a number of underlying fact questions, *see, e.g.*, *Panduit v. Dennison*, 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1595-97 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987); (3) nonobviousness of a design patent should be assessed from the perspective of an ordinary designer rather than the ordinary observer or reasonable man, a result consistent with the "person having ordinary skill in the art" language of section 103, *see, e.g.*, *Petersen Mfg. Co. v. Central Purchasing, Inc.*, 740

F.2d 1541, 1547, 222 USPQ 562, 567 (Fed. Cir. 1984); and (4) a showing of prima facie obviousness based on the closeness in structure between the claimed compound and structures shown in the prior art can be overcome by a showing of unexpected results, *see, e.g., In re De Blauwe*, 736 F.2d 699, 703-06, 222 USPQ 191, 195-97 (Fed. Cir. 1984).

Those propositions logically flow from a broader approach, originally enunciated by the Supreme Court, which the Federal Circuit has repeatedly reaffirmed. In 1966, the Supreme Court stated the proper way to resolve the nonobviousness issue:

> [1] the scope and content of the prior art are to be determined; [2] differences between the prior art and the claims at issue are to be ascertained; and [3] the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Those three determinations, the Federal Circuit has concluded, constitute three of the four basic fact inquiries underlying the legal question of nonobviousness.

The fourth fact inquiry articulated by the Supreme Court in *Graham* is ascertaining the existence of "[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc.," which "give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18, 148 USPQ at 467. The Federal Circuit has made clear that such "secondary" criteria are "secondary" in time only, not in importance, *Truswal Sys. Corp. v. Hydro-Air Eng'g, Inc.*, 813 F.2d 1207, 1212, 2 USPQ2d 1034, 1038 (Fed. Cir. 1987), and when present *must* be considered in assessing nonobviousness. *See, e.g., Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1026, 226 USPQ 881, 887 (Fed. Cir. 1985). In *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1580, 219 USPQ 8, 12 (Fed. Cir. 1983), for example, the court rejected the district court's notion that a claimed invention cannot be saved from invalidity "by resorting to 'secondary factors'"; it stated that obviousness "can be resolved only after *all* relevant evidence of nonobviousness, including so-called 'secondary considerations,' if any, has been taken into account." (Emphasis in original.) Indeed, such evidence is often the most helpful in objectively assessing whether the prior art truly suggests the claimed invention or, more precisely, whether the claimed invention "would have been obvious at the time the invention was made to a person of ordinary skill in the art." In that regard, such objective evidence serves "as insurance against the insidious attractions of the siren hindsight when confronted with a difficult task of evaluating the prior art." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The court has also tried to eliminate certain slogans, sometimes used by other courts of appeals, that confuse the nonobviousness inquiry. The need for "synergism," discussed above, is one such slogan. The court has also admonished against mischaracterizing the section 103 inquiry as an "obvious to try" approach, which had sometimes been used by other courts. *See, e.g., In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Also, opinions in other circuits sometimes referred to the obviousness of so-called "combinations of old elements," a phrase which disparagingly distinguished such combinations from "combinations of new elements." That dichotomy, which often resulted in patentability for the "new element" but not the "old element" combination, was misleading because in essence any new combination can be dissected into old elements. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983). In any event, the test required by the statute is not whether the combination is of old elements or new elements. It is whether the novel combination (it must be "novel" under 35 U.S.C. § 102 (1988)) would have been nonobvious to one of ordinary skill in the art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 959-60, 1 USPQ2d 1196, 1198-99 (Fed. Cir. 1987).

Another incorrect perception existing in the nonobviousness area was for courts to focus on the nonobviousness or obviousness of the *differences* between the claimed invention and prior art. Instead, the Federal Circuit has stated, the focus should be on the nonobviousness or obviousness of the claimed invention as a whole. *See, e.g., Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579, 219 USPQ 8, 12 (Fed. Cir. 1983). Consideration of the differences between the claimed invention and prior art is only one factor to consider. Other factors are, *e.g.*, the level of skill in the art and objective criteria of nonobviousness (commercial success, long-felt need, etc.).

The Federal Circuit has also pointed out that the critical inquiry under section 103 is not whether there is truly an *invention*. Rather, it is whether the applicant's invention would have been obvious. Thus:

> It was also error for the district court to assert that "innovation is not invention." The terms are, at least since the 1952 Patent Act, legally synonymous. Innovation is *always* invention; it may not be *patentable* invention. "Invention," since the advent of § 103, is no longer the prerequisite to patentability which it was prior to 1952. *Graham v. John Deere.*

Id. at 1580, 219 USPQ at 12 (emphasis in original). In a related fashion, the Federal Circuit has concluded, a "flash of genius" test is no longer viable. *Vandenberg v. Dairy Equip. Co., Div. of DEC Int'l, Inc.*, 740 F.2d 1560, 1565, 224 USPQ 195, 197 (Fed. Cir. 1984).

In addition, the Federal Circuit has consistently cautioned district courts to observe the statutory presumption of nonobviousness and of other aspects of validity, and to keep the burden of persuasion throughout on the one challenging validity. *See* 35 U.S.C. § 282.[8] That was something that was not occurring on a consistent basis prior to 1982.

Also existing prior to 1982 were repeated, oftentimes misleading, references to patents as "monopolies." Though a patent in a sense corresponds to one dictionary definition of monopoly, i.e., "the exclusive possession or control of something" (*The Random House College Dictionary* (1980)), reference to patents as monopolies too often created the perception of monopoly in a different, economic sense, replete with notions of something violating the antitrust laws or otherwise antithetical to free competition. That perception is unfortunate, particularly if it infects the decision-making process on nonobviousness or other aspects of validity, and Federal Circuit decisions have attempted to clarify matters.

The "exclusive possession or control of something," whether one's patent rights or one's automobile, does not necessarily give one a monopoly in the economic sense. Market power in a relevant market is needed and, because other goods often compete with the patented goods, "'not every patent confers market power.'" *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 875 n.9, 228 USPQ 90, 100 n.9 (Fed. Cir. 1985). Hence, in and of themselves, "patent rights are not *legal monopolies* in the antitrust sense of the word." *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1367, 220 USPQ 763, 776 (Fed. Cir.) (emphasis in original), *cert. denied*, 469 U.S. 821 (1984). As stated in *Schenck v. Nortron Corp.*, 713 F.2d 782, 786 n.3, 218 USPQ 698, 701 n.3 (Fed. Cir. 1983):

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[8] That section states: "A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." 35 U.S.C. § 282 (1988).

> A patent, under the statute, is property. 35 U.S.C. § 261. Nowhere in any statute is a patent described as a monopoly. The patent right is but the right to exclude others, the very definition of "property." . . . It is but an obfuscation to refer to a patent as "the patent monopoly" or to describe a patent as an "exception to the general rule against monopolies."

Moreover, the patent system, which is rooted in the United States Constitution (article I, section 8, clause 8), serves a very positive function in our system of competition, i.e., "'the encouragement of investment based risk' [citation omitted]. By so doing, it 'encourages innovation and its fruits: new jobs and new industries, new consumer goods and trade benefits [citation omitted].'" *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 876-77, 228 USPQ 90, 100-01 (Fed. Cir. 1985).

Nonobviousness is not the only area in which conflicts had existed. *See generally* Markey, *The Phoenix Court*, 10 APLA Q.J. 227, 231-35 (1982). The Federal Circuit has clarified at least these other areas of prior conflict: (1) whether a licensee may challenge the validity of a licensed patent in a declaratory judgment action without terminating the license (the Federal Circuit has answered "Yes," *see, e.g., C.R. Bard, Inc. v. Schwartz*, 716 F.2d 874, 219 USPQ 197 (1983)); (2) whether experimental use evidence can be introduced regarding the "on sale" bar of 35 U.S.C. § 102(b), even if there is no provision in the contract of sale that the sale is made primarily for experimental purposes (the Federal Circuit has never indicated that such a provision is required);[9] (3) whether the burden of proof in a challenge to patent validity based on the section 102(b) "public use" or "on sale" bar is "clear and convincing" evidence (the Federal Circuit has answered "Yes," *see, e.g.*, *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 2 (1985)); (4) whether inventorship can be changed under 35 U.S.C. § 256 without the cooperation of the patentee or assignee (the Federal Circuit has answered "Yes," *see, e.g.*, *MCV, Inc. v. King-Seeley Thermos Co.*, 870 F.2d 1568, 1573, 10 USPQ2d 1287, 1292 (1989));[10] (5) whether prosecution history estoppel as a limitation to the doctrine of equivalents can be based on arguments to the PTO, as opposed to claim amendments (the Federal Circuit has answered "Yes," *see, e.g.*, *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362-63, 219 USPQ 473, 481 (1983)); (6) whether, under prosecution history estoppel, virtually any amendment of the claims creates an estoppel that automatically bars *all* resort to the doctrine of equivalents, confining the patentee strictly to the letter of the limited claims granted (the Federal Circuit has answered "No"; the scope of the estoppel and the range of equivalents allowed depends on the facts of each case, *see, e.g.*, *Loctite Corp. v. Ultraseal Ltd*, 781 F.2d 861, 871-72, 228 USPQ 90, 96-97 (1985)); (7) whether the "late claiming" defense of *Muncie Gear Works, Inc. v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759, 53 USPQ 1 (1942), stands for a mere prohibition against new matter or whether it stands for something more (the Federal Circuit has stated that the so-called "late claiming" defense of *Muncie Gear* has an inappropriate and discredited label; the "sole question" raised by that defense "is whether the claims entered by amendment were supported by the disclosure in [the] original application," *see, e.g.*, *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1517-18, 220 USPQ 929, 940 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984)); (8) whether the "best mode" defense of section 112, paragraph 1, requires a showing of intent to conceal (the Federal

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[9] Under 35 U.S.C. § 102 (1988), a person is entitled to a patent unless "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . . ."

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[10] 35 U.S.C. § 256 (1988) states:

> Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issued [sic] a certificate correcting such error.
>
> The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

Circuit has stated that "evidence of 'concealment' (accidental or intentional), is to be considered," *see, e.g., DeGeorge v. Bernier*, 768 F.2d 1318, 1324-25, 226 USPQ 758, 763 (1985)); and (9) whether the district court must resolve validity first, then infringement if necessary, or vice versa (the Federal Circuit has said that, generally, the district court must resolve both issues in order to place the case in the proper stage for appeal, *see, e.g., Stratoflex v. Aeroquip Corp.*, 713 F.2d 1530, 1540-41, 218 USPQ 871, 880 (1983)).

Summing up, because of the conflicts and misconceptions existing in the patent area prior to 1982, the federal patent statute may not have been getting the treatment that Congress intended. By correcting those misconceptions and resolving conflicts, the Federal Circuit, hopefully, has promoted more rigid adherence to the statutory dictates of Congress and, consequently, has helped assure the patent system of its proper role in society.

D. *Inequitable Conduct*

Numerous cases since 1982 have raised charges of inequitable conduct by the patentee during prosecution in the PTO. The case law is clear that both a certain level of intent and materiality are needed. Once those levels are established, the district court judge is to see if a holding of inequitable conduct is warranted. Whether it is warranted, the court stated in an in banc portion of its opinion in *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876, 9 USPQ2d 1384, 1392 (Fed. Cir. 1988), is an equitable determination committed to the discretion of the trial court and reviewed on appeal under an abuse of discretion standard.

A necessary level of materiality can be established by any of four tests: objective "but for," subjective "but for," "but it may have been," and the standard of PTO rule 1.56(a), i.e., whether there is a substantial likelihood that a reasonable examiner would have considered the omitted reference or false information important in deciding whether to allow the application to issue as a patent. *J.P. Stevens & Co. v. Lex Tex Ltd.*, 747 F.2d 1553, 1559, 223 USPQ 1089, 1092 (Fed. Cir. 1984), *cert. denied*, 474 U.S. 822 (1985). The latter test "is the appropriate starting point because it is the broadest and because it most closely aligns with how one ought to conduct business with the PTO." *Id.* Of course, if a more rigid test for materiality is met (*e.g.*, objective "but for" test), a higher degree of materiality might be shown, which might make it easier for a judge to reach a conclusion of inequitable conduct.

A certain degree of intent is also needed. In *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876, 9 USPQ2d 1384, 1392 (Fed. Cir. 1988), the court in its in banc statement emphasized the need to find an "intent to deceive."

A determination of inequitable conduct before the PTO results in a holding of unenforceability. The unenforceability exists not only for the patent claim most directly involved but, also, for the other claims of the patent, *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d at 877, 9 USPQ2d at 1392. It can also extend to other patents to which the inequitable conduct is related. *Consolidated Aluminum Corp. v. Foseco Int'l Ltd.*, 910 F.2d 804, 809-10, 15 USPQ2d 1481, 1485-86 (Fed. Cir. 1990).

A holding of inequitable conduct can also lead to a finding of "exceptional" for purposes of awarding attorney fees under 35 U.S.C. § 285 (1988).[11]

E. *Infringement*

The court has made clear that literal infringement typically requires: (1) claim interpretation; and (2) assessing whether the properly interpreted claims read on the accused process, composition, or device. If there is no literal infringement, infringement is still possible under the doctrine of equivalents. Thus, if the accused device and claimed invention perform substantially the same function in substantially the same way to give substantially the same result, infringement can be found. The latter doctrine, though, is limited by prosecution history estoppel (i.e., the patentee cannot recapture certain coverage given up during prosecution) and by preventing the patentee from recovering for devices that were in the prior art. *See Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 870, 228 USPQ 90, 96 (Fed. Cir. 1985).

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[11] That section states that "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party."

The situation presented by "means plus function" claims has been the subject of a number of opinions.[12] In *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934, 4 USPQ2d 1737, 1739 (Fed. Cir. 1987) (in banc), *cert. denied*, 485 U.S. 961, 1009 (1988), the court first analyzed literal infringement of such claims and stated:

> To determine whether a claim limitation is met literally, where expressed as a means for performing a stated function, the court must compare the accused structure *with the disclosed structure*, and must find equivalent *structure* as well as *identity* of claimed *function* for that structure. *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 975, 226 USPQ 5, 8 (Fed. Cir. 1985); *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1575, 225 USPQ 236, 239 (Fed. Cir. 1985); *Radio Steel & Mfg. Co. v. MTD Prods.*, Inc., 731 F.2d 840, 848, 221 USPQ 657, 663 (Fed. Cir. 1984). [Emphasis in original.]

After affirming the district court finding of no literal infringement, *Pennwalt* went on to discuss the doctrine of equivalents. It stated that infringement under the doctrine of equivalents can be found if there is substantial identity in function, way, and result, but that "does not mean one can ignore claim limitations." Repeating what "this court recently stated in *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 3 USPQ2d 1321 (Fed. Cir. 1987)," the *Pennwalt* majority stated:

> "One must start with the claim, and though a 'non-pioneer' invention may be entitled to some range of equivalents, a court may not, under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement. . . . Though the doctrine of equivalents is designed to do equity, and to relieve an inventor from a semantic strait jacket when equity requires, it is not designed to permit wholesale redrafting of a claim to cover non-equivalent devices, i.e., to permit a claim expansion that would encompass more than an insubstantial change. [Citations omitted.]
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> ". . . [I]n applying the doctrine of equivalents, each limitation must be viewed in the context of the entire claim. . . . 'It is . . . well settled that each element of a claim is material and essential, and that in order for a court to

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[12] 35 U.S.C. § 112, ¶ 6 (1988), states: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." The Federal Circuit has held, however, that one cannot have a single means claim, i.e., a claim reading on a single means for performing a specified function, not in combination with other claimed elements. *See In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983).

> find infringement, the plaintiff must show the presence of every element or its substantial equivalent in the accused device.' *Lemelson v. United States*, 752 F.2d 1538, 1551, 224 USPQ 526, 533 (Fed. Cir. 1985) [footnote omitted]. To be a 'substantial equivalent,' the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed."

833 F.2d at 935, 4 USPQ2d at 1739-40.

F. *Damages and Attorney Fees*

After liability (*e.g.*, validity, infringement) is established, a district court will often conduct a trial on damages. Discretionary bifurcation of the trial into a liability and a damage phase, in conjunction with 28 U.S.C. § 1291(c)(2) (1988) (which allows appeals in patent cases that are final except for an accounting), allows the infringer to appeal the liability phase without the parties undergoing a trial on proof of damages. If the liability determination is reversed, a trial on damages becomes unnecessary. Often, therefore, appeals to the Federal Circuit involve only liability and, at some later date, only damages.

On appeal of damages issues, the Federal Circuit has frequently stressed the discretion allowed a district court judge in assessing the methodology and quantification of damages. *See, e.g.*, *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895, 898, 229 USPQ 525, 526 (Fed. Cir.), *cert. denied*, 479 U.S. 852 (1986). The award will not be overturned unless it is based on a clear error of fact, an error of law, or a manifest error of judgment. *Nickson Indus., Inc. v. Rol Mfg. Co.*, 847 F.2d 795, 798, 6 USPQ2d 1878, 1879 (Fed. Cir. 1988).

The damage award must be "adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court." 35 U.S.C. § 284, paragraph 1 (1988). Lost profits can be awarded if the patentee can show a reasonable probability that it would have made the profits but for the infringement. *Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1326, 5 USPQ2d 1255, 1260 (Fed. Cir. 1987); *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1064, 219 USPQ 670, 675 (Fed. Cir. 1983). Otherwise, a reasonable royalty is common, and is often established either by taking into consideration established industry rates or hypothetically deciding the basis upon which a willing licensor and licensee would have agreed. *See, e.g.*, *Fromson v. Western Litho Plate & Supply Co.*, 853

F.2d 1568, 1574-79, 7 USPQ2d 1606, 1612-16 (Fed. Cir. 1988). Some opinions have stated that infringers should be required to pay more than the industry licensing rate, lest there be no downside to infringement. As stated in *Stickle v. Heublein, Inc.*, 716 F.2d 1550, 1563, 219 USPQ 377, 387 (Fed. Cir. 1983):

> As a final matter we would add that the trial court may award an amount of damages greater than a reasonable royalty so that the award is "adequate to compensate for the infringement." As stated in *Panduit Corp. v. Stahlin Bros. Fibre Workers, supra*, 575 F.2d at 1178, 197 USPQ at 731 [6th Cir. 1978]:
>
> > "[T]he infringer would have nothing to lose, and everything to gain if he could count on paying only the normal, routine royalty non-infringers might have paid. As said by this court in another context, the infringer would be in a 'heads-I-win, tails-you-lose' position."
>
> Such an increase, which may be stated by the trial court either as a reasonable royalty *for an infringer* (as in *Panduit*) or as an increase in the reasonable royalty determined by the court, is left to its sound discretion. [Emphasis in original.]

See also Fromson, 853 F.2d at 1574-76, 7 USPQ2d at 1612-14; *Nickson Indus., Inc. v. Rol Mfg. Co.*, 847 F.2d 795, 798, 6 USPQ2d 1878, 1881 (Fed. Cir. 1988). The bottom line, of course, is to compensate adequately under 35 U.S.C. § 284.

The infringer is subject to increased damages under 35 U.S.C. § 284, paragraph 2 (1988), and attorney fees under 35 U.S.C. § 285 (1988), and those have been at issue in numerous cases. The key to such awards has often been a finding of willful infringement. For section 285 attorney fees, for example, willful infringement is often the basis of the necessary finding that the case is "exceptional." (Another common basis for a finding of "exceptional" is inequitable conduct before the PTO.)

Assessing when willful infringement exists can often be, literally and figuratively, the "million dollar question," and there are no clear answers. Instead:

> It is necessary to look at "the totality of circumstances presented in the case" [citations omitted], in determining whether a reasonable person would prudently conduct himself with any confidence that the courts might hold the patent invalid [or not infringed].

Central Soya Co. v. Geo. A. Hormel & Co., 723 F.2d 1573, 1577, 220 USPQ 490, 492 (Fed. Cir. 1983). The "totality of circumstances" considered in determining willful infringement includes "(1) whether the infringer deliberately copied the ideas or design of another; (2) whether the infringer, when he knew of the other's patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed, and (3) the infringer's behavior as a party to the litigation." *Bott v. Four Star Corp.*, 807 F.2d 1567, 1572, 1 USPQ2d 1210, 1213 (Fed. Cir. 1986). Also a factor to consider, but not necessarily dispositive either way, is obtaining the advice of counsel. *See, e.g., Rite-Hite Corp. v. Kelley Co.*, 819 F.2d 1120, 1125, 2 USPQ2d 1915, 1918-19 (Fed. Cir. 1987).

G. *Jury Trials*

The Federal Circuit has made it clear that, under the seventh amendment to the Constitution, parties are entitled to jury trials in patent cases. Such trials, as in other areas, are conducted under the discretionary procedural guidance of the trial judge, with any alleged errors in that regard reviewed under an abuse of discretion standard. The Federal Circuit has, however, suggested that trial judges and counsel facilitate appellate review by utilizing devices provided by the Federal Rules of Civil Procedure (*e.g.*, special verdicts, interrogatories) that will help ascertain the jury's underlying factual findings. In the absence of such devices, *e.g.*, when a general verdict is rendered, the court has presumed findings consistent with the general verdict and the instructions, and dealt with such findings accordingly. In the context of a JNOV motion, for example, such presumed findings are reviewed to see if they are supported by substantial evidence. *See, e.g., Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893, 221 USPQ 669, 673 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984); *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1513, 220 USPQ 929, 936 (Fed. Cir.), *cert. denied*, 469 U.S. 871 (1984).

H. *Interesting Areas of Technology*

Though the technology involved in cases before the court has varied from the simple to the sublime, two of the more interesting areas are biotechnology and computers. Those areas have generated considerable interest in the scientific community, and they might invoke much litigation in the future.

1. *Computers*

In *In re Grams,* 888 F.2d 835, 12 USPQ2d 1824 (Fed. Cir. 1989), the Federal Circuit reaffirmed what was previously said by the CCPA and the Supreme Court: when the claimed invention is in essence a mathematical algorithm, the claims are deemed not drawn to statutory subject matter under 35 U.S.C. § 101.[13] The opinion also repeated the admonition of CCPA cases that not all claims containing mathematical algorithms are in essence drawn to the algorithm and, hence, barred. The critical question when confronted with such claims is always this: "What did applicants invent?" In answering that:

> "[e]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is."

888 F.2d at 839, 12 USPQ2d at 1827-28 (quoting *In re Abele,* 684 F.2d 902, 907, 214 USPQ 682, 686 (CCPA 1982)). That the answer to the critical question will depend on the facts of each case is illustrated by comparing the result in *In re Grams,* where the claims were held to be nonstatutory, with that in *In re Iwahashi,* 888 F.2d 1370, 1375, 12 USPQ2d 1908, 1912 (Fed. Cir. 1989), where the Federal Circuit reversed the PTO's rejection under section 101.

2. *Biotechnology*

The court has only started to scratch the surface of what many expect to be a fertile area of litigation.

In *In re Lundak,* 773 F.2d 1216, 227 USPQ 90 (Fed. Cir. 1985), the court rejected rigid application of the PTO's rule that an inventor in the field of microbiology is required to deposit a sample of certain biological materials (i.e., those not readily reproducible from their written description) with an independent depository on or before the date the inventor files a patent application. It held that Lundak's procedures, which included filing the deposit at a recognized depository six days after the application was filed, were satisfactory.

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[13] That section states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." 35 U.S.C. § 101 (1988).

Other "biotech related" opinions have included these: *Intervet Am., Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 12 USPQ2d 1474 (Fed. Cir. 1989) (the court reversed a district court judgment holding that Intervet America, Inc., failed to prove infringement of a patent entitled "Infectious Bursal Disease Vaccine"); *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) (the court reversed a PTO rejection for lack of enablement under 35 U.S.C. § 112, paragraph 1, of the claims in an application styled "Immunoassay Utilizing Monoclonal High Affinity IgM Antibodies"); *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988) (the court affirmed a PTO rejection under 35 U.S.C. § 103 of a patent application styled "Method and Hybrid Vector for Regulating Translation of Heterologous DNA in Bacteria"); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987) (the court reversed a district court decision holding invalid, under 35 U.S.C. §§ 102(g), 103, and 112 (first and second paragraphs),[14] all twenty-nine claims of plaintiff's patent entitled "Immunometric Assays Using Monoclonal Antibodies").

II. APPEALS FROM THE MERIT SYSTEMS PROTECTION BOARD

A. *Overview of the Civil Service Reform Act of 1978*

The civil service system prior to the Civil Service Reform Act of 1978 (CSRA) constituted an "outdated-patchwork of statutes and rules built up over almost a century." *United States v. Fausto*, 484 U.S. 439, 444 (1988). Under that system:

> only veterans enjoyed a statutory right to appeal adverse personnel action to the Civil Service Commission (CSC), the predecessor of the MSPB. 5 U.S.C. § 7701 (1976 ed.). Other employees were afforded this type of administrative review by Executive Order. Exec. Order No. 11491, § 22, 3 CFR 874 (1966-1970 Comp.), note following 5 U.S.C. § 7301 (1976 ed.) (extending CSC review

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[14] 35 U.S.C. §§ 103 and 112, ¶ 1, have for the most part been reproduced, *supra*. The second paragraph of 35 U.S.C. § 112 states that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (1988). Section 102(g) proscribes the grant of a patent if "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." 35 U.S.C. § 102(g) (1988).

> to competitive service employees). Still others, like employees in respondent's classification, had no right to such review. As for appeal to the courts: Since there was no special statutory review proceeding relevant to personnel action, see 5 U.S.C. § 703, employees sought to appeal the decision of the CSC, or the agency decision unreviewed by the CSC, to the district courts through the various forms of action traditionally used for so-called nonstatutory review of agency action, including suits for mandamus. [Citations omitted.] For certain kinds of personnel decisions, federal employees could maintain an action in the Court of Claims of the sort respondent seeks to maintain here. [Citations omitted.]

United States v. Fausto, 484 U.S. 439, 444-45 (1988). Congress responded to that situation by enacting the CSRA, which "replaced the patchwork system with an integrated scheme of administrative and judicial review, designed to balance the legitimate interests of various categories of federal employees with the needs of sound and efficient administration." *Id.* at 445.

The CSRA "is 'a comprehensive revision of the laws governing the rights and obligations of civil servants, [and] contains the first statutory scheme governing labor relations between federal agencies and their employees.'" (Citation omitted.) *Cornelius v. Nutt,* 472 U.S. 648, 650 (1985). A central purpose of the CSRA "was to give agencies greater ability and flexibility to remove or to discipline employees who engage in misconduct (chapter 75) or whose work performance is unacceptable (chapter 43)." *Lisiecki v. Merit Sys. Protection Bd.,* 769 F.2d 1558, 1563 (Fed. Cir. 1985), *cert. denied,* 475 U.S. 1108 (1986). At the same time, though, "Congress sought and achieved a balance between an agency's ability to take prompt action on the substance of an employee's performance on the one hand, and an employee's procedural protections on the other." *Id.* at 1562.

Among other things, the CSRA accomplished the following:

> First, Congress abolished the Civil Service Commission and created the OPM [Office of Personnel Management], which is now responsible for administering the Retirement Act. CSRA §§ 201, 906, 92 Stat. 1118, 1224; see 5 U.S.C. § 8347(a). Second, Congress created the MSPB, and directed that one of the Board's duties would be to review OPM's decisions in Retirement Act cases "under procedures prescribed by the Board." CSRA § 906, 92 Stat. 1225; see 5 U.S.C. § 8347(d)(1). Third, Congress created a new framework for evaluating adverse personnel actions against "employees" and "applicants for employment": it established exacting standards for review of such actions by the MSPB, provided that "employees" and "applicants for employment" could obtain judicial review of MSPB decisions, and specified the standards for

> judicial review of such actions. CSRA § 205, 92 Stat. 1138, 5 U.S.C. § 7701, 7703 (1976 ed., Supp. V). [Footnote omitted.]

Lindahl v. Office of Personnel Management, 470 U.S. 768, 773-74 (1985). More particularly, the CSRA amended chapters 23 (sections 2301 *et seq.*), 43 (sections 4301 *et seq.*), 75 (sections 7501 *et seq.*), and 77 (sections 7701 *et seq.*) of title 5, which relates to "Government Organization and Employees."

By the CSRA, chapter 23 "establishe[d] in law for the first time a codification of the merit principles of the federal personnel system and the specific practices prohibited in the system." *Lovshin v. Department of Navy*, 767 F.2d 826, 832 (Fed. Cir. 1985) (in banc), *cert. denied*, 475 U.S. 1111 (1986). Executive agencies must adhere to the merit systems principles listed in section 2301(b), which (with respect to job performance) include these, *inter alia*: (1) advancement is to be based on relative ability, knowledge, and skills, i.e., equal opportunity; (2) discrimination is prohibited; (3) appropriate incentives and recognitions are to be provided for excellence in performance; (4) employees are to be retained on the basis of adequacy of performance, and inadequate performance should be corrected; and (5) employees must be protected against reprisal for "whistle-blowing" within an agency. 5 U.S.C. § 2301(b) (1988). In section 2302 there are listed specific "prohibited personnel practices" by "employees with authority," *e.g.*, discrimination, reprisal, nepotism, and taking personnel actions violating any law, rule, or regulation that implements the merit systems principles of section 2301. 5 U.S.C. § 2302 (1988).

Chapter 43 amendments were "sweeping and extensive." *Lovshin v. Navy*, 767 F.2d at 832-33. However, "'[a]doption of the substantial evidence standard and the elimination of the efficiency of the service requirement for Chapter 43 actions comprise the cornerstone of this new statutory scheme.'" (Citation omitted.) *Lisiecki*, 769 F.2d at 1565.[15] Also, the old rating system, which gave a single evaluation for an employee's overall performance (satisfactory/unsatisfactory/outstanding), was eliminated. *Lovshin*, 767 F.2d at 833. Agencies are now required to develop and establish one or more appraisal systems for each category of positions in the agency, establishing objective performance standards for such positions together with a delineation of the "critical elements" for that type of position. *Id.* Periodic performance appraisals must occur, generally at least annually, based on the particular standards for the employee's position. The results of performance appraisals must be used as a basis for training, rewarding, reorganizing, promoting, reducing in grade, retaining in RIFs (reductions in force), and removing employees. *Id.* Only instances of "unacceptable performance," defined as performance of an employee which fails to meet established performance standards in one or more critical elements of an employee's position, occurring during the one-year period ending on the date of the notice of proposed removal or demotion in grade, may be considered in taking an action under chapter 43. *Id.*

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[15] The "substantial evidence" standard is a relatively lenient one in that it makes it more difficult (than, for example, the "preponderance of evidence" standard used in chapter 75 actions, discussed *infra*) for the board to reverse an agency's findings of fact. As for the "efficiency of service" requirement, that is imposed in chapter 75 actions, discussed *infra*. Enactment of those two "basic changes gives a clear indication of congressional intent to restrict the board's authority in reviewing chapter 43 actions." *Lisiecki v. MSPB*, 769 F.2d at 1565.

Chapter 75 pertains to adverse actions against employees "'for such cause as will promote the efficiency of the service' (§ 7513(a))." *Lovshin*, 767 F.2d at 835. It covers not only removals and demotions in grade (as does chapter 43), but also (with exceptions listed in 5 U.S.C. § 7512 (1988)) suspensions greater than fourteen days, reductions in pay, and furloughs of twenty days or less. The government action precipitating a chapter 75 procedure can be for specific instances of misconduct (*e.g.*, drug use, unexplained absences) or for inadequate performance.[16]

Chapter 77 (sections 7701 *et seq.*) relates to appeals to the MSPB and judicial review, including appeals under chapters 43 and 75.

Section 7701(a) provides that an employee may appeal to the MSPB "from any action which is appealable to the Board under any law, rule, or regulation." 5 U.S.C. § 7701(a) (1988). The Board may not sustain an agency decision unsupported by a preponderance of the evidence if the action is in chapter 75, or by substantial evidence if the action is in chapter 43. Furthermore, such decisions may not be sustained if the employee shows (1) harmful procedural error by the agency, (2) that the agency decision was based on a prohibited personnel practice as described in chapter 23, or (3) that the decision was not in accordance with the law. "In the MSPB review proceeding, the appellant is entitled to an evidentiary hearing, to a transcript, and to the presence of an attorney or other representative [and] [a]ttorney's fees may be awarded in certain circumstances." *Lindahl v. Office of Personnel Management*, 470 U.S. 768, 774 n.5 (1985).

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[16] In *Lovshin*, an in banc Federal Circuit panel held that chapter 43 does not provide the exclusive procedures for performance based adverse actions by an agency. 767 F.2d at 840-43.

Section 7703 of title 5 allows an employee to obtain judicial review of a final order or decision of the MSPB. As originally enacted, review was to be by the Court of Claims or a regional court of appeals. However, in the Federal Courts Improvement Act of 1982 (FCIA):

> Congress combined the appellate portions of the Court of Claims' Tucker Act jurisdiction with certain elements of the regional courts of appeals' jurisdiction, and vested jurisdiction over these matters in a new United States Court of Appeals for the Federal Circuit. FCIA § 127, 96 Stat. 37, 28 U.S.C. § 1295. Whereas the Court of Claims and the regional courts of appeals formerly shared jurisdiction over appeals from the MSPB, the Federal Circuit now has exclusive jurisdiction "of an appeal from a final order or final decision" of the Board pursuant to, *inter alia*, 5 U.S.C. § 7703(b)(1). 28 U.S.C. § 1295(a)(9); see FCIA § 144, 96 Stat. 45.

Id. at 775. On review, the Federal Circuit must set aside any action, findings, or conclusion found to be: "(1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) obtained without procedures required by law, rule, or regulation having been followed; or (3) unsupported by substantial evidence . . . ." 5 U.S.C. § 7703(c) (1988). *Hayes v. Department of the Navy*, 727 F.2d 1535, 1537 (Fed. Cir. 1984).

Appeal is available under section 7703 to "[a]ny employee or applicant for employment adversely affected or aggrieved by a final order or decision of the [Board]." Appeal is accomplished by filing a "petition to review" at the Federal Circuit within thirty days after the petitioner receives notice of the final MSPB order or decision. 5 U.S.C.A. § 7703(b)(1) (West Supp. 1990). A petition to review may also be filed under section 7703 by the Director of OPM, but only under the specific conditions set forth in section 7703(d).[17]

As a practical matter, many of the appeals to the Federal Circuit, often by petitioners without counsel, challenge factual findings of the MSPB. For example, in a chapter 75 action, they often challenge findings on whether the proscribed conduct occurred. The court's review of such findings is limited, as the statute requires upholding findings supported by "substantial evidence," i.e., "'such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.'" (Citations omitted.) *Ahles v. Department of Justice, Immigration & Naturalization Serv.*, 768 F.2d 327, 329 (Fed. Cir. 1985). Substantiality of the evidence must be assessed on the basis of the record "taken as a whole." *Hayes v. Department of the Navy*, 727 F.2d 1535, 1537 (Fed. Cir. 1984). Thus, it "'take[s] into account whatever in the record fairly detracts from its weight,'" *Spurlock v. Department of Justice*, 894 F.2d 1328, 1330 (1990), and the entire record must be "canvassed." *Id.*

B. *Structure of the MSPB*[18]

The MSPB consists of a chairman, vice chairman, and a third member each appointed by the President and confirmed by the Senate. It operates through a headquarters and regional offices throughout the country. Case adjudication is entrusted by the MSPB to regional directors and in turn to administrative judges (or on occasion an administrative law judge) who function as hearing officers. Broida, note 18, at 9. The administrative judge presides over the hearing which is provided by section 7701(a) of title 5. He or she assembles the record and produces what amounts to an initial or recommended decision. That becomes a final Board decision if no petition to review before the Board is filed within a specified period or a petition to review before the Board is denied. Alternatively, the Board may modify the initial decision and the modified decision may become the final decision.

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[17] That section allows the Director to petition only if he or she (1) determines, in his or her discretion, "that the Board erred in interpreting a civil service law, rule, or regulation affecting personnel management and that the Board's decision will have a *substantial impact* on a civil service, law, rule, regulation, or policy directive" (emphasis added), and (2) either intervened in the matter before the Board or petitioned the Board for reconsideration of its decision and the petition is denied. 5 U.S.C. § 7703(d) (1988). The granting of the petition for judicial review "shall be at the discretion of the Court of Appeals." *Id.* In that regard, it is incumbent upon OPM to demonstrate "substantial impact" to the Federal Circuit. *Devine v. Sutermeister*, 724 F.2d 1558, 1562 (Fed. Cir. 1983).

[18] *See generally* P. Broida, *A Guide to Merit Systems Protection Board Law & Practice*, 1979-1989, at 6-20 (hereinafter Broida).

C. *MSPB Jurisdiction*

Two significant aspects of the MSPB's jurisdiction are: (1) the individual bringing an appeal must be of the type who is authorized to do so; and (2) the MSPB must have authority to hear that type of appeal. *See generally* Broida, note 18, at 23-108.

1. *The Type of Employee Who Can Sue*

The CSRA generally divides civil service employees into three main categories: Senior Executive Service, comprising those who occupy high-level positions in most agencies of the executive branch and who do not require appointment by the President and confirmation by the Senate, *see generally* 5 U.S.C. §§ 2101a, 3131-3136 (1988); competitive service employees, comprising all other employees in the executive branch (and those in other branches, as well as the District of Columbia government, specifically included in the competitive service by statute) for whom nomination by the President and confirmation by the Senate are not required and who are not specifically excepted from the competitive service by statute or regulation, 5 U.S.C. § 2102 (1988); and the "excepted service," which is the remainder of civil service positions, 5 U.S.C. § 2103 (1988). *See generally United States v. Fausto*, 484 U.S. 439, 441 n.1 (1988). Within each of the three classes, the CSRA affords preferential treatment to certain veterans and their relatives—called preference eligibles. *Id.*

In general, the CSRA provides competitive and preference eligible employees more extensive rights and protection than it provides to excepted and nonpreference employees. *See* Broida, *supra* note 18, at 25-26. (Note: This discussion addresses appeals prior to the Civil Service Due Process Amendments of 1990, Pub. L. No. 101-376, 104 Stat. 461, expanding the appeal rights of nonpreference eligibles in the excepted service.) However, the exact protection—both substantive and procedural—available to each group in any specific situation can be determined only by inspecting the particular provisions that either authorize the government to take the disputed job action or provide the employee with the right that he or she claims was violated. *Id.*

Whether a particular employee or applicant for employment is covered also depends on the applicable definition of "employee" or "agency." For example, section 4301 of title 5 (1988) limits covered "agencies" to an executive agency, the Administrative Office of the United States Courts, or the Government Printing Office (with certain express exclusions), and it defines "employee" as an individual employed in or under an agency (with certain express exclusions). For the purpose of chapter 75, subchapter II [Removal, Suspension For More Than 14 Days, Reduction in Grade or Pay, or Furlough For 30 Days Or Less], section 7511(a)(1) (1988) defines an "employee" (with certain express exclusions) as:

> (A) an individual in the competitive service who is not serving a probationary or trial period under an initial appointment or who has completed 1 year of current continuous employment under other than a temporary appointment limited to 1 year or less; and
>
> (B) a preference eligible in an Executive agency in the excepted service, and a preference eligible in the United States Postal Service or the Postal Rate Commission, who has completed 1 year of current continuous service in the same or similar positions . . . .

Also, to be an "employee" one must satisfy (unless specifically modified elsewhere, *Williams v. Office of Personnel Management*, 718 F.2d 1553, 1556 (Fed. Cir. 1983)), the provisions of 5 U.S.C. § 2105 (1988). Under that section, he or she must: (1) be appointed in the civil service by the President, a Member or Members of Congress, or the Congress, a member of a uniformed service, another "employee," the head of a government-controlled corporation, or an adjutant general designated by "[t]he Secretary concerned" under 32 U.S.C. § 709(c); (2) be engaged in the performance of a federal function under authority of law or an executive act; and (3) be subject to the supervision of an individual named in the first requirement above (i.e., the President, a Member of Congress, etc.).

Opinions of the Federal Circuit often involve whether the petitioner is in a group that is entitled to appeal. In *Mastriano v. Federal Aviation Admin.*, 714 F.2d 1152 (Fed. Cir. 1983), for example, the court decided that the MSPB had no jurisdiction in a chapter 75 removal action because Mastriano was not an "employee" under section 7511(a)(1). He was a probationary employee serving less than one year whose rights are limited by the CSRA; the only thing he could legitimately allege, per regulations (5 C.F.R. § 315.806), was a removal based on political or marital status. 714 F.2d at 1155. In *Schwartz v. Department of Transp.*, 714 F.2d 1581 (Fed. Cir. 1983), petitioner Schwartz was removed for unacceptable performance in a chapter 43 proceeding. The Board held, and the Federal Circuit affirmed, that there was no Board jurisdiction because petitioner was a nonpreference eligible in the excepted service and 5 U.S.C. § 4303(e) allows suit only by those in the competitive service or by preference eligibles in the excepted service. In *McCarley v. Merit Sys. Protection Bd.*, 757 F.2d 278 (Fed. Cir. 1985), the Federal Circuit affirmed the Board's decision that it had no jurisdiction, holding that McCarley was not an "employee" under 5 U.S.C. § 2105 because he failed to satisfy the second and third elements of the test for "employee" stated in that section. (*See* language of that section, *supra.*)[19]

If appeal to the MSPB is unavailable to a particular type of employee, the question has arisen of whether suit in another forum is available. That was considered in *United States v. Fausto*, 484 U.S. 439 (1988).

Joseph A. Fausto, an employee of the Department of the Interior, Fish and Wildlife Service, was suspended from his job for thirty days because of unauthorized use of a government vehicle. His position was as a nonpreference eligible in the excepted service and, as such, he had no appeal rights under the CSRA. Indeed, an initial appeal to the MSPB, when Fausto was being threatened with removal, was dismissed on that basis. Subsequently, and after the proposed penalty was reduced to a thirty-day suspension, Fausto sued under the Back Pay Act, 5 U.S.C. § 5596, in the United States Claims Court.[20] The Claims Court dismissed, holding that the CSRA comprised the exclusive catalog of remedies for civil servants affected by adverse personnel actions. The Federal Circuit reversed and remanded, holding that the CSRA, though it precluded nonpreference eligible excepted service employees from appealing to the MSPB, did not preclude them from seeking traditional relief under the Tucker Act, 28 U.S.C. § 1491, based on the Back Pay Act.[21] The Supreme Court, however, after examining the purpose of the CSRA, the entirety of its text, and the structure of review that it establishes, reversed. It stated:

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[19] A different aspect of *McCarley* was expressly overruled in *Hagmeyer v. Department of Treasury*, 852 F.2d 531, 532 (Fed. Cir. 1988) (in banc). *McCarley* named the MSPB as the respondent rather than the employing agency (i.e., the Department of the Army) because petitioner McCarley's appeal involved an MSPB dismissal for lack of jurisdiction. In such cases at that time, and in cases involving timeliness and attorney fees, the MSPB—not the employing agency—had been named as respondent. *Hagmeyer* changed that, holding that in such appeals, the employing agency is the proper party respondent. Interestingly, *Hagmeyer* involved interpreting 5 U.S.C. § 7703(a)(2), and that section was amended in 1989, to state: "The Board shall be the named respondent in any proceeding brought pursuant to this subsection, unless the employee or applicant for employment seeks review of a final order or decision on the merits on the underlying personnel action or on a request for attorney fees, in which case the agency responsible for taking the personnel action shall be the respondent." 5 U.S.C.A. § 7703(a)(2) (West Supp. 1990).

> Although Congress extended [certain] protections to nonpreference members of the excepted service, it denied them the right to seek either administrative or judicial review of the agency's final action. . . .
>
> The Court of Appeals viewed the exclusion of nonpreference members of the excepted service from the definitional sections of Chapter 75 as congressional silence on the issue of what review these employees should receive for the categories of personnel action covered by that chapter, including a suspension of the duration at issue here . . . . The court therefore found respondent free to pursue whatever judicial remedies he would have had before enactment of the CSRA. We view the exclusion quite differently. In the context of the entire statutory scheme, we think it displays a clear congressional intent to deny the excluded employees the protections of Chapter 75—including judicial review—for personnel action covered by that chapter.

Id. at 446-47.

2. *MSPB Authority To Hear the Appeal*

The MSPB's jurisdiction is limited to cases authorized by Congress. Section 7701(a) of title 5 allows appeal to the MSPB from any action appealable to the Board under any law, rule, or regulation. 5 U.S.C. § 7701(a) (1988); *Schwartz v. Department of Transp.*, 714 F.2d 1581, 1582 (Fed. Cir. 1983). (Regarding such rules or regulations, an agency cannot grant the right to appeal to the MSPB unless it has statutory authority to do so. *Id.* at 1583.) Thus, in *Wilson v. Merit Sys. Protection Bd.*, 807 F.2d 1577, 1579 (Fed. Cir. 1986), the court stated:

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[20] The Back Pay Act provides in pertinent part that "[a]n employee of an agency who . . . is found by appropriate authority under applicable law, rule, regulation, or collective bargaining agreement to have been affected by an unjustified or unwarranted personnel action . . . is entitled [to back pay]." 5 U.S.C. § 5596(b)(1) (1988).

[21] Prior to the CSRA, for a cause of action based on the Back Pay Act, jurisdiction would have been in the Court of Claims, under the Tucker Act, 28 U.S.C. § 1491. That jurisdiction was shared with the district courts if the claim was under $10,000. 28 U.S.C. § 1346(a)(2) [Little Tucker Act]. *See generally* §§ IV.A. and V, *infra.*

> The Board has "only that jurisdiction conferred upon it by Congress." [Citations omitted.] Accordingly, the Board has authority to hear appeals only from the types of actions specifically enumerated by law, rule, or regulation. 5 U.S.C. § 7701(a) (1982). [Citation omitted.]
>
> The petitioner in the present case is a preference eligible employee of the Postal Service. *See* 5 U.S.C. § 2108(3) (1982). Under 5 U.S.C. sections 7511(a)(1)(B), 7512(3) and (4), and 7513(d), a preference eligible employee may appeal to the Board from "a reduction in grade" and "a reduction in pay." Reassignments that do not reduce an employee's grade or pay are not appealable to the Board. [Citations omitted.]

See also Manning v. Merit Sys. Protection Bd., 742 F.2d 1424, 1427 (Fed. Cir. 1984) (allegations of a reassignment to another position without loss of pay or rank is not an adverse action and, hence, is not appealable to the MSPB).

Other types of actions that are not appealable to the MSPB include suspensions of fourteen days or less, *Synan v. Merit Sys. Protection Bd.*, 765 F.2d 1099, 1101 (Fed. Cir. 1985), cases involving the proper classification of a position, *Saunders v. Merit Sys. Protection Bd.*, 757 F.2d 1288, 1290 (Fed. Cir. 1985), and voluntary resignations. In the latter regard, the critical issue often becomes whether a particular resignation is involuntary (and, hence, an adverse action within the MSPB's jurisdiction) or voluntary (and outside that jurisdiction). *See generally* Broida, *supra* note 18, at 520-36.

D. *Chapter 75 and the Air Controller Cases*

Perhaps the most publicized group of cases in the court's early years involved the air controllers.

A strike orchestrated by the Professional Air Traffic Controllers Organization (PATCO) began on the morning of August 3, 1981.[22] On that day, President Reagan announced that striking controllers were acting in violation of the criminal law and their oaths of office, but that they could still report for duty and not be discharged if they returned to work within forty-eight hours of his announcement. Just after the strike began, the Department of Transportation's Federal Aviation Administration (FAA) sent a telegram to all air traffic controllers, ordering them to report to work and warning them that their strike was illegal and that their participation in it would result in removal. The FAA sent notice to controllers who did not report to duty, ordering them to report for "the deadline shift" at the expiration of the President's forty-eight-hour grace period. Once the FAA proposed the removal of controllers for strike participation, the FAA refused to permit to return to work those controllers who failed to report for their deadline shifts. Ultimately, the FAA discharged more than 11,000 controllers for absence without leave and participation in the 1981 strike. *In re Solerwitz,* 848 F.2d 1573, 1574 (Fed. Cir. 1988) (in banc), *cert. denied,* 488 U.S. 1004 (1989).

More than 10,000 of the discharged controllers petitioned the various regional offices of the MSPB for administrative appeal of their removal. *In re Solerwitz,* 848 F.2d at 1574. Approximately 4,500 of them, dissatisfied with the regional officers' initial decisions, petitioned the full Board for review. To deal with the many cases, the MSPB developed a "lead case" concept. The Board members designated an attorney task force: (1) to identify common legal issues in the related appeals; and (2) to locate individual appeals requiring resolution of those common issues and those appeals that would constitute the lead cases. The Board could then establish precedent for the central issues in many other cases. To facilitate its consideration of the various arguments and the major issues involved, the MSPB sought and received amicus briefs from interested parties.

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[22] Unless otherwise indicated, for much of the ensuing background of the air controller strike contained in this and the next two paragraphs, *see generally* Murphy, *Striking in the Federal Sector: An Update on the Law,* 35 Am. U.L. Rev. 929, 938-40 (1986). The article appears as one of a number of articles in *A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit* appearing in the Summer 1986 edition of that law review. A similar collection appears each summer. Another review of Federal Circuit cases appears in the CAFC Newsletter, which has been issued periodically by the ABA's Section on Litigation.

After losing at the MSPB, the air controllers petitioned the Federal Circuit for review. The Federal Circuit likewise adopted a "lead case" approach. It ordered that adjudication of the related cases pending before it be suspended until it could review the MSPB's lead decisions and issue its own lead decisions. It also accepted briefs amicus curiae from various counsel collectively representing the interests of many air controllers whose cases were described by an amici as likely to be controlled by the outcome of the lead cases. In May 1984, it decided these lead cases against petitioners: *Brown v. Department of Transp., FAA,* 735 F.2d 543; *Anderson v. Department of Transp., FAA,* 735 F.2d 537, *cert. denied,* 469 U.S. 1018 (1984); *Letenyei v. Department of Transp., FAA,* 735 F.2d 528; *DiMasso v. Department of Transp., FAA,* 735 F.2d 526, *cert. denied,* 469 U.S. 1018 (1984); *Moylan v. Department of Transp., FAA,* 735 F.2d 524, *cert. denied,* 469 U.S. 1018 (1984); *Novotny v. Department of Transp., FAA,* 735 F.2d 521; *Dorrance v. Department of Transp., FAA,* 735 F.2d 516, *cert. denied,* 469 U.S. 1018 (1984); *Johnson v. Department of Transp., FAA,* 735 F.2d 510; *Martel v. Department of Transp., FAA,* 735 F.2d 504, *cert. denied,* 469 U.S. 1018 (1984); *Campbell v. Department of Transp., FAA,* 735 F.2d 497, *cert. denied,* 469 U.S. 881 (1984); *Adams v. Department of Transp., FAA,* 735 F.2d 488, *cert. denied,* 469 U.S. 1018 (1984); and *Schapansky v. Department of Transp., FAA,* 735 F.2d 477, *cert. denied,* 469 U.S. 1018 (1984). After the lead cases became final (i.e., certiorari was denied by the Supreme Court), the Federal Circuit notified the remaining petitioners that the stay on their cases was lifted but cautioned them that they should proceed only if their cases were not in effect controlled by the lead cases. In that manner, the lead cases had a significant impact on the remaining air controller cases. They also had a significant impact on the development of the law under the CSRA, particularly relating to adverse actions under chapter 75 of title 5, a category to which the air controllers cases belong.

Schapansky established the following important concepts:[23] (1) the charge of striking is proven when it is shown that the employee withheld his services in concert with others, regardless of whether the employee joins a picket line; (2) proof of a widespread strike of general knowledge, together with proof of an employee's absence without authorization or explanation during the strike, constitutes a prima facie case of strike participation; and (3) the burden of proving the charges that prompted the adverse action—more specifically, carrying the burden of persuasion—is always on the agency (from start to finish) by a preponderance of the evidence; however, once an agency has made a prima facie case (in this case, of strike participation), the burden of going forward with evidence to rebut that showing shifts to the employee.

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[23] *Schapansky* and ten of the other lead cases were decided by the same five-judge panel; *Brown* had a three-judge panel.

The petitioner in *Schapansky*, and the other air controllers, complained that the penalty imposed, removal, was too harsh. *Schapansky*, therefore, addressed an issue—proper penalty—that the court would see over and over in future adverse action cases under chapter 75. Determining the penalty, stated the court, "is a matter committed primarily and largely to the discretion of the employing agency [citation omitted]." It continued:

> Only in the exceptional case, in which the penalty exceeds that permitted by statute or regulations or is so harsh that it amounts to an abuse of discretion, may its imposition be overturned. [Citation omitted.] Whether the court would have chosen a different penalty, had it been making the initial choice, is in the normal case irrelevant.

735 F.2d at 484.

Schapansky asserted that the agency should have mitigated the penalty of removal. In determining whether the penalty should have been mitigated, and "proper penalty" in general, consideration is typically given to the relevant factors among these articulated in *Douglas v. Veterans Admin.*, 5 MSPB 313 (1981): (1) the nature and seriousness of the offense, and its relation to the employee's duties, position, and responsibilities (including whether the offense was technical or inadvertent, or was committed maliciously or for gain, or was frequently repeated); (2) the employee's job level and type of employment, including supervisory or fiduciary role, contacts with the public, and prominence of the position; (3) the employee's past disciplinary record; (4) the employee's past work record, including length of service, performance on the job, ability to get along with fellow workers, and dependability; (5) the notoriety of the offense or its impact upon the reputation of the agency; (6) potential for the employee's rehabilitation; and (7) the adequacy and effectiveness of alternative sanctions to deter such conduct in the future by the employee or others.[24]

In *Schapansky*, the court ruled that "the gravity and effects of Schapansky's offense are so great, and the statutes relating to strikes against the United States are so unequivocal, that they do not merely limit the extent of appropriate mitigation; they render mitigation irrelevant." 735 F.2d at 485. The court continued:

> Congress has determined that removal is an appropriate penalty for striking against the government. It is therefore not necessary, as *amici* contend, to remand for a more complete record respecting mitigation factors. An individual with the longest and finest record may be removed when found to have irrevocably sullied that record by participating in the strike at bar against the United States. Long and excellent service creates no license to violate a criminal statute against striking, and to violate one's oath taken on the day of employment that one would not strike. Congress cannot be held to have acted unconstitutionally in enabling the United States to refrain from continuing to employ one who strikes against the federal government; nor can that enablement be impeded by mitigating factors that may be applicable to lesser offenses and different circumstances.

Schapansky also addresses "nexus," typically a third issue in chapter 75 adverse action cases. (Proving the conduct charged and proper penalty are the other two.) Without such nexus, of course, a chapter 75 removal would be improper. *See, e.g.*, 5 U.S.C. § 7513 (1988) ("[adverse] action[s] covered by this subchapter [may] . . . only [be] for such cause as will promote the efficiency of service"). *Schapansky* reached its nexus holding after stating, in a discussion also relevant to the "proper penalty" issue:

> Striking against the government is a grave offense and a violation of the solemn oath an employee signs, as did Schapansky, as a condition of his employment. Striking, moreover, is a criminal offense. [Citation omitted.] It disrupts the functioning of the government itself. In this case, the inescapable and thus intentional goals of Schapansky and his striking cohorts, absent prompt government capitulation, were to inflict harm of the highest magni-

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[24] *But see Yeschick v. Department of Transp.*, 801 F.2d 383, 385 (Fed. Cir. 1986) ("nothing in this court's reviewing statute, 5 U.S.C. § 7703(c), requires that a presiding official contemplate *Douglas* factors not identified by petitioner as significant. . . . neither [the agency nor the MSPB] can be held to account for failing to consider factors initially deemed so insignificant by petitioner as to warrant his silence about them").

> tude upon the national transportation system, to cause great public inconvenience, to injure the national economy, and to place at risk the public safety. [Citation omitted.]

735 F.2d at 484.

Schapansky was not the only lead case to enhance development of MSPB law. Other points made by the court in the lead cases include these: (1) once the agency presents evidence of strike participation, it is not improper to draw an adverse inference from petitioner's refusal to testify or otherwise to offer rebuttal evidence before the MSPB, *Adams*, 735 F.2d at 492; (2) with regard to the defense of some of the petitioners that they were coerced into strike participation (*e.g.*, by fellow workers), the critical inquiry "is whether that action was voluntary or involuntary, using the objective 'reasonable person' test," *Martel*, 735 F.2d at 509, *accord Johnson*, 735 F.2d at 514; and (3) regarding the first amendment argument of a supervisor who was removed because of public statements to striking officials allegedly supportive of the strike, the test of *Pickering v. Board of Education*, 391 U.S. 563, 568 (1968), is applicable, i.e.:

> (1) whether Brown's speech addressed a matter of public concern and, if so, (2) whether the interest of the agency in promoting the efficiency of the public service it performs (air traffic control) outweighed Brown's interests as a citizen.

Brown, 735 F.2d at 546.

The air controller litigation thus created a significant amount of precedent relating to chapter 75 adverse actions, particularly with respect to these three key issues: was there substantial evidence supporting the charges (*e.g.*, striking); proper penalty; and nexus. A fourth issue frequently arising in such actions is the allegation of harmful procedural error at the employing agency or at the MSPB.

Under section 7701, an agency decision may not be sustained by the MSPB if the employee or applicant shows harmful error in the application of the agency's procedures in arriving at such a decision. 5 U.S.C. § 7701 (1988). Similarly, the Federal Circuit must set aside any MSPB decision "obtained without procedures required by law, rule, or regulation having been followed." 5 U.S.C. § 7703 (1988). In the latter regard, this court has indicated that the procedural error at the MSPB must be "harmful." *See, e.g., Curtin v. Office of Personnel*

Management, 846 F.2d 1373, 1379 (Fed. Cir. 1988). As to the definition of harmful:

> While the burden is on [petitioner] to show that the failure to grant him the predecision hearing [i.e., procedural error] was harmful to his defense so that a different result *might have* been reached, the burden is not on him to prove that the outcome of such a hearing *would have* changed the result, an impossibility.

Mercer v. Department of Health & Human Servs., 772 F.2d 856, 859 (Fed. Cir. 1985).[25]

Other interesting issues have arisen in the context of chapter 75 adverse actions. In *Egan v. Department of the Navy*, 802 F.2d 1563 (Fed. Cir. 1986), for example, the court addressed whether the MSPB has authority by statute to review the substance of an underlying decision to deny or revoke a security clearance in the course of reviewing an adverse action.

Thomas M. Egan lost his laborer's job at the Trident Naval Refit Facility in Bremerton, Washington, when he was denied a security clearance. He appealed to the MSPB, citing the typical chapter 75 sections to the Board (*e.g.*, sections 7701, 7512, 7513).[26] The government argued to the MSPB that the Board's review power was limited to determining whether the required removal procedure (under chapter 75) had been followed and whether a security clearance was a condition for his position. It contended that the MSPB did not have the authority to judge the merits of the underlying security clearance determination. The MSPB agreed and sustained Egan's removal.

A divided Federal Circuit vacated and remanded the case, holding that review under section 7513 includes review of the merits of the underlying agency determination to deny a security clearance. The dissent, however, maintained that review of the merits of the security clearance denial is unavailable. It urged that Egan had received all the procedural protection to which he was entitled, that the majority in effect was transferring a discretionary decision vested in the executive agency to a body that had neither the responsibility nor the expertise to make that decision, that the ruling raised separation of power concerns, and that the Board would be unable to provide an appropriate remedy. 802 F.2d at 1577-83.

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[25] The MSPB similarly defines harmful error as "[e]rror by the agency in the application of its procedures that is likely to have caused the agency to reach a conclusion different from the one it would have reached in the absence or cure of the error." 5 C.F.R. § 1201.56(c)(3) (1990).

[26] He did not cite 5 U.S.C. § 7532(b), under which the "head of an agency" may suspend an employee "when he considers that action necessary in the interests of national security"; that action is final and not subject to Board review. *Department of Navy v. Egan*, 484 U.S. 518, 522-23 n.4 (1988). The Board stated that § 7532 "is not the exclusive basis for removal based upon security clearance revocation." 802 F.2d at 1566. The Federal Circuit agreed with the Board, noting that, here, the agency chose to remove Egan under § 7512. The Supreme Court, when reviewing the Federal Circuit decision, did not disagree. 484 U.S. 518, 526, 532 (1988).

A divided Supreme Court (5-4 decision) reversed the Federal Circuit. Recognizing what the Federal Circuit referred to as a "strong presumption in favor of appellate review," the Court nevertheless stated: "the proposition is not without limit, and it runs aground when it encounters concerns of national security, as in this case." 484 U.S. 518, at 527. Stressing the executive branch's need to protect national security information, the Court noted that "no one has a 'right' to a security clearance," that "courts traditionally have been reluctant to intrude upon the authority of the Executive in military and national security affairs," and that the Federal Circuit's opinion is contrary to that. *Id.* at 528, 530. In the Court's view, its reading of the CSRA and the Act's legislative history supported its conclusion.

E. *Chapter 43 Cases*

Chapter 75 adverse actions have constituted the bulk of MSPB actions before the Federal Circuit. Chapter 43, however, "was the centerpiece of the Reform Act." *Lisiecki v. Merit Sys. Protection Bd.*, 769 F.2d 1558, 1565 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1108 (1986). Some of the main principles of chapter 43 are highlighted in *Eibel v. Department of the Navy*, 857 F.2d 1439 (Fed. Cir. 1988).

The issue in *Eibel* was "[w]hether the marginal performance standards, pertaining to critical elements five and six for the position from which Mr. Eibel was removed, are valid." *Id.* at 1441. The court decided they were not.

The court explained that the decision to remove an employee under chapter 43 may be based only on "unacceptable performance," i.e., performance "which fails to meet established performance standards in one or more critical elements of such employee's position." *Id.* at 1441. The performance standards "must set forth in objective terms the minimum level of performance which an employee must achieve to avoid, *inter alia,* removal for 'unacceptable performance.'" *Id.* In that regard, 5 U.S.C. § 4302(b)(1) provides that performance standards must "'to the maximum extent feasible, permit the accurate evaluation of job performance on the basis of objective criteria.'" *Id.* The job performance standards of Mr. Eibel's position, concluded the court, "fall woefully short of meeting these statutory requirements." *Id.* They "neither provide an accurate objective measurement of Mr. Eibel's level of achievement nor reasonably inform the employee of what is acceptable performance." *Id.* at 1444. The court also noted:

> CSRA has now been in the statute books since 1978. This court was aware of the monumental task each agency or department faced in drafting meaningful performance standards for thousands of positions, coupled with the inexperience of those charged with implementing the new system. Our approval of initial standards should not be taken to mean that those standards would not be later disapproved. As experience is gained in writing standards which are understandable and appropriate to various types of positions, the court expects the agencies to revise and update original performance standards. [Citation omitted.]

Id. at 1443-44.

Another significant chapter 43 case was *Lisiecki v. Merit Sys. Protection Bd.,* 769 F.2d 1558, 1559 (Fed. Cir. 1985), *cert. denied,* 475 U.S. 1108 (1986), which "present[ed] a narrow but vitally important issue of statutory construction of first impression in this court, namely, whether the MSPB has the authority to review and mitigate the severity of reduction-in-grade (demotion) or removal sanctions imposed by an employing agency in an action taken for unacceptable performance under 5 U.S.C. § 4303 (1982)." After an exhaustive review of the statute and its legislative history, and of *Lovshin v. Department of Navy,* 767 F.2d 826 (Fed. Cir. 1985) (in banc), *cert. denied,* 475 U.S. 1111 (1986), the Federal Circuit concluded that the MSPB does not have such authority. It stated:

> Neither the language of the Civil Service Reform Act of 1978 nor its legislative history demonstrates that Congress intended the Merit Systems Protection Board to review and, where deemed appropriate, to mitigate penalties in Chapter 43 cases. The Reform Act does not make the MSPB's adjudicatory powers co-extensive in Chapter 43 and Chapter 75 cases. We decline the invitation of petitioner to extend the statute beyond what we perceive to be the congressional intent behind it. The MSPB was therefore correct when it reversed the initial decision of its presiding official and sustained the action of the [employing agency] in removing petitioner from

> his position for unacceptable performance in a critical element of his position, pursuant to 5 U.S.C. § 4303.

Lisiecki, 769 F.2d at 1568.

F. *Other Types of MSPB Cases*

The MSPB cases reviewed at the Federal Circuit are not limited to chapter 43/unacceptable performance or chapter 75/adverse action cases. They include, for example, retirement appeals under chapter 83 (sections 8301 *et seq.*) of title 5, which involve, *inter alia,* disability retirement, optional or regular retirement, discontinued service retirement, survivor annuity and other death benefits, and workers compensation.[27] Typically, such cases involve appeals from the MSPB of affirmances or denials of decisions made by OPM, the agency that "'determine[s] questions of disability and dependency'" in administering federal annuities to retired employees and their dependents. *Lindahl v. Office of Personnel Management*, 470 U.S. 768, 771 (1985).

In *Lindahl*, the Supreme Court addressed the proper standard of review for the Federal Circuit in a disability retirement case.

Wayne Lindahl was a civilian security guard at a Navy shipyard. He had been suffering from acute and chronic bronchitis. In September 1979, the Navy informed him he would be retired "'because your physical condition has disabled you to such an extent that you are unable to perform the full range of duties required of your position as a Police Officer.'" 470 U.S. at 775. Lindahl agreed and chose not to contest his separation. But, both before and after his separation, he took steps to apply for a disability retirement annuity. OPM denied it because in its view the evidence "'fails to establish that you have a disability severe enough to prevent useful, efficient, and safe performance of the essential duties of the position from which you are seeking retirement' [the test required by the Retirement Act at 5 U.S.C. § 8337(a)]." *Id.* at 776. Lindahl appealed to the MSPB, which sustained OPM's denial.

Eventually (after the FCIA of 1982), Lindahl's appeal went to the Federal Circuit which, sitting in banc, dismissed it as barred by section 8347(c). That section provided that, subject to administrative review by the MSPB pursuant to section 8347(d)(1), "OPM's 'decisions . . . concerning these matters are final and conclusive and are not subject to review.'" The specific issue addressed by *Lindahl* was whether section 8347(c) bars judicial review altogether of an MSPB judgment affirming OPM's denial of a disability retirement claim, or bars review only of factual determinations while permitting review for alleged legal and procedural errors. The Federal Circuit held the former but, in a 5-4 decision, the Supreme Court held the latter.

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[27] *See, e.g.*, Broida, *supra* note 18, at 1182-86.

The Supreme Court reasoned that Congress' 1980 amendment of section 8347, which enabled one class of Retirement Act applicants (involuntary mental disability) to enjoy the enhanced administrative and judicial review provisions of the CSRA, did not alter (for other classes of applicants) the *Scroggins* standard of review previously in effect. Under *Scroggins v. United States,*[28] courts could not review fact determinations of the Civil Service Commission but could determine whether there had been "a substantial departure from important procedural rights, a misconstruction of the governing legislation, or some like error 'going to the heart of the administrative determination.'" 397 F.2d at 297. The Supreme Court, unlike the Federal Circuit, decided that the 1980 amendment did not demonstrate a congressional intent for all types of disability retirement decisions other than those covered by the 1980 amendment (involving involuntary mental) to be unreviewable. Instead, it held that the *Scroggins* review applies to all such cases, except involuntary mental.

Another significant case, this time relating to the jurisdiction of the Federal Circuit, was at issue in *Williams v. Department of the Army*, 715 F.2d 1485 (Fed. Cir. 1983) (in banc).

The Army removed Mr. Williams from his civilian position. The MSPB sustained the agency's discharge, as supported by a preponderance of the evidence, for three reasons: (1) failure to report for two agency-directed, fitness-for-duty examinations; (2) absence without leave from July 20-August 8, 1981; and (3) failure to observe oral orders to complete some specific tasks. Mr. Williams raised racial discrimination as a defense, but the MSPB determined that it had not been established. Upon affirmance by the MSPB, Williams pursued two avenues of review, per 5 U.S.C. §§ 7702-7703. He filed suit in district court for de novo review of the discrimination issues, and on August 4, 1982, he filed a petition to review the nondiscrimination claims in the United States Court of Claims (this court's predecessor). When this court was formed in October 1982, the latter appeal was transferred here.

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[28] 397 F.2d 295 (Ct. Cl.), *cert. denied*, 393 U.S. 952 (1968).

The Army filed a motion to dismiss the appeal here, arguing that, per sections 7703(b)(2) and 7702, the nondiscrimination claim must go to district court with the discrimination claim. Section 7703(b)(2) of title 5 (1988) provided that "[c]ases of discrimination subject to . . . section 7702 of this title shall be filed under section 717(c) of the Civil Rights Act of 1964 . . ., section 15(c) of the Age Discrimination in Employment Act of 1967 . . ., and section 16(b) of the Fair Labor Standards Act of 1938 . . . ." Section 7702 of title 5 (1980) stated that, in the case of any employee or applicant for employment who has been affected by an action appealable to the MSPB (*e.g.*, adverse actions under chapter 75) *and* alleges discrimination (as specified in section 7702(a)(1)(B), *e.g.*, under the three Acts mentioned above), the MSPB shall decide both the discrimination and "otherwise appealable actions." Cases falling within section 7702 have been called "mixed" (i.e., discrimination mixed with an otherwise appealable action).

The issue resolved in *Williams* was whether only the discrimination claim goes to district court under, *e.g.*, the Civil Rights Act, or both the discrimination claim and the "otherwise appealable action" should go there. After examining the statutory language, its legislative history, decisions from regional courts of appeals, and policy considerations, the Federal Circuit held that it had no jurisdiction; it transferred appeal of the nondiscrimination claim to the district court. It stated:

> [W]here jurisdiction lies in the district court under 5 U.S.C. § 7703(b)(2), the entire action falls within the jurisdiction of that court and this court has no jurisdiction, under 5 U.S.C. 7703(b)(1), over such cases. This holding is limited to situations in which the employee is challenging judicially the board's determinations of both the discrimination and the nondiscrimination issues. We express no view on whether we would have jurisdiction over cases in which the employee initially raised both issues before the board, but either abandoned the discrimination claim during the board proceeding or eschewed any judicial challenge of the board's ruling on that issue. Such a case is not before us.

Williams, 715 F.2d at 1491.

Determining whether an appeal at the Federal Circuit is of a "mixed case" is sometimes at issue and is done "in the same manner in which we review other threshold questions before reaching an appeal on the merits." *Hill v. Department of Air Force*, 796 F.2d 1469, 1470 (Fed. Cir. 1986). In *Hill*, the threshold determination required review of the MSPB's ruling that the discrimination claims were frivolous. "If that ruling is correct," stated this court, "it would be improper to transfer this case to a court that is not authorized to receive it." *Id.* The court continued:

> Determination of our jurisdiction requires review of Dr. Hill's allegations of discrimination for this limited purpose. If Dr. Hill presented a non-frivolous allegation of prohibited discrimination, he was entitled to a hearing thereon before the Board. If the Board improperly denied such hearing, we must remand to the Board for this purpose. [Footnote omitted.] But if the Board correctly held that the employee presented no more than a frivolous allegation of discrimination then there never was a "mixed case", and review of the merits of the adverse action lies exclusively with the Federal Circuit.
>
> After careful review of the record, we conclude that Dr. Hill alleged no set of facts which, if proven, would comprise even a minimum *prima facie* case of age discrimination. [Footnote omitted.] The Board correctly held that Dr. Hill had not raised a nonfrivolous allegation of discrimination. Thus, this appeal is not a "mixed case" under 5 U.S.C. § 7702, and the jurisdiction of this appeal is governed by 5 U.S.C. § 7703(b)(1).

Id. at 1471.

As a practical matter, Federal Circuit rule 15(c) requires a petitioner to complete a statement indicating whether (a) a discrimination claim is being made, (b) if such a claim had been made before the Board, whether it is being abandoned, or (c) whether the petitioner seeks review only of the MSPB's dismissal of the case for lack of jurisdiction or timeliness. The court's ensuing treatment of the case will depend on which statement is made.

Cases involving removals associated with reductions in force (RIFs) also come before the Federal Circuit. A RIF involves two steps: (1) the agency determines which positions to abolish; and (2) the agency "selects the people to be eliminated serving in those positions on the basis of their retention standing." *Gandola v. FTC*, 773 F.2d 308, 310 (Fed. Cir. 1985). Normally, RIFs result from a decrease in the agency's available funds, a change in the agency's service workload, or transfer to another agency of a portion of the agency's work. *Certain Former*

CSA Employees v. Department of Health & Human Servs., 762 F.2d 978, 985 (Fed. Cir. 1985).

Often, RIFs involve regulations issued pursuant to 5 U.S.C. § 3502 (1988), a statutory section styled "Order of retention." Under it, OPM is mandated to "prescribe regulations for the release of competing employees in a reduction in force" that give due effect to: (1) tenure of employment; (2) military preference, subject to section 3501(a)(3) of this title; (3) length of service; and (4) efficiency of performance ratings. Those regulations "provide the administrative process through which the government eliminates jobs and deals with the employees who formerly occupied the abolished positions." *Grier v. Department of Health & Human Servs.*, 750 F.2d 944, 945 (Fed. Cir. 1984). As explained in *Grier*:

> Unlike adverse actions, RIFs are not aimed at removing particular individuals; rather, they are directed solely at positions. After the agency has decided to eliminate positions as a matter of its independent managerial discretion, the identification of affected employees is governed by OPM regulations.

Id. at 945-46.

"To avoid the personnel problems which might result if all government employees were affected by every RIF," OPM has limited the term "competition" (among competing employees for jobs) by carefully defining the scope thereof in 5 C.F.R. § 351.401-.506. *Id.* at 946. Two criteria are used in determining that scope: competitive area and competitive level. *Id. See also Dodd v. Tennessee Valley Auth.*, 770 F.2d 1038, 1041 (Fed. Cir. 1985). Cases often involve the proper parameters of each. *Grier*, for example, concerned the proper competitive *area*.

Mr. Grier was a civilian employee at the San Francisco Public Health Service Hospital. He received a RIF notice, notifying him that HHS had determined that his hospital would be closed because of reduced funding, that his competitive area was the hospital, and, hence, that he would be separated by RIF procedures. Grier argued that the agency placing him in a competitive area consisting only of the hospital denied him the right to compete for other positions and, thus, was contrary to the RIF regulations promulgated by OPM. In Grier's view, an agency must designate a competitive area large enough—either geographically or organizationally, or both—so that some jobs remain in the competitive area after jobs are eliminated. In affirming the MSPB, which had affirmed the agency's implementation of the RIF as in accord with applicable regulations, the Federal Circuit rejected Grier's argument:

> We have found no statute, regulation, or case law which requires an agency to expand a competitive area for the sole purpose of providing actual competition for a job.

750 F.2d at 945.

The Federal Circuit in *Grier* cited 5 C.F.R. § 351.402 for the proper definition of competitive area: "[T]he geographical area and bureaucratic unit within which the incumbent of an eliminated position will be permitted to vie for retention." *Id.* at 946.[29] Therefore, stated the court, agencies "accommodate two elements, administrative of structure and geography, in determining competitive areas." 750 F.2d at 946. As for structure, a competitive area should include "'all or that part of an agency in which employees are assigned under a single administrative authority.' FPM 351-2-2a (1981)." *Id.* As for geography, stated the court, under the Federal Personnel Manual, no competitive area need be larger than the local commuting area. *Id.* The court continued:

> [an] agency may, but need not, expand the competitive area to provide actual competition. This is left solely to the agency's discretion and this court has held: "An agency is accorded wide discretion in conducting a reduction in force; absent a clear abuse of discretion, a substantial departure from applicable procedures, a misconstruction of governing statutes, or the like, we do not upset a final agency decision." *Cooper v. TVA*, 723 F.2d 1560, 1562 (Fed. Cir. 1983) (quoting *Dancy v. United States*, 668 F.2d 1224, 1226, 229 Ct. Cl. 300 (1982)).

Id. Thus, the court affirmed the hospital on its choice of a proper competitive area.

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[29] Competitive *levels* are also defined by C.F.R.: "Each agency shall establish competitive levels consisting of all positions in a competitive area which are in the same grade (or occupational level) and classification series and which are similar enough in duties, qualification requirements, pay schedules, and working conditions so that the incumbent of one position could successfully perform the critical elements of any other position upon entry into it, without any loss of productivity beyond that normally expected in the orientation of any new but fully qualified employee." 5 C.F.R. § 351.403(a) (1990).

III. APPEALS FROM THE PTO IN TRADEMARK CASES

A. *Jurisdiction and Background*

The Federal Circuit has inherited the work of the CCPA on trademark cases from the PTO. Subsection (4)(B) of 28 U.S.C. § 1295(a) (1988) states that the Federal Circuit shall have exclusive jurisdiction of an appeal from a decision of the Commissioner of the PTO or Trademark Board "with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. 1071)," i.e., the Lanham Act. Section 21(a), in turn, provides that an applicant "who is dissatisfied with the decision of the Commissioner or Trademark . . . Board, may appeal to the . . . Federal Circuit." 15 U.S.C. § 1071 (1988). Alternatively, section 21(b) of the Lanham Act authorizes a disappointed applicant to file a civil action in district court, but the Federal Circuit is not given exclusive jurisdiction over such actions. That is unlike the patent area where, under 28 U.S.C. § 1295(a)(4)(C), the Federal Circuit is given exclusive jurisdiction over appeals from district court when a dissatisfied applicant chooses the district court route under 35 U.S.C. § 145 or § 146 (1988). Also, unlike the patent area, section 1295(a)(4)(B) authorizes appeals to the Federal Circuit of the Commissioner's decisions.[30]

Trademark issues also come to the Federal Circuit in contexts other than from the PTO. They arise in appeals from district court patent cases that also contain claims of trademark infringement or other aspects of unfair competition, *e.g.*, under common law, state statutory law, and section 43(a) of the Lanham Act.[31] Also, they arise in the context of trade cases under 19 U.S.C. § 1337, where the "unfair methods of competition or unfair acts in the importation of articles into the United States" proscribed by that section involve trademarked items, *e.g.*, where the alleged trademark is in the shape of the item. *See, e.g., New England Butt Co. v. USITC*, 756 F.2d 874, 225 USPQ 260, 3 Fed. Cir. (T) 103 (Fed. Cir. 1985).

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[30] *Compare In re Makari*, 708 F.2d 709, 711, 218 USPQ 193, 194 (Fed. Cir. 1983) (patent decisions of the Commissioner on petitions are not directly appealable to the Federal Circuit) *with In re Holland Am. Wafer Co.*, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984) (decisions of the Commissioner in trademark cases are directly appealable to the Federal Circuit). (In patent cases, though, the Federal Circuit can hear appeals of district court judgments that involve a Commissioner's decision if the district court action "arises under" the patent laws. *See, e.g.*, *Wyden v. Commissioner of Patents & Trademarks*, 807 F.2d 934, 231 USPQ 918 (Fed. Cir. 1986) (in banc), discussed in § I.A., *supra*.)

[31] Section 43 authorizes a civil action against a person who uses a "word, term, name, symbol, or device . . . or any false designation of origin [or] false or misleading description . . . or . . . representation of fact, which . . . is likely to cause confusion, or . . . mistake, or . . . deceive as to the affiliation, connection, or association of such person with another per-

Cases from the PTO typically involve whether a particular mark is entitled, under the Lanham Act, to registration on the Principal Register.[32] Federal registration, though, is not needed to obtain and enforce common law trademark rights, which are typically derived from use of the mark on goods or services. *See, e.g., In re Beatrice Foods Co.*, 429 F.2d 466, 472, 166 USPQ 431, 435 (CCPA 1970).[33] On the other hand, registration offers a number of benefits, particularly from

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son, or as to the origin, sponsorship, or approval of his or her goods . . . by another person . . . ." 15 U.S.C. § 1125 (1988).

[32] There is also a Supplemental Register. *See generally* J. McCarthy, *Trademarks and Unfair Competition*, § 19.8 (1984 and Supp. 1989) (hereinafter McCarthy). It was originally established to enable persons in this country to register trademarks domestically so that they might obtain foreign registration. *Id.* at 886. All marks capable of distinguishing an applicant's goods and services (*e.g.*, not generic, *see* § III.C., *infra*) and "not registrable on the principal register" can be registered on the Supplemental Register (unless unregistrable under §§ 2(a)-(d) of the Lanham Act, *see* § III.C., *infra*). 15 U.S.C.A. § 1091(a) (West Supp. 1990). There is no opposition proceeding before a Supplemental Registration but petitions to cancel such registrations are allowed. *Id.* at § 1092. Registration of a mark on the Supplemental Register does not preclude later registration on the Principal Register if the mark has become eligible for such registration. McCarthy, *supra*, at 891-92. As one might expect, the Supplemental Register generally offers less than the Principal Register in the way of advantages and rights. *Id.* at 887.

[33] Use is generally a key under the Lanham Act, too. Prior to the 1988 Trademark Law Revision Act (effective Nov. 16, 1989), the Lanham Act defined "trademark" as "any word, name, symbol, or device, or any combination thereof *adopted and used* by a manufacturer or merchant to identify his goods. . . ." (Emphasis added.) 15 U.S.C. § 1127 (1982). The 1988 Revision Act injected a new concept. It changed the above underlined phrase to "(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act." 15 U.S.C. § 1127 (1988). The Trademark Revision Act enables a person to apply for registration based on such intent to use. *See* 15 U.S.C. § 1051(b)-(d) (1988). Registration, however, is not allowed until a statement of use is subsequently filed within the time prescribed by 15 U.S.C. § 1051(d) (1988). *See also* § 44, involving registrations based on foreign priority and intent to use. 15 U.S.C. § 1126 (1988). "Use in commerce" is now defined by § 45 as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark"; "commerce" means "all commerce which may lawfully be regulated by Congress." 15 U.S.C. § 1127 (1988).

a procedural perspective during litigation. *In re Beatrice Foods*, 429 F.2d at 472, 166 USPQ at 435. For example, a certificate of registration of a mark upon the Principal Register is prima facie evidence of the validity of the registered mark, 15 U.S.C. § 1057 (1988). From a more substantive perspective, federal registration has traditionally conveyed certain rights in areas where the registrant's mark had not been used at the time of registration. *In re Beatrice Foods Co.*, 429 F.2d at 472-73, 166 USPQ at 435-36. *See generally* McCarthy, *supra* note 32, at section 26.13. Indeed, the 1988 Trademark Law Revision Act adds a new section 7(c) to the Lanham Act, which states that, "[c]ontingent on the registration of a mark on the principal register . . . the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect . . . ." 15 U.S.C.A. § 1057(c) (West Supp. 1990).[34]

The PTO makes the initial decision as to whether a trademark applicant is entitled to registration. If it decides that it is (or, in the case of an intent to use application, would be registrable upon the filing of a statement of use under 15 U.S.C. § 1051(d) (1988)), the mark will be published in the Official Gazette (OG) of the PTO, provided that in the case of an applicant claiming concurrent use or if an application is placed in interference with a similar mark, the mark may be published subject to determination of the rights of the parties to such proceedings. 15 U.S.C. § 1062 (1988). After publication, any person "who believes that he would be damaged by the registration of a mark upon the principal register" may file an opposition proceeding in the PTO. 15 U.S.C. § 1063 (1988). Unless registration is successfully opposed, a mark entitled to registration under section 1(a) of the Lanham Act (i.e., based on actual use, 15 U.S.C. § 1051(a) (1988)) or section 44 (i.e., based on foreign priority with an intent to use, 15 U.S.C. § 1126 (1988)), shall be registered and a certificate issued; if the application is under the new intent to use section 1(b), 15 U.S.C. § 1051(b) (1988), a notice of allowance is issued (with registration to follow upon the filing of a valid statement of use under section 1(d)). 15 U.S.C. § 1063 (1988). A petition to cancel a registration may be filed by "any person who believes that he is or will be damaged by the registration of a mark on the principal register," within five years from the date of registration under the Lanham Act or at any time if the registered mark becomes generic or has been abandoned or was obtained contrary to the provisions of section 2(a)-(c) (15 U.S.C. § 1052(a)-(c) (1988), discussed *infra*), or for any other reasons specified in 15 U.S.C. § 1064(3)-(5) (1988).

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[34] Another advantage of registration is apparent from 19 U.S.C. § 1337(a) (1988), discussed in § VII.B., *infra*. To prove a § 1337(a) violation resulting from "unfair methods of competition and unfair acts in the importation of articles," one must prove a certain "injury" articulated in § 1337(a)(1)(A)(i)-(iii), *except that* the injury requirement is unnecessary for, *inter alia*, registered trademarks. Section 1337(a)(1)(C).

Appeals to the Federal Circuit are from refusals to register, opposition proceedings, cancellation proceedings, interference proceedings, and concurrent use proceedings. 15 U.S.C. § 1071(a) (1988). They also can come from renewal proceedings. *Id.* Those relate to section 9 of the Lanham Act, which allows renewals for ten-year periods so long as the mark is still in use in commerce (unless special circumstances are shown). 15 U.S.C. § 1059 (1988). In reviewing cases from the Trademark Board, findings of fact are reviewed under a clearly erroneous standard, whereas legal questions are reviewed merely for error. *See, e.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 18, 225 USPQ 652, 654 (Fed. Cir 1985).

In general, the Trademark Rules of Practice make the Federal Rules of Civil Procedure applicable to inter partes proceedings, *e.g.*, oppositions, cancellations. 37 C.F.R. § 2.116(a) (1988). That includes use of summary judgment per rule 56 of the Federal Rules. Indeed, *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 627 n.2, 222 USPQ 741, 744 n.2 (Fed. Cir. 1984) stated:

> The practice of the U.S. Claims Court and of the former U.S. Court of Claims in routinely disposing of numerous cases on the basis of cross-motions for summary judgment has much to commend it. The adoption of similar practice is to be encouraged in inter partes cases before the Trademark Trial and Appeal Board, which seem particularly suitable to this type of disposition. Too often we see voluminous records which would be appropriate to an infringement or unfair competition suit but are wholly unnecessary to resolution of the issue of registrability of a mark.

B. *Standing*

The Federal Circuit has on a number of occasions addressed the question of standing.

In *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983), for example, the court stressed that section 14 of title 15 allows a petitioner to bring a cancellation proceeding if it *believes* it will be damaged, and it concluded that a party seeking to cancel or oppose need show only a "real interest" in the proceeding, which Selva had there. *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 1265, 219 USPQ 1050, 1052 (Fed. Cir. 1983), added that "[a]ctual damage from registration is relevant to that determination . . . but it is not requisite."

The standing issue arose in *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 204 (Fed. Cir. 1987). Jewelers Vigilance Committee, Inc. (JVC), opposed the application by Ullenberg Corporation to register a mark for precious stones, namely diamonds that included the words "Forever yours DeBeers Dia. Ltd." JVC was a nonprofit trade association in the jewelry industry representing 2,500 firms in the United States. JVC's members bought diamonds that had come to the market through DeBeers Consolidated Mines Ltd., allegedly controlling eighty-five percent of the market. In 1948 and continuously since that time, DeBeers had been using the slogan "A Diamond is Forever." JVC's members and others in the trade used the name and slogan of DeBeers to promote diamond jewelry generally.

The Board determined that JVC failed to plead sufficient facts to establish its standing because, in an opposition based on sections 2(a) and (d) (*see* section III.C., *infra*), an opposer must have a "proprietary right" in the mark that is the basis for the opposition. The Federal Circuit found that to be error. "The Board, in effect, by requiring JVC to possess a proprietary interest in the name DeBeers in order to have the requisite standing to bring an opposition proceeding under section 2(a) or 2(d), confused a merits determination . . . with a standing determination." *Id.* at 492, 2 USPQ2d at 2023. The court continued:

> [t]he Lanham Act "requires only a belief of damage resulting from the applicant's registration, and while that belief must have some reasonable basis in fact, this statutory provision . . . has been liberally construed . . . . There is no question that a trade association, having a real interest in the outcome of the proceedings, may maintain an opposition without proprietary rights in a mark or without asserting that it has a right or has an interest in using the alleged mark sought to be registered . . . .
>
> In this case, JVC must have alleged an adverse affect on its own interests *or* those of its members which will result from the issuance of the registration to

> Ullenberg. [Emphasis in original.] JVC has met that requirement . . . . These allegations [by JVC] demonstrate a real interest in the outcome of the proceeding based on a likelihood of confusion with the DeBeers' trade name. [Citations omitted.]

Id. at 493-94, 2 USPQ2d at 2024. The court also noted that JVC satisfied the three-part test for association standing stated in *Automobile Workers v. Brock*, 477 U.S. 274 (1986):

> "(a) its members would otherwise have standing to sue in their own right; (b) the interests it seeks to protect are germane to the organization's purpose; and (c) neither the claim asserted nor the relief requested requires the participation of individual members in the lawsuit." [Citation omitted.]

823 F.2d at 494, 2 USPQ2d at 2025.

C. *Grounds for Disallowing Registration*

Section 2 of the Lanham Act, 15 U.S.C. § 1052 (1988), states that "[n]o trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register unless it . . . [falls into one of five categories]." The categories are listed at subsections (a)-(e).

The first category, in subsection (a), constitutes marks that comprise "immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." In *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), for example, the university opposed the use of Notre Dame (plus a design) on cheese, not only because there was a likelihood of confusion as to source prohibited by section 2(d) (discussed *infra*), but also because applicant's mark falsely suggested a connection with the institution, prohibited by section 2(a). The court ruled that there was no likelihood of confusion as to source, per section 2(d), and that there was no false suggestion of a connection with the university, per section 2(a). In the latter regard, reasoned the court, to prove a section 2(a) violation one must at least show likelihood of confusion as to source, which was not done here.[35]

A section 2(a) case where the Trademark Board refused registration, and the refusal was affirmed on appeal, is *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988). There, the mark was LOVEE LAMB for automobile seat covers, but the Board rejected that because the term LAMB was deceptive. Specifically, the goods were made entirely of synthetic fibers, not lamb, and section 2(a) bans registration of a mark comprising "deceptive matter." The Federal Circuit affirmed, applying this three-part test: (1) is the term misdescriptive of the character, quality, function, composition, or use of the goods; (2) if so, are prospective purchasers likely to believe that the misdescription actually describes the goods; and (3) if so, is the misdescription likely to affect the decision to purchase?

For the most part, section 2(a) is not a frequent source of litigation at the Federal Circuit. Nor are sections 2(b) and 2(c), which prohibit, in (b), marks "compris[ing] the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof" and, in (c), marks "compris[ing] a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow."

The fourth category, likelihood of confusion under section 2(d), has been the most frequent source of appeals before the Federal Circuit. Under that section, registration is improper if the applicant's mark "so resembles a mark registered in the [PTO], or . . . previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. §

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[35] The court stated that the standards for §§ 2(a) and (d) cannot be identical and, in that regard, the Trademark Board has required a more stringent test for § 2(a), i.e., likelihood of confusion plus intent to trade upon the goodwill of a prior user. 703 F.2d at 1376, 217 USPQ at 508. The difference has significance because a petition to cancel after five years can be based upon § 2(a) but not § 2(d). *Id.* In any event, the court stated, it "need not decide" whether the Board's interpretation is correct because there was no likelihood of confusion, and hence, there could be no false association.

1052(d). A significant case on that section was *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Nation's Foodservice, Inc. (NFI), sought to register the mark GIANT HAMBURGERS (plus a Design) for use on "hamburger and hot dog sandwiches, milk shakes for consumption on or off premises" and restaurant services. Registration was opposed by Giant Food, Inc. (Giant), on the ground of likelihood of confusion between NFI's mark and Giant's prior use and registration of GIANT FOOD, SUPER GIANT, GIANT FOOD (plus a Design), and GIANT (plus a Design), for, among other things, retail grocery and supermarket services and private label food products. The Trademark Board ruled against Giant. The Federal Circuit reversed.

The main issue, reasoned the Federal Circuit, was "whether the mark of applicant is so similar to the marks of opposer that, when applied to applicant's goods and services, it would create a likelihood of confusion in the minds of purchasers in the marketplace concerning source or origin." 710 F.2d at 1569, 218 USPQ at 393. A more threshold issue, though, whether likelihood of confusion is a question of fact or law, was initially resolved.

NFI argued that likelihood of confusion is a question of fact, subject to the clearly erroneous standard of review. The Federal Circuit acknowledged that some circuit courts of appeals support that view but noted that other courts hold that it is a question of law. More importantly, review of a number of CCPA cases prompted the court to conclude that "our predecessor court did not consider itself bound by a narrow standard of review of the question." 710 F.2d at 1569, 218 USPQ at 394. Because CCPA decisions "are binding on us," reasoned the court, "we hold that the issue of likelihood of confusion is the ultimate conclusion of law to be decided by the court, and that the clearly erroneous rule is not applicable." *Id.*

Having decided that, it then proceeded to resolve the likelihood of confusion issue in Giant's favor, in light of the evidentiary factors mentioned in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), factors "that must be considered, when of record, in testing for likelihood of confusion." 710 F.2d at 1569, 218 USPQ at 393-94. The factors include, to name a few: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely to continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark; and (6) any other established facts probative of the effect of use.

Though likelihood of confusion under section 2(d) seems to have been the most prevalent issue before the court, issues relating to section 2(e) arise often. The latter section proscribes registration for a mark which:

> (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 [hereof relating to "Collective and Certification Marks Registrable"], or (3) is primarily merely a surname.

15 U.S.C. § 1052(e) (1988). Section 2(e) is in effect qualified by section 2(f), which allows a mark excluded by section 2(e) or otherwise not inherently distinctive to be registered if it has acquired distinctiveness, i.e., has developed secondary meaning.[36] Whether a mark has developed "secondary meaning" is reviewed as a question of fact by the court. *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990).

Sections 2(e) and 2(f) have come up in a variety of situations. A refusal based on the "merely descriptive language" of section 2(e)(1) was at issue in *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The Trademark Board had affirmed the PTO's refusal to register APPLE PIE as a trademark for potpourri (i.e., a pleasant smelling mixture used as a scent). The Board found that one of the key characteristics of applicant's potpourri was that it was scented to smell like apple pie and, on that basis, it held the mark to be merely descriptive (of a significant characteristic) under section 2(e)(1). One panel member dissented, saying that the mark was suggestive, not descriptive. The Federal Circuit stated:

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[36] Section 2(f) states, in part: "Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing [herein] shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made." 15 U.S.C. § 1052(f) (1988).

> A mark that is "merely descriptive", as the term is used in trademark law, is not registrable under section 2(e), but may be registrable under section 2(f), 15 U.S.C. § 1052(f), if secondary meaning is shown. [Footnote omitted.] A suggestive mark, one that "suggests, rather than describes," [citation omitted] is protectable without evidence of secondary meaning. Whether a given mark is suggestive or merely descriptive depends on whether the mark "immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used", or whether "imagination, thought, or perception is required to reach a conclusion on the nature of the goods." [Citation omitted.]

Id. at 1217, 3 USPQ2d at 1009. The Board, concluded the Federal Circuit, viewed "'apple pie' more as a definition of the scent than as a term requiring the exercise of imagination" and "[c]lear error has not been shown in the Board's finding that the term APPLE PIE conveys the key characteristic of the potpourri, its scent." 820 F.2d at 1217-18, 3 USPQ2d at 1010. Because there was no evidence as to secondary meaning before it, the court affirmed the Board's holding of nonregistrability.

Section 2(e)(2) was at issue in *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). The Trademark Board refused to register the mark DURANGO for chewing tobacco on the ground that it was "primarily geographically deceptively misdescriptive" under that section. Preliminary to that refusal, the PTO found: tobacco is a crop of the Durango, Mexico, area; Loew's product did not come from there; it would be reasonable for the public to expect that chewing tobacco bearing that mark would come from there; and Loew's product had not acquired distinctiveness per section 2(f). The Federal Circuit affirmed.

In *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987), however, the Federal Circuit reversed the Trademark Board's refusal to register the bottle configuration and the designation VITTEL, for certain cosmetic products, under section 2(e)(2). The source of the applicant's goods was Vittel, a small town in France which had mineral springs. 824 F.2d at 958, 3

USPQ2d at 1450. There was no question of deceptive misdescriptiveness because in fact the goods came from Vittel; the refusal was for "primarily geographically descriptive." 824 F.2d at 959, 3 USPQ2d at 1451. The Federal Circuit stated:

> a prima facie case of unregistrability cannot be made out simply by evidence showing that the mark sought to be registered is the name of a place known generally to the public; it is also necessary to show that the public would make a goods/place association, i.e., believe that the goods for which the mark is sought to be registered originate in that place. To hold such a belief, it is necessary, of course, that the purchasers perceive the mark as a place name and this is where the question of obscurity or remoteness comes to the fore.

824 F.2d at 959, 3 USPQ2d at 1452. In the latter regard, the court viewed the evidence as insufficient to show that Vittel was not obscure. As a result, "the evidence is insufficient to show the likelihood of that segment of the public [i.e., American cosmetic purchasers] thinking that Vittel refers to a place where the goods come from. Vittel is therefore not primarily geographically descriptive, at least in this country which is all that matters." 824 F.2d at 960, 3 USPQ2d at 1452.

Section 2(e)(3) was at issue in *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). There, the Trademark Board refused to register HUTCHINSON TECHNOLOGY for use with electronic components on the ground that it was primarily merely a surname under section 2(e)(3). The Federal Circuit reversed, noting that the test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public. In *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985), the court concluded that the Trademark Board's finding, that "Darty" is primarily merely a surname, is not clearly erroneous. Hence, it affirmed the Board's refusal to register under section 2(e)(3), particularly in light of the absence of evidence that the name had become distinctive of applicant's goods in commerce, per section 2(f).

As can be seen from the section 2(e) opinions, evidence of acquired distinctiveness or secondary meaning, under section 2(f), is often at issue. Such evidence, however, is not applicable to "common descriptive," i.e., "generic," marks.

In *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985), the PTO refused to register BUNDT, in a specific form, for ring cake mix. The examiner originally stated that the word is the name of a kind of cake and, as such, does not function as a mark capable of distinguishing applicant's goods. Applicant amended the application to seek registration under section 2(f) and submitted survey evidence in support of acquired distinctiveness. The examiner responded that "generic" marks cannot be saved by proof of distinctiveness or secondary meaning. The Board affirmed, and the Federal Circuit affirmed the Board. Determining whether a term is a generic or common descriptive term is a question of fact, reasoned the court, and the Board in this case correctly determined that BUNDT was such a term.

The Supreme Court offered this explanation of the difference between "generic" and "merely descriptive" marks:

> A generic term is one that refers to the genus of which the particular product is a species. [Citation omitted.] . . . A "merely descriptive" mark, in contrast, describes the qualities or characteristics of a good or service, ...

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194, 224 USPQ 327, 329 (1985). The Federal Circuit offered this explanation of generic:

> The generic name of a thing is in fact the ultimate in descriptiveness. . . .
>
> The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. [Citations omitted.] Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986).

Generic terms are refused registrability because, under at least one approach, they are incapable of serving as a trademark, i.e., of indicating the source of goods. *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1558-59, 227 USPQ 961, 962 (Fed. Cir. 1985). The ability to serve as a trademark was also the issue in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

Owens-Corning Fiberglas (OCF) was refused registration of the color pink as uniformly applied to OCF's fibrous glass residential insulation. The Board held that the overall color of goods is capable of functioning as a trademark, but affirmed the examiner's denial of registration on the ground that OCF had not adequately demonstrated that the color pink is distinctive of OCF's goods. The Federal Circuit agreed, especially in light of the Lanham Act and the objectives of enacting it, that "there is no inherent bar to trademark registration of the color of goods, when the color is an overall color rather than in the form of a design." 774 F.2d at 1118, 227 USPQ at 417. However, the Federal Circuit held as clearly erroneous the Board's finding that under the facts of this case, OCF failed to prove (per section 2(f)) that the color "pink" functions as a trademark for OCF's fibrous glass residential insulation. The dissenting opinion, however, would have held that a color, per se, is not capable of appropriation as a trademark and, even if it were, the Board's finding that OCF failed to prove secondary meaning was not clearly erroneous.

Capability of serving as a trademark is also related to the issue of functionality, typically involved with attempts to trademark product shapes and configurations. Specifically, if the shape or configuration serves a utilitarian purpose, as opposed to designating source, no registration is permitted. The issue has arisen in a number of Federal Circuit opinions. *See, e.g., In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (affirms PTO refusal to register a design of a loudspeaker system); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (affirms refusal to register overall appearance of a pistol grip water nozzle); *In re Teledyne Indus., Inc.*, 696 F.2d 968, 217 USPQ 9 (Fed. Cir. 1982) (affirms PTO refusal to register the design of a Water-Pik shower head); *cf. New England Butt Co. v. USITC*, 756 F.2d 874, 225 USPQ 260 (Fed. Cir. 1985) (section 337 ITC proceeding; no rights in overall appearance of braiding machine); *Textron, Inc. v. USITC*, 753 F.2d 1019, 224 USPQ 625 (Fed. Cir. 1985) (section 337 ITC proceeding; no rights in shape of certain machinery); *Petersen Mfg. Co. v. Central Purchasing, Inc.*, 740 F.2d 1541, 222 USPQ 562 (Fed. Cir. 1984) (district court proceeding; no rights in shape of long-nose locking pliers).

In those cases, reference is often made to *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

Applicant in *Morton-Norwich* was refused registration for a certain container configuration as a trademark. The container was used to hold spray starch, soil and stain removers, spray cleaners for household use, liquid household cleaners, general grease removers, and insecticides. The Trademark Board recognized that a product shape is registrable if it is (1) nonfunctional in character, and (2) either inherently distinctive or has acquired secondary meaning as an indication of origin for the goods. It refused registration because the container's configuration "was dictated primarily by functional (utilitarian) considerations." The CCPA reversed, holding that the shape was not functional, and it remanded for consideration of the issue of distinctiveness.

The opinion enunciated a number of principles that were useful in resolving functionality in that case and have been considerations in determining functionality in subsequent cases. Two primary ones are mentioned here. First, the requirement of nonfunctionality emanated from the case law, and not expressly from statutes. Specifically, it emanated from a judicial notion that there exists a fundamental policy in favor of copying a competitor's product unless the product is covered by a valid patent or copyright or, when a product or package design is under consideration, is "nonfunctional" and serves to identify its manufacturer or seller. Courts have considered that policy not in terms so much as a *right* to copy but, rather, as a *need* to copy those articles, in order to compete effectively. Second, there are two aspects to functionality: de facto and de jure. The former is "the use of 'functional' in the lay sense, indicating that although the design of a product, a container, or a feature of either is directed to performance of a function, it *may* be legally recognized as an indication of source." 671 F.2d at 1337, 213 F.2d at 13 (emphasis in original). "De jure functionality, of course, would be used to indicate the opposite—[i.e.,] such a design may not be protected as a trademark." *Id.*

IV. APPEALS FROM THE CLAIMS COURT

A. *Jurisdiction*

Under 28 U.S.C. § 1295(a)(3), the Federal Circuit has exclusive jurisdiction of final decisions of the Claims Court. The Claims Court, in turn, inherited the original jurisdiction of the Court of Claims.[37]

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[37] *See* Claims Court Bar Association, *The United States Claims Court, A Deskbook for Practitioners*, at 2 (1987) (hereinafter *Claims Court Deskbook*).

The principal statute governing jurisdiction of the Court of Claims, and now the Claims Court, is the Tucker Act, which states, in pertinent part:

> The United States Claims Court shall have jurisdiction to render judgment upon any claim against the United States founded either upon the Constitution, or any Act of Congress or any regulation of an executive department, or upon any express or implied contract with the United States, or for liquidated or unliquidated damages in cases not sounding in tort.

28 U.S.C. § 1491(a)(1) (1988).

The Tucker Act provides the necessary consent to suit, or waiver of sovereign immunity, by the United States. *United States v. Mitchell*, 463 U.S. 206, 212 (1983). However, the Tucker Act "does not create any substantive right enforceable against the United States for money damages." *Id.* at 216. *Accord United States v. Testan*, 424 U.S. 392, 398 (1976). The substantive right "must be found in some other source of law, such as 'the Constitution, or any Act of Congress, or any regulation of an executive department.'" *United States v. Mitchell*, 463 U.S. at 216. Moreover, "[n]ot every claim invoking the Constitution, a federal statute, or a regulation is cognizable under the Tucker Act." *Id.* Generally, "[t]he claim must be one for money damages against the United States" and "the claimant must demonstrate that the source of substantive law he relies upon '"can fairly be interpreted as mandating compensation by the Federal Government for the damage sustained."' [Citation omitted.]" *Id.* at 216-17. In undertaking the latter inquiry, "a court need not find a separate waiver of sovereign immunity in the substantive provision, just as a court need not find consent to suit in 'any express or implied contract with the United States' [citation omitted]" because "[t]he Tucker Act itself provides the necessary consent." *Id.* at 218.

The court does have limited authority to issue nonmonetary relief, but it must be specifically authorized by statute to do so. *See, e.g., United States v. Testan*, 424 U.S. 392, 398 (1976); *United States v. King*, 395 U.S. 1, 4 (1969); *see generally Claims Court Deskbook, supra* note 37, at 2-3. Thus, 28 U.S.C. § 1507 (1988) gives the court limited authority to issue declaratory judgments in actions under section 7428 of the Internal Revenue Code of 1954. Also, under 28 U.S.C. § 1491(a)(2) (1988), "the court may, as an incident of and collateral to [a] judgment, issu[e] orders directing restoration to office or position, placement in appropriate duty or retirement status, and correction of applicable records. . . ." *See generally Court of Claims History, supra* note 2, at 149-51. As another example, section 1491(a)(3) states:

> To afford complete relief on any contract claim brought before the contract is awarded, the court shall have exclusive jurisdiction to grant declaratory judgments and such equitable and extraordinary relief as it deems proper, including but not limited to injunctive relief.

That section, added by the Federal Courts Improvement Act of 1982, has been the subject of a number of bid protest cases at the court. (*See* section IV.B., *infra.*)

B. *Bid Protests*

CACI, Inc.-Fed. v. United States, 719 F.2d 1567 (Fed. Cir. 1983), traces the development of suits by unsuccessful bidders.

Prior to 1970, it was generally held that they had no standing to challenge the award of a contract. *Scanwell Laboratories, Inc. v. Shaffer,* 424 F.2d 859 (D.C. Cir. 1970), however, held that, under section 10 of the Administrative Procedure Act, 5 U.S.C. § 702 (*see* note 57, *infra*), a disappointed bidder had standing in district court to challenge a government contract award. In the Claims Court, "[t]he basis of such suits is a violation of 'an implied contract to have the involved bids fairly and honestly considered' [citation omitted]" and the Tucker Act grant of jurisdiction to the Claims Court over "'any claim against the United States founded . . . upon any express or implied contract with the United States . . .' [citation omitted]." 719 F.2d at 1573. The court quoted from *Keco Indus., Inc. v. United States,* 428 F.2d 1233 (Ct. Cl. 1970):

> "[B]y the solicitation for bids, the Government impliedly promised that it would give honest and fair consideration to all bids received and would not reject any one of them arbitrarily or capriciously, but would award the contract to that bidder whose bid in its honest judgment was most advantageous to the Government."

719 F.2d at 1573.

The legislative history of section 1491(a)(3), the court continued, reveals that Congress wanted the Claims Court to have the same authority over suits by unsuccessful bidders that the district courts have under *Scanwell.* The object of both types of suit, of course, is to challenge an impropriety in the bid process, *e.g.*, a violation of statutory or procedural requirements. *Id.* at 1574.

In *United States v. John C. Grimberg Co.*, 702 F.2d 1362 (Fed. Cir. 1983) (in banc), however, the court made it clear that bid protest suits must be filed in the Claims Court before the contract is awarded.

P.W. Parker, Inc. (Parker), was the apparent winner on two contract bids opened July 8 and September 13, 1982. Disappointed bidders Grimberg and Schlosser protested to the government contracting officer that the listing of Parker's subcontractor violated paragraph 10 of the Special Conditions of the Invitation for Bid. In spite of the protest, on September 29 and 30 the government awarded the contracts to Parker. On October 4, 1982, Grimberg and Schlosser jointly filed in the Claims Court a complaint seeking termination and award to them of the contracts awarded to Parker. They concurrently filed motions for a Temporary Restraining Order and a Preliminary Injunction. Then, the government moved to dismiss for lack of jurisdiction. The Claims Court denied Grimberg's and Schlosser's motions, for lack of jurisdiction, and it transferred the complaint to federal district court.

After a lengthy analysis of the statute and legislative history, the Federal Circuit held "that exercise of the equitable power granted the Claims Court in 28 U.S.C. § 1491(a)(3) (amended 1982) is limited to cases in which complaints are filed in the Claims Court *before* the involved contracts have been awarded." (Emphasis added.) 702 F.2d at 1374. Because the complaint was filed here after the award, concluded the court, the Claims Court lacked jurisdiction to hear and determine the present demand for equitable relief.

During its analysis, the court noted that a plaintiff may not obtain equitable relief just because a court has the power to grant it, but must state a contract claim which is itself within the jurisdiction of the court. Though the exact contract involved here was not spelled out in the complaint, "a fair construction indicates reliance on an implied contract to have the involved bids fairly and honestly considered." *Id.* at 1367. Moreover:

> only an implied contract claim is available to those who . . . are bidders, not contractors. The "contract" in the phrase "brought before the contract is awarded" in (a)(3) is an express contract awarded to another, if awarded at all. It is not the implied contract on which a claim may be brought

> for equitable relief under (a)(3) and which is never "awarded". Thus (a)(3) made an equitable remedy available when a claim over which the court has jurisdiction (implied contract under (a)(1)) is filed in the court before a contract has been awarded. [Footnote omitted.]

The court also held that 28 U.S.C. § 1631 provides for transfer to any court "in which the action or appeal could have been brought." *Id.* at 1374. As a post-award suit, the present action "could have been brought" in the district court. *Id.* "The Claims Court, therefore, did not err in issuing its transfer order." *Id.* The court reasoned in that regard that the legislative history in no way indicated an intention to remove the existing jurisdiction of district courts in such suits.

Judge Nichols concurred in the result, and four dissenting judges filed two separate opinions.

Judge Nichols believed that the better statutory construction is that "claim" in (a)(3) includes a bid protest, and hence, relief is available for a protest made before the award even though suit is filed after the award. However, the majority opinion convinced him that there is a plausible, contrary view, and in light of that, the doctrine of "strict construction of the consent to be sued" prompted him to vote with the majority. That doctrine "requires that if there is real ambiguity in a statutory consent, the ambiguity must be resolved against the broad construction." 702 F.2d at 1377.

Judge Kashiwa filed a dissenting opinion in which the other dissenters joined. He believed that the Federal Circuit had jurisdiction in the case and, hence, that transfer was inappropriate. As did Judge Nichols, he believed that "claim" in (a)(3) did not mean only a lawsuit filed in the Claims Court, as the majority would hold. He would interpret it merely as the assertion of a right, including a claim or bid protest brought to the attention of the contracting officer. Because the term is ambiguous, resort to legislative history, as well as the statute's purpose and intent, is needed, and in his view it supports the latter interpretation.

Judge Bennett filed the other dissenting opinion, in which the three other dissenters joined. He agreed with Judge Kashiwa's dissent, but wished to add that the majority's view is contrary not only to the general purpose of the Tucker Act, but, also, to "the two distinct ends which Congress contemplated in enacting the legislation before us: (1) that the Claims Court have jurisdiction to grant equitable relief so as to promote the integrity of the bidding process; and (2) that judicial interference be kept to a minimum so as not to delay the performance of government contracts unduly." *Id.* at 1387.

Grimberg was distinguished in *F. Alderete Gen. Contractors v. United States*, 715 F.2d 1476 (Fed. Cir. 1983). There, a prospective contractor first filed his suit for equitable relief in a district court, which transferred the case to the Claims Court. The contract was awarded one day after the transfer, before the Claims Court could rule on the merits of an application for injunctive relief. Holding that it could not exercise the equitable powers granted by the statute beyond the pre-award stage of the procurement process, the Claims Court dismissed the complaint.

The Federal Circuit reversed and remanded for further proceedings. It distinguished *Grimberg* on the ground that, here, a complaint had been filed before the date of the award (the filing date in district court was perceived as the initial date, *id.* at 1479-80), even though the Claims Court had not yet acted on it. Although it acknowledged that the Claims Court decision is supported by dicta in *Grimberg* precluding the allowance of *any* post-award relief, it noted that the precise issue there was "whether the Claims Court had power to enter injunctive relief in suits filed *after* the contract was awarded, and the statements relied on by [the Claims Court] were entirely unnecessary to decide that question." *Id.* at 1479 (emphasis in original).

In *Electro-Methods, Inc. v. United States*, 728 F.2d 1471 (Fed. Cir. 1984), Electro-Methods (EM) had bids outstanding on a number of government contracts when it was suspended from procurement activity. It sued in the Claims Court, seeking "emergency" injunctive and declaratory relief to prevent award of certain contracts to others on the ground that EM had been unlawfully suspended. The Claims Court ordered that, because of certain defects in the procedure used, the suspension of EM was defective, invalid, and not to be given further effect.

On appeal to the Federal Circuit, the government argued that the Claims Court lacked jurisdiction because the suit allegedly concerned EM's suspension, a matter which the government argued is separate and distinct from the bid solicitation process over which the Claims Court has exercised jurisdiction. The court rejected that argument. It noted that, at the time EM asserted its claims, it had established its implied contract with the government to have its bid fairly and honestly considered. That its grounds for appeal concerned the suspension does not change that; the effect of the suspension was to cause EM to lose a contract on which, at least with some bids, it was low bidder.

ATL, Inc. v. United States, 735 F.2d 1343 (Fed. Cir. 1984), presented a situation where the suit was filed *before* the government award of the contract but long *after* the government barred ATL from receiving any government contracts, "as were the bids at issue filed long after that suspension." *Id.* at 1344. "While mechanistic application of these facts does not per se determine the Claims Court's jurisdiction, this information is relevant in resolving whether the case is styled a 'bid protest' case over which the Claims Court and its predecessor court have long exercised jurisdiction, or whether the case constitutes an Administrative Procedure Act challenge to the government's suspension action, in which event the case belongs in district court." *Id.* (footnotes omitted). In this case, the Claims Court's dismissal for lack of jurisdiction was affirmed because the agency involved had no actual authority to bind the government to a contract with a suspended entity so long as the entity remained suspended—hence, the contract never existed.

C. *Where A Claims Court Case Can Be Heard*

Before proceeding to a general discussion of the types of cases that come before the Claims Court and, hence, are heard by the Federal Circuit, we address a more fundamental question: Where can the Claims Court hear its cases?

In re United States, 877 F.2d 1568 (Fed. Cir. 1989), involved suit by a contractor pertaining to his contract for repairs to military housing units in Germany. The claims were denied by the contracting officer, and the contractor filed suit in the Claims Court. The Claims Court ordered that the trial be held in a United States consulate to be designated in Germany. The government moved for reconsideration, contending that the court had no statutory authority to schedule, attend, or conduct any proceeding outside the territorial United States, and that under 28 U.S.C. § 2505, it could do so only within the United States. That section states:

> § 2505 *Trial before judges*
>
> Any judge of the United States Claims Court may sit at any place within the United States to take evidence and enter judgment.

28 U.S.C. § 2505 (1988). The Claims Court denied the motion.

The government petitioned the Federal Circuit for a writ of mandamus to vacate the order and prevent the Claims Court from conducting the proceeding outside the United States. The contractor opposed the petition, as did the Claims Court Bar Association, serving as amicus curiae. The Federal Circuit, though, granted the petition.

The Federal Circuit noted that "[n]either the Claims Court, . . . [the contractor], nor the brief of Amicus Curiae, point to any act of Congress as authority for the Claims Court to conduct proceedings abroad. In the absence of Congressional authorization, the Claims Court has no such power." 877 F.2d at 1571. The plain language of section 2505, reasoned the court, contemplates proceeding only in the United States, and there is no contrary legislative history. The Federal Circuit similarly rejected the Claims Court's suggestion that its interpretation of section 2505 is consistent with Claims Court procedure, with the Claims Court rules, and with a policy of allowing foreign contractors to sue in the Claims Court. In the latter regard, the Federal Circuit noted, a foreign contractor is not prevented from using the Claims Court. (It acknowledged, however, that for convenience a foreign contractor might opt to sue at the Armed Services Board of Contract Appeals, *see* section VI, *infra*, which regularly conducts hearings abroad.)

Judge Friedman dissented. He stated that the settled practice of the Court of Claims, of conducting hearings abroad, which Congress recognized and apparently approved and did not change when it created the Claims Court in 1982, authorizes the Claims Court judges to conduct such proceedings. As for section 2505 of 5 U.S.C., that had its origin in a 1930 statute written at a time when there were trial *commissioners* and appellate *judges*. It allowed the Court of Claims judges to "take evidence"; it was enacted not to limit where the trial commissioners could try cases but to allow the (appellate) *judges* to help cut down the court's backlog by hearing evidence. *Id.* at 1573-74. Consequently, the statute should not be construed to limit the present trial judges (formerly commissioners) as to where they can take evidence. *Id.* at 1575.

D. *The Types of Cases Heard by the Claims Court*

Though the Tucker Act covers a variety of claims, most can be categorized in these areas: contracts; takings (including patent cases); Indian claims; pay (civilian and military); tax; and "vaccines." *See generally Claims Court Deskbook, supra* note 37, at 3-20.

1. *Government Contracts*

One type of implied-in-fact contract has already been mentioned in section IV.B., *supra* (on Bid Protests). There are, of course, express contracts as well.

Litigating express contracts with the government generally involves the Contract Disputes Act of 1978 (CDA), codified at 41 U.S.C. §§ 601-613 (1988). *See Claims Court Deskbook, supra* note 37, at 4. That Act contains a number of provisions (*e.g.*, the requirement of written submission of a claim for over $50,000 to the contracting officer) that have been construed as "jurisdictional" prerequisites to the institution of suit in either the Claims Court or, as will be seen in section VI, *infra,* the Boards of Contract Appeals (BCA).

Both types of contracts—express or implied-in-fact—whether coming from the Claims Court, district court (*see* section V, *infra*), or a BCA, often involve issues pertinent to contract law in general and the government contract area in particular. Thus, one sees issues relating to contract ambiguity (both patent and latent), mutual mistake, estoppel, authority to bind, etc.

In a common type of case, a contractor will claim greater compensation (an equitable adjustment) for extra work performed as a result of, for example, a "differing site condition."

Stuyvesant Dredging Co. v. United States, 834 F.2d 1576 (Fed. Cir. 1987), for example, involved a 1982 contract award to Stuyvesant for maintenance dredging of Corpus Christi (Texas) Entrance Channel. All previous maintenance dredging of the channel had been performed by the United States Army Corps of Engineers (the Corps) with its own dredges. The last maintenance dredging had been done in 1978. After Hurricane Allen, there had been "emergency dredging" in 1981 designed to open the channel to navigation until maintenance dredging could restore the channel to its acceptable level.

The contract included a table in Technical Provision (TP) 4-1.3, which showed six places in the channel at which readings had been taken and density averages of material to be removed that ranged from 1.380 to 1.675 kilograms per liter. (Government records of previous dredgings, however, which were available to bidders in the government records office, showed densities ranging from 1.633 to more than 2.000 kilograms per liter.) The contract also contained TP 4-1.1, which stated that "[t]he material to be removed . . . is that composing [sic] of shoaling that has occurred since the channel was last dredged . . . ." TP 4-1.1 (like other technical provisions, including the table in 4-1.3) was part of the invitation for bids.

The work ultimately required twenty-four days more than Stuyvesant had anticipated, and it included approximately 302,500 cubic yards of material taken beyond what was allegedly prescribed, for which the Corps refused to pay. The contracting officer denied Stuyvesant's claim for an equitable adjustment based upon the company's alleged increased cost of performance. Stuyvesant filed suit in the Claims Court, which rejected Stuyvesant's claim. The Federal Circuit affirmed.

To prevail on a claim for differing site conditions, reasoned the Federal Circuit, the contractor must show that the conditions "indicated" in the contract differ materially from those it encountered during performance. *Id.* at 1581. The encountered conditions must have been "reasonably unforeseeable based on all the information available to the contractor at the time of bidding." *Id.* The contractor must also show that it reasonably relied on its interpretation of the contract and contract-related documents, and that it was damaged as a result of material variations between the expected and encountered conditions. *Id.* Also, the bid documents or contract must indicate what the conditions were supposed to be. *Id.*

Here, TP 4-1.3 did not indicate, much less warrant, that the density of the removed material would range from 1.380 to 1.6750. *Id.* TP 4-1.3 represented the figures to be an "average value of the density readings taken within the range indicated" and warned that average values should not be interpreted as a maximum or minimum. *Id.* Moreover, the averages were shown for only six specific locations in a channel 600-700 feet wide and four miles long—a totally inadequate basis for any generalization about the material to be removed. Also, the density of the material was only one of several factors determining the difficulty of dredging. *Id.*

TP 4-1.1 stated that "bidders are expected to examine the site of the work and the records of previous dredging" and after that "decide for themselves the character of the materials." The court reasoned that the conduct required of contractors by those provisions are inconsistent with the notion that Stuyvesant acted reasonably here. Stuyvesant failed to conduct the tests and documentary examination it was supposed to undertake for Corpus Christi, but it argued that it conducted such tests and documentary examination for its bids on two prior dredging contracts in the Texas Gulf and that the work in those projects was almost identical to the work here. The Federal Circuit rejected that:

> Each government contract stands by itself, however. Unless the government advises contractors that conditions in different contracts are the same, a contractor acts at its peril if it assumes that what it learned in bidding on other contracts applies equally to a new contract.

834 F.2d at 1582.

Stuyvesant also argued that TP 4-1.3 was a design specification, that the government therefore warranted the correctness of the information contained therein, that the term "shoaling" inaccurately described the material to be removed, and that the average densities listed in TP 4-1.3 inadequately and erroneously described the character of that material. *Id.* The court responded:

> Design specifications explicitly state how the contract is to be performed and permit no deviations. Performance specifications, on the other hand, specify the results to be obtained, and leave it to the contractor to determine how to achieve those results. [Citation omitted.] Detailed design specifications contain an implied warranty that if they are followed, an acceptable result will be produced. [Citation omitted.]
>
> The Claims Court ruled that technical provision 4-1.3 was not "a detailed [design] type specification for which the government might be liable under the defective specification theory." [Citation omitted.] Instead it was a "'performance' type specification for which the government does not warrant accuracy or adequacy".
>
> That determination was correct.

Id.

Stuyvesant also made an argument based upon the statement in TP 4-1.1 that the "material to be removed . . . is that compos[ed] of shoaling that has occurred since the channel was last dredged." Stating that it knew that the channel was last dredged in 1981, Stuyvesant contended that that provision led it to believe that the contract required the removal of only the material added to the channel since that time, which it assumed was a small amount and easy to dredge. The government countered that the words "last dredged" refer to the last maintenance dredging in 1978 and not to the emergency dredging three years later. The Federal Circuit responded:

> We find it unnecessary to determine which interpretation of the contract is correct or whether any ambiguity in the language was "patent" (as the Claims Court held), which would have required the contractor to make inquiry of the government before bidding, or merely latent (as Stuyvesant contends), in which case the contractual language would be construed against the government as the drafter of the document. For even under Stuyvesant's interpretation of the contract, Stuyvesant does not prevail.

Id. at 1583. The argument was immaterial, stated the court, because the Claims Court found, based upon expert testimony, that there was no difference in the degree of difficulty of dredging whether done after 1978 or after 1981. Because that finding was not clearly erroneous, it "compel[led] rejection of Stuyvesant's arguments." *Id.*[38]

Another contract-type case was *Johns-Manville Corp. v. United States*, 855 F.2d 1556 (Fed. Cir. 1988) (per curiam), *cert. denied*, 489 U.S. 1066 (1989). The appeal was of a Claims Court order dismissing three suits brought by Johns-Manville (JM) against the United States. The three dismissed cases were filed in the Claims Court as test cases representative of thousands of separate claims. In each of the three, JM sought indemnification from the United States for JM's liability to shipyard workers who were exposed to asbestos made by JM and sold to the United States.

The first case, which covered exposure to asbestos during World War II, sought relief under these theories: (1) breach of an implied warranty of specifications; (2) breach of a duty to reveal superior knowledge; (3) reformation of the contract due to mutual mistake of material facts; and (4) equitable adjustment. The second case, which covered exposure to asbestos after 1963, raised the above four theories and: (5) breach of warranty to use products safely arising from control by the United States of the specifications and conditions of use; (6) rights as an intended and third-party beneficiary of the supply contracts; and (7) breach of an additional implied-in-fact contract to indemnify, arising out of the government's requirement of contract compliance and its control of the asbestos products. The third case, which covered exposure to asbestos during "unrestricted or overlapping time periods," repeated the theories of the first suit and also alleged that the implied contract to indemnify applies to later "rip-out operations" under the exclusive control of the United States. *Id.* at 1558.

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[38] Review of fact findings of the Claims Court is under a "clearly erroneous" standard. *Heisig v. United States*, 719 F.2d 1153, 1158 (Fed. Cir. 1983).

Prior to its filing in the Claims Court, JM filed indemnification claims in district courts, alleging various negligence theories under the Federal Tort Claims Act. It also filed fifty-nine third-party indemnification complaints in one district court, alleging: breach of warranties of safe use, merchantability, and fitness for particular purpose; and breach of duty to maintain a safe workplace and to enforce health standards. The factual allegations in the district court cases overlapped with those in the Claims Court cases. *Id.* at 1558-59. They all alleged: (1) the United States compelled compliance with supply contracts and with the Navy's specifications; (2) the United States had control of the shipyard working conditions; and (3) the United States established safety standards in the shipyards but did not follow them.

The Claims Court dismissed the three suits because of 28 U.S.C. § 1500 (1988), which states that it:

> shall not have jurisdiction of any claim for or in respect to which the plaintiff or his assignee has pending in any other court any suit or process against the United States or any person who, at the time when the cause of action alleged in such suit or process arose, was, in respect thereto, acting or professing to act, directly or indirectly under the authority of the United States.

The Federal Circuit, despite a dissent, agreed that JM was barred by its prior suit. After examining statutory language, legislative history, and judicial precedent, the court concluded that the term "claim" in section 1500 is "defined by the operative facts alleged, not the legal theories raised." 855 F.2d at 1563. Here, "[t]he operative facts which support the several legal theories raised are . . . the same," *id.*, and hence, "28 U.S.C. § 1500 bars jurisdiction of the Claims Court over claims pending in a prior-filed case in another court." *Id.* at 1568. That is so, even though JM could not bring all its theories in one court (inasmuch as the tort claims could not be filed in Claims Court and the contract claims over $10,000 could not be filed in district court). *Id.* at 1564. Moreover, stated the court, the district court claims were "pending" within the meaning of section 1500 even though they had been stayed. *Id.* at 1567. Though the court did recognize an exception "where a type of relief not available in the Claims Court is sought in the other court," it found the exception inapplicable in this case. *Id.* at 1568.

2. *Takings (Including Patent Cases)*

Property may be taken by the government through condemnation proceedings in United States district court, 28 U.S.C. §§ 1358, 1403 (1988). *Court of Claims History, supra* note 2, at 137. Alternatively, it may be taken by "inverse condemnation" followed by suit in the Claims Court (with the option to go to district court under the Little Tucker Act for claims under $10,000, *see* section V, *infra*). *Id.* Appeal under the latter option is to the Federal Circuit.

Plaintiffs, who invoke the fifth amendment's mandate that no private property shall be taken for public use without just compensation, come to the Claims Court under its Tucker Act jurisdiction to adjudicate "claims founded upon the Constitution of the United States." *Id.* at 45. However, not every deprivation of use, possession or control is a taking. It is the character and extent of an invasion of property rights that is determinative. *Id.* An excellent review is provided by the *Claims Court Deskbook, supra* note 37, at 5-6 (citations and footnotes omitted):

> Questions of federal takings, or "inverse" exercises of the eminent domain power, are determined essentially by means of *ad hoc* analyses. The underlying principle of the just compensation remedy is that society may not impose a burden upon an individual that, in fairness and justice, should be borne by society itself. "This basic understanding of the [Fifth] Amendment makes clear that it is designed not to limit the governmental interference with property rights *per se*, but rather to secure *compensation* in the event of otherwise proper interference amounting to a taking." [Emphasis in original.]
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> * * * *
>
> A plaintiff must demonstrate an unfair interference with the use of its property by the United States in order to establish the existence of a taking

> within the meaning of the fifth amendment. The types of interference which can result in a taking are as varied as governmental action itself. For example, the broad spectrum of taking claims instituted in the Claims Court and its predecessor, the Court of Claims, includes flooding or water-related takings; overflight, or aviation easement takings; and regulatory takings, as well as many cases which elude classification in discrete categories.

Regarding the last category of "taking" mentioned in that excerpt, regulatory takings, *Florida Rock Indus., Inc. v. United States*, 791 F.2d 893 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1053 (1987), discusses development of the law. "[I]t was once said," stated the court, that a lawful regulation "was not an exercise of the power of eminent domain but of the police power or some other different source of authority." *Id.* at 900. That argument got its start in an 1887 Supreme Court case, *Mugler v. Kansas*, 123 U.S. 623 (1887), but "the scope of permissible regulation has much increased since 1887 and it is no longer asserted that a regulation, by its very nature as a regulation, cannot be an exercise of eminent domain." *Id.* In that regard, the court cited this test from *Connolly v. Pension Benefit Guaranty Corp.*, 475 U.S. 211, 224-25 (1986) (citations omitted), for determining when a regulation constitutes a taking:

> [W]e have eschewed the development of any set formula for identifying a "taking". . . and have relied instead on ad hoc, factual inquiries into the circumstances of each particular case. To aid in this determination, however, we have identified three factors which have "particular significance": (1) "the economic impact of the regulation on the claimant"; (2) "the extent to which the regulation has interfered with distinct investment-backed expectations"; and (3) "the character of the governmental action."

Federal Circuit opinions have involved a variety of compensable takings since the court began in 1982. *See, e.g., Cooper v. United States*, 827 F.2d 762 (Fed. Cir. 1987) (government destruction of timber caused by flooding); *Branning v. United States*, 784 F.2d 361 (Fed. Cir. 1986) (aviation easement, i.e., easement of flight in air space above land); *City of Van Buren, Ark. v. United States*, 697 F.2d 1058 (Fed. Cir. 1983) (government appropriation of subterranean flowage easement).

In *Owen v. United States*, 851 F.2d 1404 (Fed. Cir. 1988), the court decided in banc to override precedent and determine that a certain type of action was a compensable taking. The suit in *Owen* was brought by William Owen, as executor of the estate of his mother, Caroline Payne. Plaintiff claimed that the government "inversely condemned" the land and home of Mrs. Payne when it undertook certain improvements along the Tombigbee River in Greene County, Alabama. In particular, he claimed, dredging by the Army Corps of Engineers caused erosion of Mrs. Payne's land and eventual collapse of her house into the river. The Claims Court granted the government's motion for judgment on the pleadings, finding that the Tombigbee River was "navigable water," and hence, the government's activities were immunized from suit by the dominant "navigational servitude."

Quoting Supreme Court precedent, the Federal Circuit explained "navigational servitude":

> "The power to regulate navigation confers upon the United States a 'dominant servitude,' which extends to the entire stream and the stream bed below ordinary high-water mark. The proper exercise of this power is not an invasion of any private property rights in the stream or the lands underlying it, for the damage sustained does not result from taking property from riparian owners within the meaning of the Fifth Amendment but from the lawful exercise of a power to which the interests of riparian owners have always been subject."

Id. at 1408 (citations omitted). "Land or property within the bed," said the Federal Circuit, "are always subject to (or burdened with) the potential exercise of the navigational servitude; thus, no compensation is owed when the government takes such land or property as the result of aiding the navigability of the stream." *Id.* at 1409 (footnote omitted). The critical question became what constitutes the boundary of the stream "bed." *Id.* The Supreme Court has defined it this way:

> "[T]hat portion of its soil which is alternately covered and left bare, as there may be an increase or diminution in the supply of water, and which is adequate to contain it at its average and mean stage during the entire year, without reference to the extraordinary freshets of the winter or spring, or the extreme droughts of the summer or autumn."

Id. at 1409 (citation omitted). Thus, at least with respect to the vertical limits of the navigational servitude, the "'[h]igh-water mark bounds the bed of the river. Lands above it are fast lands and to flood them is a taking for which compensation must be paid' [citations omitted]." *Id.* The court also noted that there are horizontal, as well as vertical, limits to navigational servitude. *Id.* at 1410.

The Payne property at issue was outside the bed of the Tombigbee River. The Federal Circuit concluded that Supreme Court precedent, and most Court of Claims cases, support this: "navigational servitude does not provide a blanket exception to the Takings Clause of the Fifth Amendment where improvements to navigation made by the government result in erosion to land located above *or* outside the bed of the stream as delineated by the high-water mark at the time of the construction." *Id.* at 1412 (emphasis in original).

The Claims Court, however, had dismissed the case on the pleadings because of two cases, *Pitman v. United States*, 457 F.2d 975 (Ct. Cl. 1972), and *Ballam v. United States*, 806 F.2d 1017 (Fed. Cir. 1986), *cert. denied*, 481 U.S. 1014 (1987). In the Claims Court's view, those cases prevented any possible recovery for government-caused erosion. *Owen*, 851 F.2d at 1406. That reliance was "understandable," said the Federal Circuit, 851 F.2d at 1418, but "we hereby overrule [in banc] those decisions to the extent that they allow the navigational servitude to reach fast land above and outside the bed of navigable water." *Id.* at 1416 (footnote omitted).

The Federal Circuit added that, on remand, the government "will not be constrained to accept the complaint's [sic] factual allegations [as it was so constrained here, on the judgment on the pleadings] and will be free to prove that the alleged destruction was either not the result of its action or was such an indirect consequence of it as not to be a compensable taking." *Id.* at 1418. Indeed, in the Claims Court, on remand, "[d]efendant established other forces and developments that independently are sufficient to explain the damage," and hence, the Claims Court held that "[p]laintiff has not met his burden of proving that the dredging was a cause of the erosion." *Owen v. United States*, 20 Cl. Ct. 574, 577 (1990). The complaint was dismissed.

A different type of "compensable taking" involves patents and 28 U.S.C. § 1498 (1988), which in pertinent part states:

> (a) Whenever an invention described in and covered by a patent of the United States is used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, the owner's remedy shall be by action against the United States in the United States Claims Court for the recovery of his reasonable and entire compensation for such use and manufacture.

"The theoretical basis for his recovery" in such suits "is the doctrine of eminent domain." *Motorola, Inc. v. United States,* 729 F.2d 765, 221 USPQ 297 (Fed. Cir. 1984). As is the case generally for Claims Court suits, there is no injunctive relief available in such actions. Hence, the fundamental right of the patent laws, to exclude others from making, using, or selling patented inventions, 35 U.S.C. § 154 (1988), does not exist.[39] In that sense, the United States is not in the position of an ordinary infringer; it is "a compulsory nonexclusive licensee." 729 F.2d at 768, 221 USPQ at 299. Other differences also exist:

> increased damages and attorneys fees available against private infringers under 35 U.S.C. §§ 284 and 285 are not permitted in the eminent domain proceeding . . . . [T]he Government (treated as a licensee) has a right to replace (repair) an unpatented element in a patented combination without paying additional royalty. . . . As a compulsory, nonexclusive licensee, the Government is treated as an *Aro* I voluntary licensee, and not as an *Aro* II private, unlicensed infringer. Further, the Government can only be sued for any direct infringement of a patent (35 U.S.C. § 271(a)), and not for inducing infringement by another (section 271(b)) or for contributory infringement (section 271(c)).

Id. at 768 n.3, 221 USPQ at 299 n.3 (citations omitted). Additionally, the marking requirements of 35 U.S.C. § 287 (1988) are not incorporated into a section 1498 suit. *Id.*[40]

3. *Indian Claims*

The jurisdiction of the Claims Court to entertain the claims of Indians and Indian tribes possesses a historical basis that extends back to the mid-1800s. *See generally Claims Court Deskbook, supra* note 37, at 17-18; *Court of Claims History, supra* note 2, at 99-102. The Court of Claims, established in 1855, was soon deprived by an 1863 statute of jurisdiction to entertain most Indian claims. *Claims Court Deskbook, supra* note 37, at 17. Eventually, however, in 1946, Congress created the Indian Claims Commission (ICC). *Court of Claims History, supra* note 2, at 99. The purpose of the Act establishing the ICC was to hear and decide every Indian tribal claim—legal, moral, and equitable—against the United States arising before August 13, 1946. *Id.*

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[39] *Cf. W.L. Gore & Assocs., Inc. v. Garlock, Inc.,* 842 F.2d 1275, 1282, 6 USPQ2d 1277, 1283 (Fed. Cir. 1988) (an injunction against infringement by a private party, entered in private litigation, cannot apply to government contracting activities because of § 1498(a)).

[40] Section 287(a) of title 35 states, in pertinent part: "Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word 'patent' or the abbreviation 'pat.', together with . . . . In the event of failure so to mark, no damages shall be recovered by the patentee . . . except on proof that the infringer was notified. . . ."

The Act divided claims into five broad categories, which were listed in 25 U.S.C. § 700. *Id.* at 101. Claimants, though, had to file a claim within five years of the date of the Act. *Id.* at 100. The Court of Claims originally had jurisdiction to hear appeals from the ICC in those "historical tribal claims." *Claims Court Deskbook, supra* note 37, at 17. In 1978, though, when the ICC expired (originally, it was to be in existence only ten years), all of its cases were transferred to the Court of Claims. *Id.*

Section 24 of the ICC Act also provided a jurisdictional basis for nonhistoric, "modern-era" claims. *Claims Court Deskbook, supra* note 37, at 18. It allowed suit for legal, but not moral, claims arising after the 1946 Act, in the Court of Claims. *Court of Claims History, supra* note 2, at 99. That so-called "Indian Tucker Act" is now 28 U.S.C. § 1505 (1988):

> The United States Claims Court shall have jurisdiction of any claim against the United States accruing after August 13, 1946, in favor of any tribe, band, or other identifiable group of American Indians residing within the territorial limits of the United States or Alaska whenever such claim is one arising under the Constitution, laws or treaties of the United States, or Executive orders of the President, or is one which otherwise would be cognizable in the Claims Court if the claimant were not an Indian tribe, band or group.

Section 1505 is for the claims of tribes, bands, or groups of American Indians. *Claims Court Deskbook, supra* note 37, at 18. Individuals can sue under 28 U.S.C. § 1491(a). *Id.*

In any event, both "historic" and "nonhistoric" claims come before the Claims Court, and are reviewable by the Federal Circuit. *Gila River Pima-Maricopa Indian Community v. United States,* 877 F.2d 961 (Fed. Cir. 1989), involves a "historic claim."

The Pima and Maricopa Indians had developed as an agricultural society, utilizing water from the Salt and Gila Rivers for irrigation. However, some of the upstream river water was diverted away from the Pima's community after creation of its reservation in 1859. That diversion hindered farming. In an attempt to alleviate diminished water supply, the United States undertook several irrigation projects.

In addition, the United States, acting as fiduciary for the Pimas, leased some of the reservation lands. The Pimas believed that the United States breached its fiduciary duty of trust in administering those leases. Accordingly, they filed a claim with the ICC in 1951. The case was subsequently transferred to the Court of Claims and then to the Claims Court.

The Claims Court found that the government did not breach its duty of trust or of fair and honorable dealings in representing the community's interests, in leasing and managing the reservation lands and water resources. On appeal, the Federal Circuit affirmed, concluding that there was "no legal error, clearly erroneous fact-finding, or abuse of discretion in the judgment of the Claims Court." 877 F.2d at 965.

Short v. United States, 719 F.2d 1133 (Fed. Cir. 1983), involved "modern era" claims by individual Indians seeking relief from allegedly discriminatory distribution of proceeds from timber sales on Indian-owned lands.

The suit was filed in 1963 by plaintiffs, each of whom claimed to be an Indian and sought to participate in the distribution of funds the government had distributed to the Hoopa Valley Reservation. The Court of Claims decided, in 1973, that all the Indians of the Hoopa Valley Reservation (including members of the Hoopa Tribe and non-Hoopa Indians residing on or connected with the reservation) were entitled to equal rights in the division of timber profits and other income from the unallotted trust land of the reservation. *Short v. United States,* 486 F.2d 561 (Ct. Cl. 1973), *cert. denied,* 416 U.S. 961 (1974). The United States, however, wrongfully paid profits only to members of the Hoopa Valley Tribe. The court in 1982 directed the trial judge to recommend standards for the qualification of the approximately 3,800 remaining plaintiffs, as Indians of the Hoopa Valley Reservation, entitled to share in the income of the reservation. The trial judge then established standards, which were appealed to the Federal Circuit. The Federal Circuit affirmed those standards. 719 F.2d at 1134.

Apart from affirming the standards, the Federal Circuit had to address a jurisdictional challenge raised by the government, and in light of *United States v. Mitchell,* 463 U.S. 206 (1983), the challenge was rejected. *Mitchell* involved a similar suit, where the government acted as a fiduciary in the management of Indian-owned forest lands on an Indian reservation. Respondents there (1,465 individuals and the tribe) invoked jurisdiction under the Tucker Act (applicable to the individuals) and the "Indian Tucker Act" (applicable to the tribe). The key jurisdictional issue for the Court was whether other statutes created a substantive right for money. It held they did, and hence, jurisdiction properly was in the Claims Court pursuant to the Tucker Act and the "Indian Tucker Act." Similar considerations led the Federal Circuit in *Short* to conclude that the statutes involved created a substantive right for money, and the Tucker Act provided jurisdiction in the Claims Court to adjudicate those rights.

4. *Pay Cases*

The Court of Claims traditionally reviewed civilian and military claims for pay. Suits brought by civilian employees included those seeking "to recover overtime pay, hazardous duty pay, travel allowances . . . and other types of pay and financial benefits provided by statute for civilian workers of the Government." *Court of Claims History, supra* note 2, at 115. *See also Claims Court Deskbook, supra* note 37, at 11-12.

Court of Claims, and later Claims Court, jurisdiction over civilian pay matters was decreased by the Civil Service Reform Act of 1978 (CSRA), at least with respect to adverse personnel actions of the type covered by chapter 75 of the CSRA. Thus, in *McClary v. United States*, 775 F.2d 280, 282 (Fed. Cir. 1985), the Federal Circuit stated that "[w]here an employee is provided a means of redress under the CSRA, that is, an appeal to the [Merit Systems Protection] Board, the employee does not have an independent cause of action in the Claims Court." Later, *United States v. Fausto*, 484 U.S. 439 (1988), held that, even though the CSRA provided no relief to the particular employee involved (a nonpreference eligible in the excepted service who had been suspended for thirty days), the employee could not sue in the Claims Court. (*Fausto* is discussed in section II.C.1., *supra*.)

On the other hand, numerous types of civilian pay cases still remain. *See, e.g., Bradley v. United States*, 870 F.2d 1578 (Fed. Cir. 1989) (suit by printers to adjust pay pursuant to 5 U.S.C. § 5379); *Adams v. United States*, 810 F.2d 1142 (Fed. Cir. 1987) (pay rate for Bureau of Engraving and Printing employees under 5 U.S.C. § 349(a)); *Aurich v.*

United States, 786 F.2d 1126 (Fed. Cir.), *cert. denied*, 479 U.S. 1017 (1986) (housing allowances for Department of Defense "teachers").

Suits brought by military personnel include those seeking "pay and allowances authorized by law for members of the Armed Services." *Court of Claims History, supra* note 2, at 47-51, 115, 120. They comprise "suits to recover disability pay, severance pay, per diem, allowances for quarters and for dependents, payments for the dependents of missing persons, and back pay . . . . [Military] [p]laintiffs may also seek restoration to active duty or retirement status and may request correction of records of service." *Id. See also Claims Court Deskbook, supra* note 37, at 13-14.

A military pay case, where the Federal Circuit was reversed by the Supreme Court, is *United States v. Morton*, 467 U.S. 822 (1984). The issue was whether the United States is liable for sums withheld from the pay of one of its employees because it complied with a writ of garnishment issued by a state court without personal jurisdiction over the employee. The Claims Court, and on appeal the Federal Circuit, held in favor of Morton. The Federal Circuit said that when an obligor notifies the government that the court issuing the garnishment order does not have personal jurisdiction over him, the order does not constitute legal process appearing regular on its face. However, the Supreme Court reversed, stating:

> [T]o hold the Government liable in this case would be to conclude that Congress intended to adopt a different standard for liability than would be applicable to a private employer. Such a conclusion is foreclosed by the statute and its legislative history. . . .
>
> The plain language of the statute, its legislative history and underlying purposes, as well as the explicit regulations authorized by the statute itself, all indicate that the Government cannot be held liable for honoring a writ of garnishment which is "regular on its face" and has been issued by a court with subject-matter jurisdiction to issue such orders.

Id. at 832-36.

Another significant military pay case is *Cornetta v. United States*, 851 F.2d 1372 (Fed. Cir. 1988) (in banc). Because that case was filed in district court under the Little Tucker Act, it is discussed in section V, *infra*.

5. *Tax Cases*

The Claims Court has jurisdiction under the Tucker Act "to render judgment upon any claim against the United States founded . . . upon . . . any Act of Congress . . . ." Because the tax laws are Acts of Congress, "[i]t has been clear since 1915 that suits for refund of taxes . . . come within the jurisdiction of the Claims Court." *Claims Court Deskbook, supra* note 37, at 3 (footnote omitted). That jurisdiction is shared with district courts under 28 U.S.C. § 1346(a)(1), which relates specifically to tax claims. Unlike Little Tucker Act cases under section 1346(a)(2), *see* section V, *infra,* there is no monetary limit in section 1346(a)(1) on the district courts' jurisdiction. District court tax cases are appealed to the regional circuits, whereas cases in the Claims Court are appealed to the Federal Circuit.

The tax jurisdiction of the Claims Court extends also: (1) pursuant to 28 U.S.C. § 1507 (1988), to declaratory judgment actions under section 7428 of the Internal Revenue Code, 26 U.S.C. § 7428 (1982), regarding the initial or continuing qualification of an entity as a charitable organization, a private foundation, or a private operating foundation; and (2) pursuant to 28 U.S.C. § 1508 (1988), to certain cases concerning the tax treatment of partnership items under sections 6226 and 6228(a) of the Internal Revenue Code, 26 U.S.C. §§ 6226, 6228(a) (1988). *Claims Court Deskbook, supra* note 37, at 3.

The Federal Circuit has resolved a number of interesting issues in the tax area. Two opinions illustrate that.

In *Danville Plywood Corp. v. United States,* 899 F.2d 3 (Fed. Cir. 1990), the Commissioner disallowed a claim for certain of a taxpayer's "entertainment" expenses, related to a weekend trip for 120 people to the Super Bowl in 1981. Taxpayer had claimed they were "ordinary and necessary business expenses under § 162 of the Internal Revenue Code." *Id.* at 6. The Claims Court affirmed the Commissioner, and the Federal Circuit affirmed the Claims Court. The Supreme Court, reasoned the Federal Circuit, has defined "necessary" as "appropriate and helpful" to the development of the taxpayer's business. *Id.* Also, to qualify as "ordinary," an expense must be a "'normal, usual, or customary' practice for the type of business involved." *Id.* Applying those definitions to the facts of this case, the decision of the Claims Court that Danville had failed to prove that the Super Bowl expenses were "ordinary and necessary" business expenses under section 162(a) of the Code, was not clearly erroneous. *Id.* at 10.

American College of Physicians v. United States, 743 F.2d 1570 (Fed. Cir. 1984), involved a medical journal published by the American College of Physicians (Physicians). Physicians was exempt from taxation under section 501(c)(3) of the Internal Revenue Code, as an entity "organized and operated exclusively for religious, charitable, scientific, testing for public safety, literary, or educational purposes." The journal included advertisements for pharmaceuticals, medical supplies, and medical equipment useful in the practice of internal medicine. After paying taxes on the profits from those advertisements, Physicians filed a claim for refund, which was denied on the grounds that the advertisements were not substantially related to Physicians' tax-exempt purposes.

The Claims Court affirmed. It, too, concluded that the advertisements were not substantially related to Physicians' tax-exempt purposes. It reasoned that any connection between the advertisements and Physicians' educational purposes was incidental.

The Federal Circuit, however, reversed. It held clearly erroneous the trial court's finding that the advertising was not substantially related to Physicians' tax-exempt purposes. It believed that the Claims Court had focused too much on the commercial nature of the journal and not enough on the advertisement's contribution to the education of the medical journal's readers. That purpose, reasoned the Federal Circuit, established the requisite substantial relation to the purpose of Physicians, and it entitled Physicians to exemption from taxation on the advertisement profits.

However, the Supreme Court reversed. It held that the advertisements were neither substantially related, nor did they contribute importantly, to the medical journal's educational purposes. The Claims Court, reasoned the Court, properly directed its attention to respondent's conduct of its advertising business, whereas the court of appeals erroneously focused exclusively upon the information conveyed by commercial advertising. 475 U.S. 834, 848-50 (1986).

6. *Vaccine Cases*

In 1986, the National Childhood Vaccine Injury Act (Vaccine Act), Pub. L. No. 99-660, §§ 3-1 *et seq.*, 100 Stat. 3743, 3755 (1986), was passed. Under the Act, the Secretary of the Department of Health and Human Services (Secretary) was to "establish a National Vaccine Program to achieve optimal prevention of human infectious diseases through immunization and to achieve optimal prevention against adverse reactions to vaccines." 42 U.S.C. § 300aa-1 (1988). In addition, the Act established the National Vaccine Injury Compensation Program (Program), to take effect October 1, 1988, under which compensation could be paid for vaccine-related injury or death. 42 U.S.C.A. § 300aa-10 (West Supp. 1990). Under the Program, persons can collect from the Vaccine Injury Compensation Trust Fund for a vaccine-related injury or death associated with the administration of a vaccine on or after October 1, 1988. *Id.* at § 300aa-15(i)(2); 26 U.S.C. § 9510 (1988). Payment for an injury or death associated with a vaccine administered before that date is to be made from sums appropriated to the Department of Health and Human Services. 42 U.S.C.A. § 300aa-15(i)(1) (West Supp. 1990). Petitions for the latter type of injuries must be typically filed within twenty-eight months after October 1, 1988. *Id.* at § 300aa-16(a)(2), as amended by the Vaccine and Immunization Amendments of 1990, Pub. L. No. 101-502, § 5(e), 104 Stat. 1285, 1287.

In order to facilitate awards of compensation, the Vaccine Act establishes special masters in the United States Claims Court. 42 U.S.C.A. § 300aa-12(c) (West Supp. 1990). The office of special masters consists of a chief special master and not more than seven others. *Id.* at § 300aa-12(c)(1). When a petition against the Secretary is filed with the Clerk of the United States Claims Court, it is forwarded to the chief special master. *Id.* at § 300aa-12(d)(1). The chief designates a special master to issue a decision on such petition with respect to whether compensation is to be provided under the Program and the amount of such compensation. *Id.* at § 300aa-12(d)(3)(A). The decision of the special master may then be reviewed by the United States Claims Court. *Id.* The Claims Court may: (1) uphold the findings of fact and conclusions of law and sustain the special master's decision; (2) set aside any findings of fact or conclusions of law of the special master found to be arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law and issue its own findings of fact and conclusions of law; or (3) remand the petition to the special master. *Id.* at § 300aa-12(e)(2). The findings of fact and conclusions of law of the United States Claims Court are final, except that they may be reviewed by the Court of Appeals for the Federal Circuit upon petition by the Secretary or an aggrieved petitioner. *Id.* at § 300aa-12(f).

There have been two published Federal Circuit decisions in the area: *Brown v. Secretary, Dep't of Health & Human Servs.*, 920 F.2d 918 (1990); and *Wiggins v. Secretary, Dep't of Health & Human Servs.*, 898 F.2d 1572 (Fed. Cir. 1990). *Brown* is of particular interest insofar as it refers to a potential issue of Federal Circuit jurisdiction:

> Under section 300aa-21(a), a claimant may elect to accept the award of the Claims Court or to file a civil action in a state or federal court for damages arising from vaccine-related injuries or death. Brown filed an election to accept the Claims Court award before the Secretary noticed an appeal, and in any event the statute of limitations has long since run against her. Therefore the judgment of the Claims Court is final and this court may exercise its appellate jurisdiction. . . . Likewise, it appears review here is appropriate under Article III of the Constitution because there is no risk our opinion would be impermissibly advisory; Brown has already elected to accept the judgment of the Claims Court. As amended in 1989, section 300aa-21(a) does not require claimants to make an election until after appeal to this court, 42 U.S.C.A. § 300aa-21(a) (West Supp. 1990), but we intimate no view on the reviewability in this court of cases in which elections are not made before appeal.

920 F.2d at 921-22 n.** (citations omitted). Regarding the last quoted sentence, the Vaccine and Immunization Amendments of 1990, Pub. L. No. 101-502, § 5(g), 104 Stat. 1285, 1288-89, provide:

> If the review authorized by section 2112(f) [regarding appeals to the Federal Circuit] is held invalid because the judgment of the United States Claims Court being reviewed did not arise from a case or controversy under Article III of the Constitution, such judgment shall be reviewed by a 3-judge panel of the United States Claims Court.

In commenting on that provision, the explanation of amendments printed in the Congressional Record states:

> Although the committees do not believe that the review contemplated by the statute is impermissible, the committees have received comments suggesting that such review is without precedent. The committees have, therefore, provided for an alternative method of review so that the program may continue in any event.

136 Cong. Rec. S15199 (daily ed., Oct. 12, 1990).

V. APPEALS FROM DISTRICT COURTS IN LITTLE TUCKER ACT CASES

Under the "Little Tucker Act," 28 U.S.C. § 1346(a)(2) (1988), a district court shares original jurisdiction with the Claims Court in nontax Tucker Act cases not exceeding $10,000 in amount. Similar claims over $10,000, of course, cannot go to district court; they go only to the Claims Court pursuant to the Tucker Act, 28 U.S.C. § 1491(a)(1) (1988). *See* section IV, *supra.*

Prior to the Federal Courts Improvement Act of 1982 (FCIA), Little Tucker Act cases went either to the Court of Claims trial division, with automatic review by the appellate tier of that court, or to a district court, with review at the regional circuit court of appeals. That resulted in a significant degree of forum shopping, a result which the FCIA sought to eliminate by having appeals of all Little Tucker Act cases go to the Federal Circuit (including appeals from the Claims Court inasmuch as the Court of Claims appellate tier was eliminated). As stated in *Bray v. United States,* 785 F.2d 989, 991 (Fed. Cir. 1986):

> The legislative history of 28 U.S.C. § 1295 spells out Congress' further intent to eliminate forum shopping, as was exhaustively discussed in *Atari, Inc. v. JS & A Group, Inc.,* 747 F.2d 1422, 1434-35 (Fed. Cir. 1984). That intent was not limited to patent-related cases, but applied equally to those which, like the present case, are filed under the Little Tucker Act. *Id.* at 1437 n.13.

Perhaps the most publicized Little Tucker Act case in the past eight years was *United States v. Hohri,* 482 U.S. 64 (1987). That involved a suit by a Japanese-American organization and nineteen individuals seeking damages and declaratory relief for injuries suffered when, during World War II, the Federal Government displaced 120,000 Japanese-Americans from their homes. District court jurisdiction was based on the Little Tucker Act and the Federal Tort Claims Act (FTCA). The district court concluded that all claims were barred either by sovereign immunity or the applicable statute of limitations. The Court of Appeals for the District of Columbia Circuit (D.C. Circuit), however, reversed the district court's dismissal of certain of the Little Tucker Act claims. 782 F.2d 227 (1986).

First, the D.C. Circuit concluded that it, rather than the Federal Circuit, had jurisdiction over the appeal. "It noted that 28 U.S.C. § 1295(a)(2) generally grants the Federal Circuit exclusive jurisdiction of appeals in cases involving nontax claims under the Little Tucker Act." 482 U.S. at 67. But, it reasoned, "Congress did not intend the Federal Circuit to hear appeals of such cases when [as here] they also included FTCA claims." *Id.* The court then concluded that the statute of limitations did not begin to run on certain of respondents' Little Tucker Act claims until 1980, when Congress created the Commission on Wartime Relocation and Internment of Civilians. *Id.* Chief Judge Markey of the Federal Circuit, sitting by designation, dissented, disagreeing with the court's jurisdictional analysis, as well as its decision on the statute of limitations.

On review, the Supreme Court held that the case should have been at the Federal, not the D.C., Circuit. It stated: "Congress intended for centralized determination of nontax Little Tucker Act claims to predominate over regional adjudication of FTCA claims. We hold that a mixed case, presenting both a nontax Little Tucker Act claim and an FTCA claim, may be appealed only to the Federal Circuit." 482 U.S. at 75-76. Accordingly, the Supreme Court vacated the judgment and remanded the case with instructions to transfer to the Federal Circuit. (On remand, the Federal Circuit affirmed the district court's opinion, i.e., it held all the claims barred either by the statute of limitations or sovereign immunity, "for the reasons stated in the district court opinion." 847 F.2d 779 (Fed. Cir.), *cert. denied*, 488 U.S. 925 (1988).) *See also* discussion of *Atari, Inc. v. JS & A Group, Inc.*, section I.A., *supra.*

Another significant Little Tucker Act case filed in district court was *Cornetta v. United States*, 851 F.2d 1372 (Fed. Cir. 1988) (in banc). After in effect being twice passed over for promotion, Ronald J. Cornetta was honorably discharged from the United States Marine Corps on May 31, 1979. Following his discharge, he served three years on active duty in the Coast Guard, which service tolled the running of the six-year statute of limitations period set forth in 28 U.S.C. § 2401. 851 F.2d at 1378, 1380 n.2. On May 20, 1986, Cornetta filed suit in district court, alleging that his discharge was unlawful. To bring his case within the district court's jurisdiction under the Little Tucker Act, he limited his claim for back pay to $10,000. *Id.* at 1375. With his complaint, he served a discovery request on the government seeking information that would show that his delay in filing suit was neither unjustified nor unreasonable, and that the government would suffer no prejudice if the suit were to proceed.

Instead of responding to the discovery request, the government moved for summary judgment because of laches. The district court granted it, concluding that Cornetta's delay of nearly seven years from the date of discharge was unreasonable and that the government had been prejudiced by the delay. The latter conclusion was not based on "defense prejudice" (*e.g.*, loss of records, fading memories) but on a potential back pay recovery of $10,000 "for work he has not performed and which possibly was performed by another officer," and on increased retirement benefits should Cornetta prevail. *Id.* at 1375.

The Federal Circuit initially affirmed the district court. However, it accepted Cornetta's suggestion for rehearing in banc to reconsider the scope of the laches defense in military pay cases and the novel idea that potential receipt of increased retirement pay is prejudicial to the government. *Id.* The subsequent in banc opinion vacated the earlier judgment and opinion of the Federal Circuit panel, reversed the judgment of the district court, and remanded for proceedings consistent with the in banc opinion. *Id.* at 1383.

The court traced the development of laches in military cases and concluded that two Court of Claims decisions in *Cason v. United States*, 461 F.2d 784 (1972) and 471 F.2d 1225 (1973), resurrected the doctrine after a dormancy of over forty years. However, some quirks developed in the law, which prompted the court "to revisit the laches doctrine." 851 F.2d at 1377.

After a lengthy analysis, the court concluded: (1) laches must be applied apart from the statute of limitations. Hence, a tolling of the statute, as here, does not automatically toll the period to be considered in determining laches. *Id.* at 1378, 1380 n.2; (2) Cornetta wanted but did not receive discovery information that, he says, went to the justification of the delay. Because the delay must be unreasonable and unexcused for laches to apply, stated the court, "absent a record, we cannot say now if the district court erred in its summary conclusion that the delay was unreasonable." *Id.* at 1378; (3) a presumption of prejudice, based on a certain period of delay, has been premised largely on the theory that, if a claimant prevails, the government will be required to pay two salaries, over a long period of time, when it has received the services of only one person. In military cases, however, that "second man theory" lacks an adequate factual predicate.

After an explanation of why that is so, the court stated that: "[p]rejudice may not be presumed from the length of a claimant's delay." *Id.* at 1380. That will leave the burden of proving prejudice on the defendant. *Id.*; (4) "potential receipt of back pay alone is insufficient to show prejudice." *Id.* at 1381. That is particularly true here, where Cornetta limited his recovery to $10,000. *Id.* at 1382; and (5) the potential receipt here of increased retirement pay is insufficient to establish economic prejudice. *Id.*

Judge Michel concurred, agreeing with the majority opinion except in a few respects. First, he said, Cornetta had a chance to justify his delay, and hence, only the prejudice inquiry should be reopened on remand. Second, the majority, by stating that back pay, *alone*, cannot constitute prejudice, leaves open the use of back pay as a factor in determining prejudice. Thus, back pay plus another aspect of prejudice, itself insufficient, might show sufficient prejudice. The concurrence would eliminate its relevance entirely. Finally, the majority discussed the fact that only $10,000 in back pay was at issue here. The concurrence would make the amount of back pay irrelevant.

VI. APPEALS FROM BOARDS OF CONTRACT APPEALS

The Contract Disputes Act of 1978 (CDA), *see* section IV.D.1., *supra*, provides an aggrieved contractor with the choice of appeal to either the United States Claims Court, 41 U.S.C. § 609(a)(1) (1988), or an agency's board of contract appeals (BCA), 41 U.S.C. §§ 606, 607(d) (1988). In either event, under 28 U.S.C. §§ 1295(a)(3) and 1295(a)(10), the Federal Circuit has exclusive jurisdiction over any subsequent appeal, i.e., of final decisions of agency BCAs pursuant to section 8(g)(1) of the CDA, 41 U.S.C. § 607(g)(1) (1988), or of the Claims Court. *See* section IV.D.1., *supra*.

Prior to the CDA:

> a contractor could pursue two kinds of claims: claims for equitable adjustments under the disputes clause of the contract and claims for breach of contract. Disputes clause claims could be heard and decided by contracting officers and by boards of contract appeals, from which limited judicial review was available in the Court of Claims. The contracting officers and boards were not permitted to decide breach claims, however, which were taken directly to the Court of Claims.

Essex Electro Eng'rs, Inc. v. United States, 702 F.2d 998, 1002 (Fed. Cir. 1983) (footnotes omitted). The CDA to a certain extent "unified the process," allowing "breach" claims to go to the contracting officer and BCA. *Id.* Thus:

> Section 6(a) of the [A]ct, 41 U.S.C. § 605(a), provides that "*[a]ll* claims by a contractor against the government relating to a contract" are to be first submitted to the contracting officer for decision. Furthermore, under section 8(d), 41 U.S.C. § 607(d), a board of contract appeals can "decide *any* appeal from a decision of a contracting officer" with limited review by this court, pursuant to section 10 of the [A]ct, 41 U.S.C. § 609.[41]

Id. (emphasis supplied).

The law prior to the CDA was governed by the Wunderlich Act. Its background is explained in *Vista Scientific Corp. v. United States*, 808 F.2d 50, 51 (Fed. Cir. 1986):

> In *United States v. Wunderlich*, 342 U.S. 98, 72 S. Ct. 154, 96 L.Ed. 113 (1951), the Supreme Court held that procurement agencies could preclude judicial review of their decisions relating to contract disputes, except as to fraud issues, by exacting the contractor's acquiescence in contract clauses making agency board's decisions final both as to fact and law. This result was not deemed desirable by Congress, which enacted the Wunderlich Act, so called, to overturn the decision above cited of that name. Under the terms of this Act, board decisions could be accorded no finality on questions of law, but findings could be made final as to fact issues so far as supported by substantial evidence and not arbitrary or capricious, etc., and thus the statute restored a significant role to the Court of Claims. . . .
>
> The Contract Disputes Act of 1978 altered Wunderlich procedure in several ways. A contractor dissatisfied with a contracting officer's decision, could file a suit [in the Court of Claims] and have his trial with the court, bypassing the agency boards. If, however, he preferred the board route, the board decision was treated as a trial level decision; the function of the [Court of Claims] being to accord appellate review, clearly a function of the article III judges and not of the trial division. It was no longer, in form, a Tucker Act suit.

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[41] The standard of review in the CDA for reviewing a Board decision is: "on any question of law [it] shall not be final or conclusive, but the decision on any question of fact shall be final and conclusive and shall not be set aside unless the decision is fraudulent, or arbitrary, or capricious, or so grossly erroneous as to necessarily imply bad faith, or if such decision is not supported by substantial evidence." 41 U.S.C. § 609(b) (1988).

Relevance of the Wunderlich Act, though, was not eliminated by passage of the CDA. In *North Am. Corp. v. United States*, 706 F.2d 1212 (Fed. Cir. 1983), for example, the contract at issue was entered before the effective date of the CDA, and as stated in *Essex Electro*:

> The Contract Disputes Act applies to all contracts entered into after March 1, 1979. Its applicability to contracts entered into before March 1, 1979, is governed by section 16, 41 U.S.C. § 601 note, which provides, in pertinent part:
>
> "Notwithstanding any provision in a contract made before the effective date of this Act, the contractor *may elect* to proceed under this Act with respect to *any claim pending then before the contracting officer or initiated thereafter*. [Emphasis supplied.]"

702 F.2d at 1003. In *North American*, the contractor's claim was decided by the contracting officer on August 4, 1978. Hence, on the effective date of the CDA, "the claim was not pending before the contracting officer . . . but was pending before the Board. Such a claim is not subject to the Act." 706 F.2d at 1213. Because the CDA did not apply, the BCA "necessarily proceeded under the Wunderlich Act and the disputes clause of the contract." *Id.* But, reasoned the Federal Circuit, under 28 U.S.C. § 1295(a)(10), "this court cannot review the Board decision, since its jurisdiction over appeals from boards of contract appeals is limited to decisions of those boards pursuant to the Contract Disputes Act." *Id.* The present case "is reviewable only in the United States Claims Court (under the Tucker Act) and not in this court." *Id.* Rather than transfer the case, it was dismissed at appellant's request.

In *Vista Scientific Corp. v. United States*, 808 F.2d 50 (Fed. Cir. 1986), however, the Federal Circuit, on appeal from the Claims Court, actually reviewed a Wunderlich Act decision. The Department of Agriculture BCA had rejected two claims for equitable adjustment under a contract awarded in 1976. The decisions, stated the Federal Circuit, "were subject to the Wunderlich Act," and to obtain judicial review, appellant Vista sued in the Claims Court under the Tucker Act. Concerning that procedure, and the subsequent appeal to the Federal Circuit, the court stated:

> Since no legislation provides for judicial review of determinations made under the Wunderlich Act, except the Tucker Act, it follows that new petitions for review of Wunderlich cases had to be filed in the Claims Court under that Act. Yet, that court is still precluded by the *Bianchi* case from conducting

> trials, and its function in Wunderlich cases is of necessity purely appellate.[42] In view of the very different disposition made by the statutes respecting board decisions in [CDA] cases, the disposition of Wunderlich cases is so anomalous it reflects possible inadvertence on the part of Congress, or a sense that Wunderlich cases were, or else soon would be, so few that legislation respecting them was not needed. At any rate, after a board decides a Wunderlich case, facts and law, there ensue since 1982 two stages of appellate review, Claims Court and here [Federal Circuit], both functioning as appellate tribunals barred from reopening or redetermining the facts. Board findings not supported by substantial evidence can be overturned, but no such findings are pointed out here. . . .
>
> For us, functioning as the second stage of appellate review, our role normally would be to determine whether the Claims Court decided correctly the legal issues the unassailed fact findings present, including substantial evidence issues, where present. But we cannot forget it is the board decision which is the subject of Wunderlich Act review.

Id. at 52. The Federal Circuit went on to hold that "appellant has failed to persuade us of reversible error in the board's decision under the Wunderlich standard" of review, and hence, "[w]e affirm the judgment of the Claims Court." *Id.* at 53.

For the most part, though, Federal Circuit review of BCA decisions is pursuant to the CDA. In that role, the Federal Circuit sometimes reviews the scope of BCA jurisdiction. One such case was *Coastal Corp. v. United States*, 713 F.2d 728 (Fed. Cir. 1983).

In *Coastal*, the Department of Energy had requested proposals for storage of large amounts of petroleum for national emergencies. The Request for Proposals stated that the Department "was not committed 'to pay costs incurred in the submission of a proposal,' and that the government might terminate the procurement 'at any stage' and reject 'any and all offers.'" 713 F.2d at 729. The Department cancelled the solicitation for proposals before any contract was awarded, but after proposals were submitted. As a result, Coastal Corporation (Coastal) incurred bid preparation costs and sued for more than two million dollars. Its theory was that there was an implied contractual commitment by the government to pay its bid preparation costs because the government improperly had cancelled the solicitation. The complaint was, in that regard, similar to those filed by disappointed bidders in Claims Court. *See* section IV.B., *supra*. Coastal's claim was denied on the merits by both the contracting officer and, on appeal, by the Department of Energy BCA. The Federal Circuit, however, never reached the merits. It vacated the BCA's decision for lack of BCA jurisdiction.

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[42] "In *United States v. Carlo Bianchi & Co.*, 373 U.S. 709 . . . (1963), the Supreme Court construed the Wunderlich Act to restrict the Court of Claims to a purely appellate function in disputes clause cases." 808 F.2d at 51.

Though section 8 of the CDA allows a contractor to appeal to a BCA, and section 9(d) states that the BCA shall have jurisdiction to decide an appeal, 41 U.S.C. §§ 606, 607(d), the court reasoned that section 3(a) of the CDA, 41 U.S.C. § 602(a), expressly makes that Act applicable only to the procurement of services and property, and to the disposal of property. The type of contract involved in Coastal's theory to recover, i.e., an implied contract obligating the government to treat a bid honestly and fairly, is *not* such a contract, concluded the court. Though some BCAs, reasoned the court, have taken jurisdiction over such claims—on the theory that section 3(a) covers not only the particular kinds of contract there specified but, also, other contracts tangentially connected with procurement of goods and services—the Federal Circuit "reject[s] this gloss upon the unambiguous language of the statute," which expressly limits the type of contracts covered. 713 F.2d at 730.

Coastal argued that disappointed bidders have brought such claims in the Claims Court, and the last sentence of section 8(d) of the CDA, 41 U.S.C. § 607(d), authorizes BCAs "to grant any relief that would be available to a litigant asserting a contract claim in the United States Claims Court." The court rejected that:

> The last sentence of section 8(d), however, does not define the kinds of contracts to which the Act applies. Section 3(a) defines the scope of the Act and, as we hold, it does not cover this type of contract. The second sentence of section 8 deals solely with the kind of relief a contract appeals board may give in a case within its jurisdiction. The provision cannot properly be considered as expanding the jurisdiction that section 3(a) gives the Board.

713 F.2d at 731.

Pertaining to another aspect of jurisdiction, the Federal Circuit, in appeals from BCAs and the Claims Court, is frequently confronted with issues relating to certification of a claim. Under the CDA, for claims against the government exceeding $50,000, "the contractor shall certify that the claim is made in good faith, that the supporting data are accurate and complete to the best of his knowledge and belief, and that the amount requested accurately reflects the contract adjustment for which the contractor believes the government is liable." 41 U.S.C. § 605(c)(1) (1988). "Lack of proper certification, where required, deprives the contracting officer, the board of contract appeals, and this court (on review) of jurisdiction to proceed on the claim." *See, e.g., Tecom, Inc. v. United States,* 732 F.2d 935, 937 (Fed. Cir. 1984).

The person who certifies must have proper authority to do so. In *Ball, Ball & Brosamer, Inc. v. United States,* 878 F.2d 1426 (Fed. Cir. 1989), for example, Federal Acquisition Regulation (FAR) 33.207 was in both contracts and listed several categories of persons who qualified as being an appropriate authority to certify. The person who certified in that case, though, did not fit under any of the categories. Certification, therefore, was held to be improper, and the BCA decision dismissing the appeal for lack of jurisdiction was accordingly affirmed.

Issues of jurisdiction at a BCA have not been limited to cases involving the CDA. For example, *Electronic Data Sys. Fed. Corp. v. General Servs. Admin. Bd. of Contract Appeals,* 792 F.2d 1569 (Fed. Cir. 1986), involved the statutory protest authority of the General Services Administration BCA (GSBCA) under the Brooks Act, 40 U.S.C. § 759, as amended by the Competition in Contracting Act, Pub. L. No. 98-369 (CICA), now 40 U.S.C. § 759(h).

Pursuant to the Brooks Act (sections 759(a) and (b)), GSA is made the procurer of automatic data processing equipment (ADPE) for all government agencies (with certain exceptions). 792 F.2d at 1577. (No definition of ADPE is offered in the statute. *Id.* at 1578.) GSA's authority is exercised subject to direction by the President and the Office of Management and Budget (OMB), and proposed determinations are subject to review and decision by OMB. *Id.* A protest may be filed with GSBCA "by 'an interested party in connection with any procurement conducted under the authority of this section (including procurements conducted [by an agency other than GSA] under delegations of procurement authority [by GSA]). . . .' If the protest falls within that jurisdictional provision, GSBCA then 'shall review any decision by a contracting officer alleged to violate a statute or regulation.'" *Id.* at 1578. Relief can be granted by GSBCA through its power to "'suspend, revoke, or revise the procurement authority of the

Administrator [of GSA] or the Administrator's delegation of procurement authority applicable to the challenged procurement.''' *Id.* at 1577. That power extends to both pre-award and post-award protests. *Id.* at 1580. Appeal of a GSBCA decision can be made to the Federal Circuit. 41 U.S.C. § 607(g)(1).

The controversy in this case arose out of a GPO procurement for integrated printing and publishing services to prepare, print, and distribute Army manuals. After a request for proposals, and receipt of a number of bids, the contract was awarded to Electronic Data Systems Federal Corporation (EDS). Xerox filed a protest with GSBCA, to which other protestors joined, alleging, *inter alia*, that the contract is one for ADPE which should have been a procurement under the Brooks Act and that GPO violated other statutes, regulations, and its own requests for proposals. No party in the case contended that the subject procurement was actually conducted under the Brooks Act either by GSA or via a delegation of GSA's authority to GPO.

GPO filed a motion to dismiss the protest on the ground that GSBCA lacked jurisdiction because the procurement was not conducted under the Brooks Act. GPO further contended that the contract was for printed material, not ADPE, and that the contractor's use of ADPE in performing the contract did not bring it within the Brooks Act. GSA intervened and endorsed the protestor's position against GPO.

GSBCA denied GPO's motion to dismiss for lack of jurisdiction, reasoning that it, like other tribunals, had power to determine its own jurisdiction. In the course of the protest, GSBCA stated, it would resolve the question of its jurisdiction over the particular contract by determining whether it *should have been* a Brooks Act contract. On appeal, however, the Federal Circuit reversed the GSBCA.

The court reasoned that GSBCA's jurisdiction is limited strictly to the matters entrusted to it, and the conveyed jurisdiction here pertains to procurement conducted under the Brooks Act. Such procurement was simply not involved here. The protestors argued that the statutory language means that GSBCA has jurisdiction in any instance where "the procurement *should have been* conducted under the Brooks Act," 792 F.2d at 1580 (emphasis added), i.e., it is not limited to instances where such procurement actually occurred. The court rejected that statutory interpretation, supporting its rejection not only with the literal language of the statute but, also, with the legislative history. It concluded:

> [A] necessary predicate to establishing protest jurisdiction in GSBCA under the Brooks Act is a procurement of automatic data processing equipment conducted or authorized by GSA under the Brooks Act. Since it is undisputed that GPO conducted this procurement without reference to the Brooks Act or GSA, and has received no delegation of procurement authority from GSA related to the subject procurement, we hold that GSBCA had no jurisdiction over the subject protest.

792 F.2d at 1572.

The court added that "[l]imiting the board's jurisdiction to protests challenging a procurement actually conducted under the authority of the Brooks Act is consistent with OMB's statutory responsibility for determining the *government's* position on the applicability of the Brooks Act." *Id.* at 1581 (emphasis in original). From its inception, stated the court, the Brooks Act has contemplated that OMB would resolve Brooks Act-related conflicts between GSA and affected agencies. *Id.*

The court also stated that, if Congress "sees the matter differently, Congress can change the way the statute is written." *Id.* at 1583. Interestingly, Congress has amended the statute, effective about five months after the opinion was written. Former subsection (h)(1), styled "Automated data processing dispute resolution," was redesignated (f)(1), and the following sentence added: "The authority of the board to conduct [a] review shall include the authority to determine whether any procurement is subject to this section . . . ." The amendment was cited in *Cyberchron Corp. v. United States*, 867 F.2d 1407, 1408 (Fed. Cir. 1989), where the court stated that the Board's authority to review ADPE procurement includes "'the authority to determine whether any procurement is subject to' the Act."

VII. APPEALS FROM THE COURT OF INTERNATIONAL TRADE AND THE INTERNATIONAL TRADE COMMISSION

Under 28 U.S.C. §§ 1295(a)(5) and (a)(6), respectively, the Federal Circuit has exclusive jurisdiction "of an appeal from a final decision of the United States Court of International Trade," and "to review the final determinations of the [ITC] relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930." The Federal

Circuit inherited that jurisdiction from its predecessor court, the Court of Customs and Patent Appeals.

A. *Appeals from the Court of International Trade*

1. *Jurisdiction*

The Court of International Trade had its origin in the 1890 Board of Appraisers, which was established in the Treasury Department to review determinations by customs officials on the classification and valuation of imported merchandise, and the rate of duty to be assessed.[43] That board in 1926 became the United States Customs Court, an article I court eventually integrated into the federal judicial system, and in 1956 became an article III court. Re, *supra* note 43, at XII. In 1980, the Customs Court Act changed the name of the Customs Court to the Court of International Trade, and it clarified and expanded jurisdiction of the Customs Court from both a substantive and remedial standpoint. *Id.*

The Court of International Trade is located in New York City but can sit elsewhere. *Id.* at XV. It has national jurisdiction and "all the powers in law and equity of, or as conferred by statute upon, a district court of the United States." 28 U.S.C. § 1585 (1988). The Federal Rules of Evidence generally apply to all civil actions in the court, and the rules of the court conform to the maximum extent possible to the Federal Rules of Civil Procedure. Re, *supra* note 43, at XVI. Also, the 1980 Act added a provision, 28 U.S.C. § 1876, pertaining to jury trials. *Id.* at XVI. That section, however, does not grant a right to a jury trial. *Washington Int'l Ins. Co. v. United States,* 863 F.2d 877, 878, 7 Fed. Cir. (T) 33 (1988), *cert. denied,* 490 U.S. 1106 (1989). Rather, it "is an enabling statute which simply 'sets forth the mechanisms for the court to conduct a jury trial.'" *Id.* A party in an action must show that Congress has, by statute, "affirmatively and unambiguously" granted that right for a particular action (which plaintiff failed to do in *Washington Int'l*). The first jury trial ever held in the court was involved in *United States v. Priority Prods., Inc.,* 793 F.2d 296, 298, 4 Fed. Cir. (T) 88, 90 (1986).

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[43] *See generally Litigation Before the Court of International Trade,* by the Honorable Edward D. Re, Chief Judge of the Court of International Trade, *printed in* 19 U.S.C.A. (§§ 1 to 1300) XI, XII (West Supp. 1990) (hereinafter Re).

The court's jurisdiction is articulated at 28 U.S.C.A. §§ 1581(a)-(i) and 1582-1584 (West Supp. 1990). It "encompasses civil actions arising from adverse agency actions pertaining to import transactions." Re, *supra* note 43, at XVI. It covers traditional grants of authority, given to the Customs Court under pre-1980 statutes, and new areas added in 1980. *Id.* at XVI. The traditional areas of jurisdiction include civil actions dealing with the classification and valuation of imported merchandise, charges or exactions within the jurisdiction of the Secretary of the Treasury, the exclusion of merchandise from entry under provisions of the customs laws, the liquidation of an entry,[44] the refusal to pay a claim for drawback,[45] and antidumping and countervailing duty issues. Re, *supra* note 43, at XVI. Newer areas of jurisdiction include actions to review determinations by the Secretary of Treasury denying, revoking, or suspending a customs broker's license, actions to review determinations regarding eligibility for trade assistance under the Trade Act of 1974, and a variety of civil actions commenced by the United States. *Id.* at XVI-XVII.

Included in its jurisdictional grant under section 1581 of title 28 is the residual jurisdiction stated in subsection (i):

> In addition to the jurisdiction conferred upon the Court of International Trade by subsections (a)-(h) of this section . . . the Court of International Trade shall have exclusive jurisdiction of any civil action commenced against the United States . . . that arises out of any law of the United States providing for—
>
> (1) revenue from imports or tonnage;
>
> (2) tariffs, duties, fees, or other taxes on the importation of merchandise for reasons other than the raising of revenue;
>
> (3) embargoes or other quantitative restrictions on the importation of merchandise for reasons other than the protection of the public health or safety; or

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[44] Upon entry into the country, merchandise is placed in the custody of the Customs Service (Department of Treasury) until the duties are computed or ascertained. The final determination of duties accruing on entry is called liquidation. *Id.* *See generally* 19 C.F.R. Part 159 (159.0 *et seq.*) (1990).

[45] "Drawback" is the refunding of duties paid upon goods previously imported into the United States, and used in the manufacture of articles which are then exported. *Id.* *See* section 313 of the Tariff Act of 1930, as amended, 19 U.S.C.A. § 1313 (a) (West Supp. 1990).

> (4) administration and enforcement with respect to the matters referred to in paragraphs (1)-(3) of this subsection and subsections (a)-(h) of this section.

28 U.S.C.A. § 1581(i) (West Supp. 1990). An interesting jurisdictional issue under that section came up in *Vivitar Corp. v. United States*, 761 F.2d 1552, 3 Fed. Cir. (T) 124 (1985), *cert. denied*, 474 U.S. 1055 (1986).

Vivitar concerned the importation of "grey market" goods, which can be explained this way:

> Goods are produced and legitimately sold abroad under a particular trademark and are imported into the United States and sold in competition with goods of the owner of U.S. trademark rights in the identical mark. But for international boundaries and the territoriality of trademark rights, the use of the trademark in competition with the U.S. owner would not constitute infringement because of the relationship between the foreign entity from whom the goods were directly or indirectly obtained and the owner of U.S. rights in the mark. In this sense, grey market goods are "genuine" and bear a "genuine" trademark.

Id. at 1555, 3 Fed. Cir. (T) at 124-25. Here, Vivitar was a California corporation which owned a trademark registration covering VIVITAR for certain kinds of photographic equipment. All of its manufacturing was done by foreign manufacturers, mostly in Japan. Vivitar had set up a worldwide marketing arrangement wherein it sold in the United States through independent authorized dealerships. Foreign subsidiary corporations sold abroad, and the mark was displayed on all equipment at Vivitar's direction. Foreign-made products nevertheless reached the United States via independent importers purchasing VIVITAR products abroad and selling them through discount outlets here (*e.g.*, intervenor 47th Street Photo).

Vivitar sued in the Court of International Trade for a declaratory judgment to invalidate a Customs Service regulation which, in Vivitar's view, improperly allowed importation of grey market goods contrary to the express provisions of section 526 of the Tariff Act of 1930, 19 U.S.C. § 1526. That section stated, in pertinent part:

> Except as provided in subsection (d) of this section, it shall be *unlawful to import* into the United States *any merchandise of foreign manufacture* if such merchandise, or the label, sign, print, package, wrapper, or receptacle, *bears a trademark owned by a citizen of, or by a corporation or association created or organized within, the United States, and registered in the Patent and Trademark Office by a person domiciled in the United States . . . unless written consent of the owner of such trademark is prcduced at the time of making entry.* [Emphasis added by *Vivitar* opinion.]

The customs regulation challenged by Vivitar, 19 C.F.R. § 133.21(b), provided generally that "[f]oreign made articles bearing a trademark identical with one owned and recorded by a citizen of the United States or a corporation or association created or organized within the United States are subject to seizure and forfeiture as prohibited importations." Vivitar had no problem with that aspect of the regulation, which paralleled the statute. But, the regulation furnished a "common control" exception to the ban, which permitted the entry of grey market goods made abroad by the trademark owner or its affiliate, and an "authorized use" exception for articles that bear a recorded trademark applied under authorization of the United States owner. 761 F.2d at 1557, 3 Fed. Cir. (T) at 128. Vivitar challenged those exceptions.

The Court of International Trade upheld the regulation as consistent with the statute. Before doing so, however, it confronted a threshold jurisdictional issue. The government had contended that, because 19 U.S.C. § 1526(a) relates to trademarks, section 1338(a) of title 28 (which grants jurisdiction to United States district courts over "any civil action arising under any Act of Congress relating to . . . trademarks") is controlling and gives jurisdiction to district courts. The government further contended that because the Court of International Trade possesses *exclusive* jurisdiction only, not concurrent jurisdiction with the federal district courts, it cannot possess jurisdiction over the present action.

The Court of International Trade rejected the government's argument. It relied first on section 1581(i)(4) in conjunction with section 1581(a). Section 1581(i)(4) provides jurisdiction over claims arising out of the administration and enforcement of the matters referred to in section 1581(a)-(h). Under section 1581(a), reasoned the court, it "has jurisdiction 'of any civil action commenced to contest the denial of a protest, in whole or in part, under section 515 [19 U.S.C. §§ 1514-1515] of the Tariff Act of 1930.'" *Id.* at 1558, 3 Fed. Cir. (T) at 129-30. Though the case did not involve a protestable exclusion of the goods in issue (because the disputed exceptions in the regulation do not exclude—they allow—importation), the court read section 1581(i)(4) broadly, as a "residual independent jurisdictional basis for litigating Customs Service administration and enforcement of the substantive matter that may be the subject of a protest, but where the protest remedy is inappropriate or unavailable." *Id.* at 1559, 3 Fed. Cir. (T) at 130. Alternatively, it ruled that because 19 U.S.C. § 1526 provided for excluding certain goods, jurisdiction could be found in section 1526(i)(3) as an "embargo" or "quantitative restriction on the importation of merchandise." *Id.*

The Federal Circuit affirmed the Court of International Trade, both on the jurisdictional issue and on the merits. (In the latter respect, though, it upheld the regulation "on narrower grounds." *Id.* at 1570-71, 3 Fed. Cir. (T) at 145-46.)

The same jurisdictional issue, however, arose in *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176 (1988), in which the Supreme Court implicitly overruled *Vivitar* on the jurisdictional issue. The challenge there was made in *district court* (by another party), and the Supreme Court held that jurisdiction was appropriate. The Court rejected both of the grounds relied on by the Court of International Trade in *Vivitar* as exceptions to district court jurisdiction provided generally by section 1331 and specifically by section 1338. Regarding the view that section 1581(i)(4) in conjunction with section 1581(a) provides jurisdiction to the Court of International Trade, the Supreme Court viewed the "protest" referred to in subsection (a) as involving the *exclusion* of merchandise from entry, whereas the present action challenges a Customs Service decision to *permit* the entry of something. The Court also rejected the theory that 19 U.S.C. § 1526 imposes an "embarg[o]" within the meaning of 28 U.S.C. § 1581(i)(3). The Court perceived the "embargo" of the latter section as something reflecting a *governmental* restriction on the quantity of a particular product that will enter (for purposes of safety, morality, trade, etc.), but that the restriction here is merely a mechanism by which a private party might, at its own option, enlist the government's aid in restricting the quantity of imports in order to enforce a private right.[46]

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[46] Thus, the Court upheld the district court's jurisdiction and restored the action before it to the Supreme Court calendar for argument on the merits. In the subsequent merits decision, it held that the common-control exception of the Customs Service regulation is consistent with 19 U.S.C. § 1526 but that the "authorized use" exception is inconsistent with it. 486 U.S. 281, 294 (1988).

2. *Standard of Review*

Fact findings of the Court of International Trade are reviewed under a clearly erroneous standard, whereas questions of law are reviewed for error. *See, e.g.*. *Superior Wire v. United States*, 867 F.2d 1409, 7 Fed. Cir. (T) 43 (1989). When the Court of International Trade reviews an agency (*e.g.*, ITC) finding of fact under a substantial evidence standard, the Federal Circuit on review must decide whether the Court of International Trade was correct in determining whether substantial evidence supports the agency finding. In essence, therefore, the focus on review at the Federal Circuit is on the agency finding of fact to see if it is supported by substantial evidence. *See, e.g.*, *American Permac, Inc. v. United States*, 831 F.2d 269, 273, 6 Fed. Cir. (T) 6, 10 (1987), *cert. dismissed*, 485 U.S. 901 (1988); *Atlantic Sugar, Ltd. v. United States*, 744 F.2d 1556, 1559, 2 Fed. Cir. (T) 130, 132 (1984).

3. *Typical Cases Appealed to the Federal Circuit*

The most frequent types of cases appealed to the Federal Circuit involve (1) classification or valuation of goods and (2) antidumping or countervailing duties.

a. *Classification and Valuation Cases*

Classification typically starts at the port of entry, where an import specialist determines the classification pursuant to the tariff schedules. Re, *supra* note 43, at XVII. (From 1963-1988, those schedules were known as the Tariff Schedules of the United States (TSUS) but, effective 1989 pursuant to the Omnibus Trade and Competitiveness Act of 1988, the TSUS have been replaced by the Harmonized Tariff Schedule of the United States (HTS). House Committee on Ways and Means, Overview and Compilation of U.S. Trade Statutes at 1 (1989 ed.).) An importer might believe that the classification is at too high a rate but, before commencing an action, the importer exhausts administrative remedies and pays all liquidated duties. Re, *supra* note 43; *id.* at XIX.

The party challenging a classification decision—usually the importer—bears the burden of proof. Section 2639(a)(1) of title 28 provides that "the decision of the Secretary of the Treasury . . . is presumed to be correct. The burden of proving otherwise shall rest upon the party challenging such decision." 28 U.S.C.A. § 2639(a)(1) (West Supp. 1990). Prior to the 1980 Act, the importer had a dual burden—namely, to prove that the decision of the Customs Service was erroneous and that the claimed classification was correct. The Federal Circuit has made clear, however, that after the 1980 Act there is no "dual burden." *Jarvis Clark Co. v. United States*, 733 F.2d 873, 876-78, 2 Fed. Cir. (T) 70, 72-75, *reh'g denied*, 739 F.2d 628, 2 Fed. Cir (T) 97 (1984). Under present law, once the importer proves that the government classification is incorrect, the trial court must find the correct result "by whatever procedure is best suited to the case at hand." 733 F.2d at 878, 2 Fed. Cir. (T) at 75. If the court cannot reach a conclusion on proper classification, it may remand the case for further administrative proceedings or conduct a retrial or rehearing so that the parties may introduce additional evidence. 733 F.2d at 877-78, 2 Fed. Cir. (T) at 74-75.

Determining proper classification has frequently involved: (1) the meaning of a term in the TSUS; (2) whether imported merchandise fits within the meaning of that term; and (3) generally, where an imported article should be classified within the TSUS. The first question is one of law, *Stewart-Warner Corp. v. United States*, 748 F.2d 663, 664-65, 3 Fed. Cir. (T) 20, 22 (1984); the second is one of fact, *id.*; and the third is one of law, *Amersham Corp. v. United States*, 728 F.2d 1453, 1454-55, 2 Fed. Cir. (T) 33, 33-34 (1984).

An illustrative classification case is *Channel Master, Div. of Avnet, Inc. v. United States*, 856 F.2d 177, 6 Fed. Cir. (T) 175 (1988). It concerned solid state scanners that were exported without crystals needed to make them work. The crystals were inserted into the scanners, after importation, by removing the back panel of the scanner and placing the crystals in an empty space designed for their receipt. Channel Master (CM) asserted that, because its scanners as imported lacked crystals, they should have been classified under the TSUS as "parts of radio receivers" or "other radio broadcasting reception apparatus," dutiable at six percent of their value. The Court of International Trade, however, upheld the customs classification of the scanners as "other solid state (tubeless) radio receivers," dutiable at a rate of 10.4 percent of their value.

The Federal Circuit affirmed, holding that "the test to be applied is not solely whether an omitted part is 'essential,' but whether [CM's] assembled pieces result in a 'substantially complete' article." The relative significance of the omitted part, stated the court, is not the only factor to consider. Considering all the facts of the case, the court concluded that CM's scanners "were properly classified and properly charged at the higher rate." 856 F.2d at 180, 6 Fed. Cir. (T) at 178.

Somewhat different than the question of where an item is classified, is the "valuation" issue, which involves the correct valuation (or appraisement) of the goods. Re, *supra* note 43, at XXIII. Thus,

> Customs duties are imposed on an *ad valorem*, specific, or combination basis. *Ad valorem* duties are assessed on the value of the imported merchandise. Hence, a fifteen per centum *ad valorem* duty is equal to fifteen percent of the value of the merchandise. A specific duty is imposed on a unit or quantity of merchandise, such as ten cents per pound, four cents per linear foot, or thirty-two cents each. A combination duty has both *ad valorem* and specific features, *e.g.*, 12.5 cents per gross plus ten per centum *ad valorem*.

Id. Dutiable value is determined in accordance with the statutory standards set forth in the Tariff Act of 1930, 19 U.S.C.A. § 1401a (West Supp. 1990). *Id.* at XXIV. "Several formulae are enumerated [therein], and are to be applied in the order described. 'Transaction value' is the most frequently employed basis of valuation." *Id.* Determining transactional value under the statute "is relatively simple: subject to specifically enumerated additions and exclusions, an appraisal for duty purposes is based on the price paid for the merchandise to or for the benefit of the seller." *Moss Mfg. Co. v. United States*, 896 F.2d 535, 539, 8 Fed. Cir. (T) ___, ___ (1990).

A procedural aspect of classification or valuation was discussed in *Goldhofer Fahrzeugwerk GmbH & Co. v. United States*, 885 F.2d 858, 7 Fed. Cir. (T) 148 (Fed. Cir. 1989), *cert. denied*, 110 S. Ct. 1946 (1990). Goldhofer, a West German corporation, was the importer of certain "gooseneck" semitrailers covered by Entry No. 101757 on February 16, 1980, at the port of Norfolk, Virginia. Due to an error by a customs employee, Customs never sent a courtesy notice of liquidation and a bill for duty increase to Goldhofer. Subsequently, Customs generated a REBILL dated September 4, 1981 (the 91st day after the original notice of liquidation), which was sent to Goldhofer. Goldhofer filed a protest at the port of Norfolk, which was received by Customs 179 days after the original bulletin notice was posted but on the 89th day after the date of REBILL. Customs denied the protest as untimely because it was not filed within the ninety-day period prescribed by 19 U.S.C. § 1514(c)(2) (1982).

Goldhofer sued in the Court of International Trade, contesting the denial of its protest. It argued that failure to give courtesy notice of liquidation violates both Custom's own regulations and constitutional requirements for due process, and as a result, liquidation was incomplete and Goldhofer's protest was timely filed within ninety days of the REBILL. The court rejected those arguments, and the Federal Circuit affirmed.

The statute (19 U.S.C. § 1500), reasoned the Federal Circuit, requires "notice of such liquidation to the importer, his consignee, or agent in such form and manner as the Secretary shall prescribe in . . . regulations [prescribed by the Secretary]." 885 F.2d at 860, 7 Fed. Cir. (T) at 150. The regulations are "clear that the only notice of liquidation required is bulletin notice 'posted for the information of importers in a conspicuous place in the customhouse at the port of entry.'" *Id.* "Courtesy notice," stated the court, "is just that, a 'courtesy,' and Custom's providing, or failure to provide, such a notice cannot create any legally cognizable right in the importer." *Id.*

Nor did failure to mail a courtesy copy violate due process, reasoned the Federal Circuit. 885 F.2d at 860-63, 7 Fed. Cir. (T) at 151-53. A fundamental concept of due process is "'notice reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections.' [Citation omitted.]" 885 F.2d at 861, 7 Fed. Cir. (T) at 151. Notice by mail or other means "as certain to ensure actual notice" is a "minimum constitutional precondition to a proceeding which will adversely affect the liberty or property interests of *any* party." *Id.* (emphasis in original). The critical question, therefore, was whether the posted notice here was "'as certain to ensure actual notice,' [citation omitted]" a test for which the Supreme Court "has looked to a number of considerations" (*e.g.*, reliability of the form of notice). *Id.* Under the facts here, the court answered that question in the affirmative and held that "mail notice was not constitutionally required." 885 F.2d at 863, 7 Fed. Cir. (T) at 153.

b. *Antidumping and Countervailing Duty Cases*

The statutory provision for the imposition of antidumping duties (ADDs), found in section 1673 of title 19, states:

> If—
>
> (1) the administering authority [the Department of Commerce] determines that a class or kind of foreign merchandise is being, or is likely to be, sold in the United States at less than its fair value, and
>
> (2) the [International Trade] Commission determines that—
>
> (A) an industry in the United States—
>
> (i) is materially injured, or
>
> (ii) is threatened with material injury, or
>
> (B) the establishment of an industry in the United States is materially retarded,
>
> by reason of imports of that merchandise or by reason of sales (or the likelihood of sales) of that merchandise for importation,
>
> then there shall be imposed upon such merchandise an antidumping duty, in addition to any other duty imposed, in an amount equal to the amount by which the foreign market value exceeds the United States price for the merchandise.

19 U.S.C.A. § 1673 (West Supp. 1990).

For countervailing duties (CVDs), pertinent statutory language is found in title 19, section 1671:

> (a) General rule
>
> If—
>
> (1) the administering authority [Department of Commerce] determines that—
>
> (A) a country under the Agreement, or
>
> (B) a person who is a citizen or national of such a country, or a corporation, association, or other organization organized in such a country,
>
> is providing, directly or indirectly, a subsidy with respect to the manufacture, production, or exportation of a class or kind of merchandise imported, or sold (or likely to be sold) for importation, into the United States, and
>
> (2) the [International Trade] Commission . . . [makes the same kind of injury determination as required for ADDs under § 1673(2)(A)-(B), *supra*]. . . .
>
> then there shall be imposed upon such merchandise a countervailing duty, in addition to any other duty imposed, equal to the amount of the net subsidy.

19 U.S.C.A. § 1671(a) (West Supp. 1990).

Unlike with ADDs, an injury determination is not always involved in a CVD proceeding. Section 1671 of title 19 applies to "a country under the Agreement," which is defined in 19 U.S.C.A. § 1671(b) (West Supp. 1990). Some countries do not fall within that definition, *e.g.*, nonsignatory countries to the Subsidies Code of the General Agreement on Tariffs and Trade (GATT) (i.e., articles VI, XVI, and XVIII of the GATT) or those not providing reciprocal benefits to the United States. For them, section 303 of the Trade Act of 1930, as amended, 19 U.S.C.A. § 1303 (West Supp. 1990), provides for CVDs, but without an injury requirement in most instances.[47]

An overview of the procedure involved in ADD proceedings (at least in 1986) was provided in *American Lamb Co. v. United States*, 785 F.2d 994, 4 Fed. Cir. (T) 47 (1986). Normally, stated the court, proceedings are initiated when a petition is filed by an interested party on the same day with the ITC and Commerce (specifically, the International Trade Administration (ITA)). 785 F.2d at 998, 4 Fed. Cir. (T) at 50. Then, these five stages may typically follow (citations and footnotes omitted):

> (1) The ITA decides within twenty days of receiving a petition whether to initiate an investigation. An investigation will be initiated if the petition alleges the necessary elements for imposition of a duty and is accompanied by information "reasonably available to the petitioner supporting the allegations." ITA's self-initiated investigations are based on "information available to it." If ITA finds a petition insufficient an investigation is not initiated, and any investigation initiated by ITC is terminated.
>
> (2) If ITA has not found the petition insufficient, ITC must preliminarily determine within 45 days of the filing of the petition "whether there is a reasonable indication" that a domestic industry is being materially injured or threatened with material injury. ITC bases its preliminary determination on questionnaires sent to importers and domestic interests, public conferences, post conference briefs, and exhibits. If that determination should be in the negative, ITC terminates the investigation.

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[47] *See generally* Barshefsky, *Amendments to the Antidumping and Countervailing Duties Laws Under the Omnibus Trade and Competitiveness Act of 1988*, 13 N.C. J. Int'l L. & Com. Reg. 251, 256 n.20, and accompanying text (1988); T. Vakeries, *Antidumping, Countervailing Duty, and Other Trade Actions*, § 3.4(a) at 239-40 (1987); Horlick, *Summary of Procedures Under the United States Antidumping and Countervailing Duty Laws*, 58 St. John's L. Rev. 828, 830 n.10 (1988). In *American Lamb*, for example, the Court of International Trade dismissed as moot a negative preliminary injury determination against New Zealand in a CVD investigation because the U.S. Trade Representative had terminated New Zealand as a country under the GATT Subsidies Code, and hence, New Zealand was no longer entitled to an injury test in the CVD investigation. 785 F.2d at 997, 4 Fed. Cir. (T) at 49.

> (3) If ITC finds a reasonable indication of injury, ITA must preliminarily determine, within 160 days of the petition filing date (subject to extension of up to 210 days), whether there is a "reasonable basis to believe or suspect" that the merchandise is being sold, or is likely to be sold, at LTFV [less than fair value]. An affirmative preliminary LTFV determination results in suspension of liquidation of duties and in posting of bonds for the merchandise. A negative preliminary determination prevents imposition of those provisional remedies but does not terminate the investigation.
>
> (4) Within 75 days of its preliminary determination (subject to extension of up to 135 days), ITA makes a final determination respecting the sale of merchandise at LTFV. If that final determination is in the negative, the investigation is terminated.
>
> (5) If ITA's final LTFV determination is in the affirmative, ITC makes its final determination of material injury. That determination is based on technical and economic testimony given at a trial-like hearing. If ITC finally determines that no injury exists, the investigation is terminated. If ITC determines that injury exists, ITA issues an antidumping duty order.

785 F.2d at 998-99, 4 Fed. Cir. (T) at 50-51.

Interlocutory administrative actions subject to judicial review at the Court of International Trade include decisions not to initiate an investigation, refusals to review a determination based upon changed circumstances, and preliminary negative determinations as to whether there is a reasonable indication of material injury, threat of material injury, or material retardation. Re, *supra* note 43, at XXVII-XXVIII. 19 U.S.C.A. § 1516a(a)(1) (West Supp. 1990). Final determinations subject to review by the Court of International Trade include: final affirmative determinations, including any negative part; final negative determinations; final determinations of the periodic review; suspensions of a countervailing duty or antidumping duty investigation; injurious effect determinations by the ITC; and determinations as to whether a particular type of merchandise is within the class or kind of merchandise described in an existing finding of dumping or antidumping or countervailing duty order. Re, *supra* note 43, at XXVIII. 19 U.S.C.A. § 1516a(a)(2)B(i)-(vi) (West Supp. 1990).

Of course, reviewability of a decision by the Court of International Trade does not mean reviewability by the Federal Circuit. Only "final" decisions of the former are reviewable by the latter. Consider, for example, *Cabot Corp. v. United States*, 788 F.2d 1539, 4 Fed. Cir. (T) 80 (1986).

In 1982, the ITA initiated a CVD investigation of carbon black imports from Mexico as a result of a petition filed by Cabot Corporation (Cabot), a domestic producer of carbon black. The ITA issued a final determination, finding that some but not all Mexican government programs conferred bounties or grants to Mexican producers.

Cabot challenged four of the ITA determinations in an action brought at the Court of International Trade. The court reversed some of those determinations and remanded for their reconsideration. The government appealed but Cabot moved to dismiss the appeal as premature because the order required further action by the agency prior to final action by the court. The Federal Circuit granted the motion. Final judgments, reasoned the Federal Circuit, require "that 'a party must ordinarily raise all claims of error in a single appeal following final judgment on the merits.'" *Id.* at 1542, 4 Fed. Cir. (T) at 82. "A corollary rule is that an order remanding a matter to an administrative agency for further findings and proceedings is not final." *Id.* The Federal Circuit dismissed the appeal, after holding inapplicable certain recognized exceptions to the finality rule.

Cabot involved interpreting the word "final" appearing in 28 U.S.C. § 1295(a)(5). In that respect, it is illustrative of statutory interpretation, which appears frequently in trade cases because that is an area laden with statutes. Indeed, Congress has passed "approximately 'two hundred statutes' pertaining to the administration and enforcement of the customs and international trade laws of the United States." Re, *supra* note 43, at XII.

American Lamb Co. v. United States, 785 F.2d 994, 4 Fed. Cir. (T) 47 (1986), for example, involved statutory interpretation of language in 19 U.S.C. § 1673b(a) that an affirmative preliminary determination of injury in an ADD proceeding requires a "reasonable indication" of injury. In assessing whether there was such a "reasonable indication," the ITC thought it appropriate to weigh all the evidence. The Court of International Trade, however, rejected that; it concluded that the ITC approach was all right for a final determination of injury but—in the preliminary stage—the ITC should determine if there are "*any facts which raised the possibility of injury.*" 785 F.2d at 999, 4 Fed. Cir. (T) at 52 (emphasis in original).

The Federal Circuit reversed the Court of International Trade. It noted that a reviewing court must accord "substantial weight to an agency's [*e.g.*, the ITC's] interpretation of a statute it administers." 785 F.2d at 1001, 4 Fed. Cir. (T) at 54. "Though a court may reject an agency interpretation that contravenes clearly discernible legislative intent, its role when that intent is not contravened is to determine whether the agency's interpretation is 'sufficiently reasonable.'" *Id.* Applying those guidelines, the Federal Circuit "reject[ed] the court's imposition of the mere possibility standard." *Id.* at 1001, 4 Fed. Cir. (T) at 55. Moreover, it was "unable to join the court in its view that the statutory phrase 'reasonable indication' means the same as a mere 'possibility,' or that it suggests 'only the basest clues or signs needed to justify further inquiry.'" 785 F.2d at 1001, 4 Fed. Cir. (T) at 55-56. Both the statutory language itself, reasoned the Federal Circuit, which is "the best source of congressional intent," and the legislative history supported its view. 785 F.2d at 1002, 4 Fed. Cir. (T) at 56.

In support of its holding, *American Lamb* referred to the statutory requirement in 28 U.S.C. § 1673b(a) that the ITC use the "best information available" in assessing "reasonable indication" of injury in a preliminary investigation. *Id.* A different "best information" phrase was the focus of statutory interpretation in *Atlantic Sugar, Ltd. v. United States*, 744 F.2d 1556, 2 Fed. Cir. (T) 130 (1984).

Atlantic Sugar arose out of a petition filed in 1979 by a United States sugar producer alleging injury by reason of "dumped" imports. An ADD investigation commenced, resulting in a final injury determination and an ADD order. In reaching its determination, the ITC focused on injury to a regional, as opposed to nationwide, sugar industry in the Northeast/Great Lakes area. During the final injury investigation step, the "ITC staff endeavored to collect the extensive data necessary to determine whether a northeastern states' sugar industry existed which satisfied the . . . strict statutory definition [of appropriate regions in 19 U.S.C. § 1677(4)(c)], and, if so, what should be the scope of the region." *Id.* at 1558, 2 Fed. Cir. (T) at 131. That involved, *inter alia*, mailing questionnaires to the seven sugar producers in the suspected region, including the second largest, Revere. Revere provided information for three plants—Brooklyn, Boston, and Chicago. Ultimately, however, the northeastern region defined by the ITC excluded the Chicago area. When asked to separate the data, so that the ITC could exclude the Chicago data from Revere's aggregate, Revere responded that such information "was not readily available" and that the Chicago operation constituted only a minor portion of the data.

The ITC used all of Revere's data, even though it included Chicago. The Court of International Trade held that inclusion to be contrary to law and to cause the ITC's final injury determination to be unsupported by substantial evidence, resulting in that court vacating the ADD order. The Federal Circuit reversed.

The key issue involved whether the aggregate Revere data was the "best information otherwise available," within the meaning of that phrase in 28 U.S.C. § 1677e(b):[49]

> [T]he Commission shall, whenever a party or any other person refuses or is unable to produce information requested in a timely manner and in the form required, or otherwise significantly impedes an investigation, use the best information otherwise available.

The Federal Circuit, as it typically does, looked to the statute to see what Congress intended. "We note the use of the mandatory term 'shall' [in section 1677e(b)], indicating that the ITC *must* use the best information otherwise available in the enumerated circumstances." 744 F.2d at 1560, 2 Fed. Cir. (T) at 133. (Emphasis in original.) The need for such use "is [also] reflected in the legislative history." *Id.* The Federal Circuit also considered relevant the context of the "best information" rule:

> [I]t is set within the extremely short statutory deadlines which the Congress built into the new antidumping law [footnote omitted] and the resultant lack of time which the ITC has to wield its little-used subpoena power. [Footnote omitted.] Thus cooperation by the parties to the investigation is essential, as well as diligence by the ITC staff, to gather the data needed for an accurate determination. Noncooperation by parties or other persons may, in the absence of ITC time to pursue judicial compliance, be penalized, at least in the eyes of those parties or persons, by the ITC's mandatory use of whatever other best information it may have available. In short, one may view the best information rule, as the ITC urges, as an investigative tool, which that agency may wield as an informal club over recalcitrant parties or persons whose failure to cooperate may work against their best interest. One may as well view the rule, in light of the legislative history cited, as a club over the *ITC's* head, which Congress has brandished to force that agency to arrive at *some*

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[49] The provision now appears in subsection (c) rather than (b), 19 U.S.C.A. § 1677e(c) (West Supp. 1990).

> determination within the time allotted. "Impossible" is a word which Congress does not want to hear in these complex cases.

744 F.2d at 1560, 2 Fed. Cir. (T) at 133-34. (Emphasis in original.)

A different aspect of information retrieval was the subject of statutory interpretation in *Al Tech Specialty Steel Corp. v. United States*, 745 F.2d 632, 3 Fed. Cir. (T) 1 (1984). The dispute arose during the second administrative review of an ADD order pertaining to stainless steel rods. The review was under section 751(a) of the Tariff Act of 1930 (as amended by the Trade Agreement Act of 1979), 19 U.S.C. § 1675 (1988).[49] The appellees, domestic manufacturers of stainless steel wire rods, contended that the ITA was required under 19 U.S.C. § 1671e(a) to verify the information supplied to it during the review by a foreign manufacturer and a domestic importer who, according to the counsel for those two, were available for verification. The ITA disagreed, stating that verification in section 751 reviews is discretionary. On appeal, the Court of International Trade held that the ITA is *required* by section 1677e(a) to verify information upon which assessment of ADDs is based. The case was appealed to the Federal Circuit.

The statutory section at issue, reasoned the Federal Circuit, "states (with an exception not relevant here) that 'the administering authority shall verify all information relied upon in making a final determination in an investigation.'" 745 F.2d at 634, 3 Fed. Cir. (T) at 3. The government argued that "investigation" covers only the portion of the proceeding resulting in a determination that dumping has actually occurred, i.e., the so-called investigative phase. It maintained that the assessment or periodic review phase involves neither a "final determination" nor "investigation" and, hence, was not covered by the verification requirement. The Federal Circuit rejected that, and affirmed the Court of International Trade:

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[49] Subsection (a)(1) of § 1675 states that "[a]t least once during each 12-month period beginning on the anniversary of the date of publication of a countervailing duty order under this subtitle or under section 1303 of this title, an antidumping duty order under this subtitle or a finding under the Antidumping Act, of 1921, or a notice of the suspension of an investigation, the administering authority, if a request for such a review has been received and after publication of notice of such review in the Federal Register, shall—(A) review and determine the amount of any net subsidy, (B) review, and determine (in accordance with paragraph (2)), the amount of any antidumping duty, and (C) review the current status of, and compliance with, any agreement by reason of which an investigation was suspended, and review the amount of any net subsidy or margin of sales at less than fair value involved in the agreement. . . ." 19 U.S.C.A. § 1675(a)(1) (West Supp. 1990).

> "Although an agency's interpretation of the statute under which it operates is entitled to some deference, 'this deference is constrained by our obligation to honor the clear meaning of a statute, as revealed by its language, purpose, and history'". [Citations omitted.] . . . Regardless of Commerce's construction of its regulations to the contrary in this respect, under the language of the statute, the legislative history, and the Congressional purpose, a section 751 review results in "a final determination in an investigation." Thus, the provisions of section 1677e(a), *supra,* apply to all information relied upon in making a final periodic review determination.

745 F.2d at 642, 3 Fed. Cir. (T) at 13.[50]

B. *Appeals From the ITC Under 19 U.S.C. § 1337*

1. *Violations—Types of Proscribed Activities*

The Federal Circuit has exclusive jurisdiction to hear appeals from final decisions of the ITC in cases brought under section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (1988). Subsection (A) of section 1337(a)(1) proscribes:

> Unfair methods of competition and unfair acts in the importation of articles (other than articles provided for in subparagraphs (B), (C), and (D)) into the United States, or in the sale of such articles by the owner, importer, or consignee, the threat or effect of which is—
>
> (i) to destroy or substantially injure an industry in the United States;
>
> (ii) to prevent the establishment of such an industry; or
>
> (iii) to restrain or monopolize trade and commerce in the United States.

Subparagraphs (B), (C), and (D) of section 1337(a)(1), specifically proscribe such importation and sale of: under (B), articles that "(i) infringe a valid and enforceable United States patent or a valid and enforceable United States copyright registered under title 17; or (ii) are made, produced, processed, or mined under, or by means of, a process covered by the claims of a valid and enforceable United States patent"; under (C), articles that "infringe a valid and enforceable United States trademark registered under the Trademark Act of 1946"; or under (D), "a semiconductor chip product in a manner that constitutes infringement of a mask work registered under chapter 9 of title 17."[51]

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[50] Interestingly, 19 U.S.C. § 1677e was amended, effective Oct. 30, 1984. Old § 1677e(a) became present § 1677e(b), and was amended to make clear not only that the "administering authority" is to verify all information relied on in making (1) "a final determination in an investigation," but also, in making (2) a revocation of an ADD or CVD order under § 1675(c) and in making (3) "a review and determination under section 1675(a) of this title [i.e., a periodic review of amount of duty] if (A) verification is timely requested by an interested party . . . and (B) no verification was made under this paragraph during the two immediately preceding reviews and determinations under that section of the same order, finding, or notice, except that this clause shall not apply if good cause for verification is shown." 19 U.S.C.A. § 1677e(b) (West Supp. 1990).

Prior to the Omnibus Trade and Competitiveness Act of 1988, Pub. L. No. 100-418, 102 Stat. 1107 (1988) (Omnibus Act), the specific activities articulated in subparagraphs (B)-(D) of section 1337(a)(1) were not stated as such. Instead, the statute resembled the language of present subparagraph (A), i.e., "unfair methods . . . and unfair acts," and all proscribed activities had to be covered by that language. Over the years, the phrase reflected a variety of illegal conduct including, *inter alia*: (1) intellectual property, *e.g.*, patent, copyright, and trademark infringement; (2) unfair trade practices (*e.g.*, false designation of origin, unfair advertising); and (3) acts in restraint of trade.[52] The latter included price fixing and predatory pricing, but was not used often. Nance, *supra* note 52, at 494, 505. The most common type of case in the first category (at least at the Federal Circuit in the past eight years) has involved "patent infringement," of two types: (1) product patent infringement, i.e., importation of a patented article and (2) process patent infringement, i.e., importation of a nonpatented product made abroad by a patented process.

Traditionally, the latter type of activity was technically not infringement, because the process was not performed in the United States.[53]

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[51] A "mask work" is defined in chapter 9, which was added to the Copyright Act, title 17, by Pub. L. No. 98-620, the "Semiconductor Chip Protection Act of 1984." 17 U.S.C. §§ 901-914 (1988).

[52] *See generally* Victor, *Section 337 of the Tariff Act of 1930: A Proven Tool in the Protection of Intellectual Property*, 2 J. of Proprietary Rts. 10, 11 (1990) (hereinafter Victor); Nance, *Relief From Unfair Import Practices Under Section 337 of the Tariff Act of 1930: An Overview*, 13 N.C. J. Int'l L. & Com. Reg. 493, 506 (1988) (hereinafter Nance).

[53] Subsection (a) of 35 U.S.C. § 271 states that "whoever without authority makes, uses or sells any patented invention, *within the United States* during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a) (1982) (emphasis added). However, the Omnibus Act expanded the patent grant to include, for process patents, a "right to exclude others from using or selling throughout the United States, or importing into the United States, products

However, it was covered by section 1337 in conjunction with section 1337a, the latter of which stated that a product "made, produced, processed or mined under or by means of a process covered by the claim of any unexpired valid United States letters patent shall have the same status under section 1337 as a product that is directly covered by a patent." Section 1337a was repealed by the Omnibus Act, but it was replaced by similar language in new section 1337(a)(1)(B)(ii). Both the old and new sections were involved in *Amgen, Inc. v. United States*, 902 F.2d 1532, 14 USPQ2d 1734, 8 Fed. Cir. (T) ___ (1990).

On January 4, 1988, Amgen filed a complaint with the ITC that Chugai Pharmaceutical Company of Japan and its United States subsidiary had violated sections 1337 and 1337a by importing recombinant erythroproetin (rEPO) made by a process covered by its patent. The patent had claims directed to recombinant DNA sequences, vectors, and host cells used to produce rEPO, but no claims to the product itself or to any process of making rEPO (or any other process). After the Omnibus Act passed, new section 1337(a)(1)(B)(ii) replaced section 1337a and became applicable to the case. 902 F.2d at 1534, 14 USPQ2d at 1736.

The Commission dismissed the complaint for lack of jurisdiction because, in its view, there were no process claims in the patent, and the presence of such claims is a jurisdictional prerequisite to old section 1337a and new section 1337(a)(B)(ii). The Federal Circuit disagreed with the Commission that the issue was jurisdictional, instead treating it as a "merits" determination. The court then expressly rejected Amgen's argument that, because the challenged foreign process requires the use of Amgen's patented DNA sequence, vectors, and host cells, the process is "covered by" Amgen's patented product claims. The Federal Circuit held that "section 337(a)(1)(B)(ii) was [not] intended to prohibit the importation of articles made abroad by a [nonpatented] process in which a *product* claimed in a U.S. patent is

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made by that process." 35 U.S.C.A. § 154 (West Supp. 1990). The Omnibus Act also added subsection (g) to 35 U.S.C. § 271, making "liable as an infringer" whoever "without authority imports into the United States or sells or uses within the United States a product which is made by a process patented in the United States." *Id.* at § 271(g).

used, namely the new host cell." 902 F.2d at 1538, 14 USPQ2d at 1729 (emphasis in original).

2. *Violations—"Injury" and "Industry" Requirements*

Before the Omnibus Act took effect, no activity could be deemed illegal under section 1337(a) unless it had an "injurious" effect. The Omnibus Act eliminated the injury requirement for the intellectual property related conduct of new subparagraphs (B)-(D) of section 1337(a)(1), but the requirement remains in effect for new subparagraph (A). In the latter respect, the wording of the injury requirement of new subparagraph (A) is very similar to the wording of old section 1337(a).[54] Hence, Federal Circuit (and CCPA) precedent on injury may still be useful, although much of what was said by the Federal Circuit in that respect was said in the intellectual property context.

The Federal Circuit had acknowledged that "proof of injury [was] less in the context of patent, trademark, or copyright infringement . . . than in other types of unfair trade practices, because the holder of the former type of rights is entitled to exclude competitors entirely from using the intellectual property covered by those rights." *Textron, Inc. v. United States Int'l Trade Comm'n*, 753 F.2d 1019, 1029, 224 USPQ 625, 632, 3 Fed. Cir. (T) 72, 83 (1985). Indeed, the court stated in *Bally/Midway Mfg. Co. v. United States Int'l Trade Comm'n*, 714 F.2d 1117, 129 USPQ 97, 1 Fed. Cir. (T) 119 (1983), that even a relatively small amount of sales in intellectual property cases might constitute the necessary injury. However, the court has steadfastly required distinct proof not only that there was injury, but also that the injury was substantial. *See, e.g., Corning Glass Works v. United States Int'l Trade Comm'n*, 799 F.2d 1559, 1567, 230 USPQ 822, 827, 4 Fed. Cir. (T) 118, 125 (1986); *Textron*, 753 F.2d at 1028, 224 USPQ at 631, 3 Fed. Cir. (T) at 82. Rather than adopt "some arbitrary market-share benchmark as a prerequisite to a finding of a § 337 violation," the court preferred to ascertain "injury" on the facts of each case. *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1487, 1 USPQ2d 1241, 1251, 5 Fed. Cir. (T) 52, 68 (1986), *cert. denied*, 482 U.S. 909 (1987).

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[54] However, it is not identical. The phrase "the effect or tendency of which is [*e.g.*, to cause injury]" in old § 1337 has been replaced in § 1337(a)(1)(A) with "the threat or effect of which is [*e.g.*, to cause injury]." Thus, the "tendency" language has been eliminated.

Separate from "injury" was, and still is, the "industry" requirement. Under old section 1337(a), the effect or tendency of the unfair method or act had to be "to destroy or substantially injure *an industry,* efficiently and economically operated, in the United States, or to prevent the establishment of such an *industry,* or to restrain or monopolize trade and commerce in the United States." (Emphasis added.) The present section retains the above reference to "industry" (although it deletes "efficiently and economically operated") in section 1337(a)(1)(A)(i)-(ii) and specifically requires for section 1337(a)(1)(B)-(D) violations that they "apply only if an industry in the United States, relating to the articles protected by the patent, copyright, trademark, or masked work concerned, exists or is in the process of being established." For the latter violations, section 1337(a)(3) states that "industry" exists if one of three articulated circumstances apply. No similar criteria for "industry" was listed in old section 1337(a)(1).

Schaper Mfg. Co. v. United States Int'l Trade Comm'n, 717 F.2d 1368, 219 USPQ 665, 1 Fed. Cir. (T) 157 (1983), for example, involved alleged patent infringement and false designation of origin by Schaper, who was a toy producer and the exclusive licensee under the patent in question, regarding toy vehicles. Despite Schaper's involvement, in the United States, in designing the toys and the machinery to make them (and the fact that Schaper owned the foreign machinery), the Commission issued a final determination of "no violation" because, "given the particular facts of this case, complainants do not constitute 'an industry . . . in the United States' within the meaning of that phrase as used in § [1]337." 717 F.2d at 1369, 219 USPQ at 666, 1 Fed. Cir. (T) at 158.

The critical fact working against Schaper was that the toys were manufactured abroad. 717 F.2d at 1370, 219 USPQ at 667, 1 Fed. Cir. (T) at 159-60. The ITC rejected Schaper's proposed general definition that a "significant employment of American land, labor and capital for the creation of value" constitutes an "industry." The Federal Circuit stated:

> [T]he words, purposes, and history of section 337 do not compel [Schaper's] reading if it is meant to downplay the role of production and servicing in this country. . . . If, as appellants suggest, present-day "economic realities" call for a broader definition to protect American interests (apparently including many of today's importers) it is for Congress, not the courts or the Commission, to legislate that policy. [Footnote omitted.]

717 F.2d at 1373, 219 USPQ at 669, 1 Fed. Cir. (T) at 163. Interestingly, new sections 1337(a)(2)-(3) state that new subsections (B)-(D) of section 1337(a)(1) apply only if an "industry" exists, i.e., if there is in the United States:

(A) significant investment in plant and equipment;

(B) significant employment of labor or capital; or

(C) substantial investment in its exploitation, including engineering, research and development, or licensing.

3. *Remedies*

In *Viscofan, S.A. v. United States Int'l Trade Comm'n,* 787 F.2d 544, 548, 229 USPQ 118, 121, 4 Fed. Cir. (T) 62, 65 (1986), the court stated that 19 U.S.C. § 1337 (before the Omnibus Act) required the Commission, upon determining a violation of the section, either to exclude the relevant articles from entry (subsection (d)) or to issue a cease-and-desist order (subsection (f)(1)) "unless [in light of four articulated factors listed in those subsections] it finds that such order should not be issued." The ITC, noted the court, has broad discretion in that regard, specifically with respect to "selecting the form, scope and extent of the remedy, and judicial review of its choice of remedy necessarily is limited." *Id.*

The new law makes clear that the Commission can issue a cease-and-desist order in lieu of, or in addition to, an exclusion order. Section 337(d); Victor, *supra* note 52, at 13. The Commission can also: order exclusion (or cease and desist, or both) with respect to a person failing to appear to answer a complaint and notice, or order a general exclusion order if no person appears to contest an investigation and a violation is established by "substantial, reliable, and probative evidence" (subsections (g)(1)-(2)); or, under certain conditions, order that any article imported in violation of section 1337 be seized and forfeited to the United States (subsection 1337(i)).

The Commission can also award preliminary relief under subsection (e)(1) of section 1337:

> If, during the course of an investigation under this section, the Commission determines that there is reason to believe that there is a violation of this section, it may direct that the articles concerned, imported by any person with respect to whom there is reason to believe that such person is violating this section, be excluded from entry into the United States, unless, after considering the effect of such exclusion upon the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers, it finds that such articles should not be excluded from entry.

19 U.S.C. § 1337(e)(1) (1988). That language is identical to that of section 1337(e) prior to the Omnibus Act. Added by the Act were subsections (2) and (3), the latter of which states that "[t]he Commission may grant preliminary relief under this subsection [(e)] or subsection (f) [against defaulting persons] to the same extent as preliminary injunctions and temporary restraining orders may be granted under the Federal Rules of Civil Procedure."

The court in *Rosemount, Inc. v. United States Int'l Trade Comm'n*, 910 F.2d 819, 820-21, 15 USPQ2d 1569, 1570-71, 8 Fed. Cir. (T) ___, ___ (1990), quoted subsections (e)(1) and (e)(3) and then articulated and considered the four factors used by district courts in granting preliminary relief: (1) likelihood of success; (2) whether movant will suffer irreparable injury without the preliminary relief; (3) balancing of harms; and (4) public interest. Noting that the ITC had "brought its practice into line with the standards of the district courts to the extent it had previously varied therefrom," it agreed with the ITC that the exercise of preliminary relief in Commission proceedings "should generally parallel" such exercise by district courts. 910 F.2d at 821, 15 USPQ2d at 1571, 8 Fed. Cir. (T) at ____.[55] After considering the four factors, it concluded that the ITC did not abuse its discretion in denying preliminary relief in the patent infringement case before it.

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[55] In *Warner Bros., Inc. v. United States Int'l Trade Comm'n*, 787 F.2d 562, 229 USPQ 126, 4 Fed. Cir. (T) 59 (1986), decided before the addition of subsection (e)(3) to § 1337, the ITC applied an "immediate and substantial harm" concept to preliminary relief. The "irreparable injury" concept used in *Rosemount*, to the extent different, is more in tune with the district courts' approach, which, per *Rosemount*, now "should generally parallel" the approach in ITC proceedings.

The court found that the presumption of irreparable harm afforded the movant because of its strong showing of success on the merits (a presumption derived from Federal Circuit patent jurisprudence) had been offset by evidence of what actual damage was likely, to the point where the ITC's finding of no irreparable harm was supported by substantial evidence.[56] Nor did it find error in the ITC's evaluation that the balance of harm tips towards the nonmovant, or in its assessment of the public interest. In the latter respect, the court recognized not only the public interest in protecting patent rights, but also, the "other public interest factors . . . delineated in the above-quoted section 1337(e)(1)." As for the nonmovant's challenge to likelihood of success, the court found that unnecessary to address because the irreparable injury and balance of harm factors compelled it to conclude that the ITC had not abused its discretion in denying preliminary relief.

4. *Procedure at ITC*

After a complainant files a complaint (or the ITC begins an investigation upon its own initiative), the ITC conducts an investigation. 19 U.S.C.A. § 1337(b)(1)) (West Supp. 1990). Before a determination is made, notice and opportunity for hearing is provided. *Id.* at § 1337(c). The hearing is held before an administrative law judge (ALJ) and is conducted in conformity with "subchapter II of chapter 5 of title 5." *Id.*[57] The ITC may then review part or all of the ALJ's decision, at which time that decision can be substantially modified or even reversed. 19 C.F.R. § 210.53 (1990). If the ALJ's decision is not reviewed within forty-five days, it becomes the determination of the ITC. *Id.* at § 210.53(h). The ITC may decide to review some or all of the issues embodied in the initial determination. *Id.* at § 210.55.

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[56] The court pointed out that eliminating injury as a requirement for proving a § 1337 violation in intellectual property contexts, per the Omnibus Act, "does not affect the standard for the granting of temporary relief [*e.g.*, the irreparable injury factor]." 910 F.2d at 821 n.1, 15 USPQ2d at 1571 n.1, 8 Fed. Cir. (T) at ___ n.1.

[57] The provisions of "subchapter II of chapter 5 of title 5" (5 U.S.C. §§ 551-559) and ch. 7 of title 5 (5 U.S.C. §§ 701-706) were originally enacted by the Act, June 11, 1946, ch. 423, 60 Stat. 237, popularly known as the Administrative Procedure Act. That Act was later repealed as part of the general revision of title 5 by Pub. L. No. 89-554 and its provisions incorporated in 5 U.S.C. §§ 551-559, 701-706. *See* 5 U.S.C.A. §§ 701-706, Historical Note, at 398 (1977).

The statute places strict time limits on the length of ITC proceedings. The Commission "shall conclude any such investigation, and make its determination under this section, at the earliest practicable time, but not later than one year (18 months in more complicated cases) after the date of publication of notice of such investigation." 19 U.S.C. § 1337(b)(1) (1988). The ALJ must make his or her determination within nine months of publication of the ITC's notice of investigation, or within fourteen months in complicated cases. 19 C.F.R. § 210.53(a) (1990).

The ITC must publish any "violation" determination in the Federal Register and transmit a copy to the President, along with the remedy provided. 19 U.S.C.A. § 1337(j)(1) (West Supp. 1990). The President then has sixty days to decide whether to disapprove of the determination, and he may disapprove for policy reasons only. *Id.* at § 1337(j)(2). Though "policy" is a broad concept, *Duracell, Inc. v. United States Int'l Trade Comm'n*, 778 F.2d 1578, 1581-82, 228 USPQ 187, 189, 4 Fed. Cir. (T) 29, 32 (1985), the President may not disapprove of a determination because of disagreement with the ITC's determination on the merits. *Young Eng'rs, Inc. v. United States Int'l Trade Comm'n*, 721 F.2d 1305, 1313, 219 USPQ 1142, 1149, 2 Fed. Cir. (T) 9, 17 (1983).

The day the determination is sent to the President, it is also published in the Federal Register *and takes effect*. 19 U.S.C.A. § 1337(j)(1) and (3) (West Supp. 1990). If the President disapproves of it, and notifies the Commission accordingly during the sixty-day period, it and any exclusionary relief issued pursuant to it ceases being effective. *Id.* at § 1337(j)(2).

5. *Judicial Review*

Section 1337(c) of title 19 authorizes "[a]ny person adversely affected by a final determination of the Commission under subsection (d) [exclusion orders], (e) [temporary exclusion orders], (f) [cease-and-desist orders], and (g) [exclusion or cease-and-desist order against defaulting persons] of this section" to appeal to the Federal Circuit under the Administrative Procedure Act, 5 U.S.C. §§ 701-706. Pursuant to 5 U.S.C. § 706, the Federal Circuit is to "decide all relevant questions of law" and set aside findings of fact found to be unsupported by substantial evidence. *SSIH Equip. S.A. v. United States Int'l*

Trade Comm'n, 718 F.2d 365, 371-72, 218 USPQ 678, 684, 1 Fed. Cir. (T) 90, 95-96 (1983).[58]

A "final" determination is a decision "'*on the merits*, excluding or refusing to exclude articles from entry' under 19 U.S.C. § 1337(d), (e), or (f)." *Block v. United States Int'l Trade Comm'n*, 777 F.2d 1568, 1571, 228 USPQ 37, 38, 4 Fed. Cir. (T) 21, 24 (1985) (emphasis in original).[59] In *Block*, a dismissal by the Commission without ruling on, and wholly vacating, the ALJ's decision was held not to be "final," and hence, not appealable. *Id.* Moreover, a Commission determination of "violation" that is denied by the President is not final (and, hence, cannot be appealed). *Duracell, Inc. v. United States Int'l Trade Comm'n*, 778 F.2d 1578, 1580, 228 USPQ 187, 188, 4 Fed. Cir. (T) 29, 30 (1985). Thus:

> Under the statutory scheme, a determination of the Commission under (d), (e), or (f), while effective immediately, becomes "final" for purpose of appeal only if the President approves or if the 60-day review period passes without his disapproval. [Footnote omitted.]

Id. Accord Allied Corp. v. United States Int'l Trade Comm'n, 782 F.2d 982, 984, 228 USPQ 532, 533, 4 Fed. Cir. (T) 40, 41-42 (1986). As for a Commission determination of "no violation" (*e.g.*, because of patent invalidity), it is final as of the date of the determination because "there [is] no provision for Presidential review, or for other administrative proceedings, following a determination that does not lead to an exclusion order." *Allied Corp. v. United States Int'l Trade Comm'n*, 782 F.2d at 984, 228 USPQ at 533, 4 Fed. Cir. (T) at 40-41 (1986).

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[58] Before § 1337(c) was amended in 1980, it required the CCPA to review ITC determinations in "the same manner and subject to the same limitations and concerns as in the case of appeals from decisions of the United States Customs Court." 19 U.S.C.A. § 1337(c) (West Supp. 1980). Customs Court decisions at that time were generally reviewed by the CCPA under a "weight of the evidence" standard. *See, e.g., Cascade Corp. v. United States*, 595 F.2d 25, 30 (CCPA 1979); *Montgomery Ward & Co. v. United States*, 499 F.2d 1283, 1285 (CCPA 1974). *See generally* Sturm, *Customs Law & Administration*, § 34.6 at 19-22 (1989). The latter standard was changed statutorily in 1980 (for review by the CCPA of Court of International Trade decisions) to "clearly erroneous." 28 U.S.C. § 2601 (Supp. V 1981). The latter statute was repealed in 1982 by the FCIA. The standard of review of Court of International Trade decisions, though, is still "clearly erroneous." *See* § VII.A.2., *supra*.

[59] Present subsection (g), also involving exclusionary relief (against defaulting persons), was added after *Block*.

Finality also has come up in the context of reviewing discovery orders, particularly as they relate to confidentiality. In *Viscofan, S.A. v. United States Int'l Trade Comm'n*, 787 F.2d 544, 229 USPQ 118, 4 Fed. Cir. (T) 62 (1986), the petitioner challenged not only aspects of an exclusion order, but also, the ITC's refusal to declassify confidential information that had been submitted pursuant to a protective order during the Commission proceedings. The Federal Circuit ruled that it could not review the matter because its review is only of final determinations under sections 1337(d), (e), and (f), and that does not include review of a refusal to declassify information that is unrelated to the propriety of the exclusion order. Later, though, in *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241, 5 Fed. Cir. (T) 52 (1986), *cert. denied*, 482 U.S. 909 (1987), the court did review the ITC's denial to permit greater access to confidential information. It distinguished *Viscofan* on the basis that "here (but not in *Viscofan*) the confidentiality problem was directly related to the propriety of the exclusion order." 808 F.2d at 1485 n.15, 1 USPQ2d at 1250 n.15, 5 Fed. Cir. (T) at 65 n.15.

As for *who* may sue, the statute refers to "[a]ny person adversely affected by a final determination . . . ." That can include an entity who was not a party or intervenor to the proceeding below, so long as it is aggrieved by the exclusion order. *See LSI Computer Sys., Inc. v. United States Int'l Trade Comm'n*, 832 F.2d 588, 4 USPQ2d 1705, 6 Fed. Cir. (T) 31 (1987) (nonparty LSI, a United States manufacturer of electrical circuits that constituted components of the excluded products, was allowed to appeal).

VIII. APPEALS FROM THE COURT OF VETERANS APPEALS AND RULEMAKING BY THE SECRETARY OF VETERANS AFFAIRS

Effective September 1, 1989, and established under article I of the Constitution, the United States Court of Veterans Appeals (Court of Veterans Appeals) was created and the Federal Circuit was given exclusive authority to review those of its decisions that are reviewable. 38 U.S.C. §§ 4051, 4092 (1988). To be reviewable, a decision must involve "the validity of any statute or regulation (other than a refusal to review the schedule of ratings for disabilities adopted under section 355 of this title) or any interpretation thereof (other than a determination as to factual matter) that was relied on by the Court [of Veterans Appeals] in making the decision." 38 U.S.C. § 4092(a) (1988). In addition, section 4092(d)(2) (1988) provides that "[e]xcept to the extent that an appeal under this chapter presents a constitutional issue, the Court of Appeals may not review (A) a challenge to a factual determination, or (B) a challenge to a law or regulation as applied to the facts of a particular case."

Also, effective September 1, 1989, rulemaking by the Secretary of Veterans Affairs (i.e., formerly the Administrator of the Veterans' Administration)[60] "to which section 552(a)(1) or 553 of title 5 (or both)[61] refers (other than an action relating to the adoption or revision of the schedule of ratings for disabilities adopted under section 355 of this title) is subject to judicial review." 38 U.S.C.A. § 223(c) (West Supp. 1990). Such review should be brought in accordance with chapter 7 of title 5 (section 701 *et seq.*, which pertains to judicial review of agency actions) and may be sought only in the Federal Circuit. *Id.*

Cases from the Court of Veterans Appeals originate when a claimant files a claim with a Veterans' Administration Regional Office. Appeal may then be taken to the Board of Veterans Appeals, which may be followed by appeal to the Court of Veterans Appeals, 38 U.S.C. §§ 4004 and 4052 (1988), where it is heard by judges sitting alone or in panels of at least three. 38 U.S.C. § 4054 (1988). The Court of Veterans Appeals is composed of a chief judge and at least two, but not more than six, associate judges. Those judges are appointed by the President for fifteen-year terms. 38 U.S.C. § 4053 (1988).

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[60] Effective March 15, 1989, the "Department of Veterans Affairs Act" redesignated the Veterans' Administration "as the Department of Veterans Affairs," which "shall be an executive department in the executive branch of the government. There shall be at the head of the Department a Secretary of Veterans Affairs . . . ." Pub. L. No. 100-527, 102 Stat. 2635 (1988), reproduced in 38 U.S.C.A. § 201 Note (West Supp. 1990). Thereafter, reference in any federal law to the Administrator of Veterans Affairs and to the Veterans' Administration, respectively, shall be deemed to refer to the Secretary of Veterans Affairs and to the Department of Veterans Affairs. *Id.* at 2640-41. Also, the Secretary was obligated by the Act to submit to Congress within six months proposed legislation containing technical and conforming amendments to title 38 and other provisions of law reflecting the changes made by the Act. *Id.* at 2644. *See also* Stichman, *The Veterans' Judicial Review Act of 1988: Congress Introduces Courts and Attorneys to Veterans' Benefits Proceedings*, 41 Admin. L. Rev. 365 (1989).

[61] Sections 552(a)(1) and 553 are part of chapter 5 of title 5, i.e., the Administrative Procedure Act. *See* note 57, *supra*. Section 552(a)(1) requires an agency, *inter alia*, to publish in the Federal Register rules of procedure and substantive rules of general applicability authorized by law. Section 553 pertains specifically to the procedure for rulemaking.

Due to the recent nature of the legislation, as of July 1, 1990, the Federal Circuit had not issued any decisions in "Veterans Appeals" cases.

IX. APPEALS FROM THE SECRETARIES OF COMMERCE AND AGRICULTURE IN SELECTED MATTERS

A. *Review of the Secretary of Commerce*

Under 28 U.S.C. § 1295(a)(7), the Court of Appeals for the Federal Circuit has exclusive jurisdiction to review "on questions of law only, findings of the Secretary of Commerce under U.S. note 6, subchapter X, chapter 98 of the Harmonized Tariff Schedule (HTS) of the United States (relating to importation of instruments or apparatus)." However, as of July 1, 1990, less than ten cases have been appealed to the Federal Circuit on that jurisdictional ground. One such case was *M.M. & P. Maritime Advancement, Training, Education & Safety Program (MATES) v. Department of Commerce*, 729 F.2d 748, 2 Fed. Cir. (T) 36 (1984).

MATES was a nonprofit institution administering the Maritime Institute of Technology and Graduate Studies and conducting educational/training programs in navigation, shipbuilding, and related fields. It requested duty-free entry into the United States of two shipbuilding and navigational simulators to be used in its shipbuilding/navigational courses. MATES contended that the simulators were to be used for educational purposes and, hence, were duty free under item 851.60 of the Tariff Schedule of the United States (TSUS) added by section 6 of the Educational, Scientific and Cultural Materials Importation Act of 1966 (Act).[62] The Act provides for "duty-free importation of educational, scientific, and cultural materials if certain requirements are met." 729 F.2d at 750, 2 Fed. Cir. (T) at 37. The provision at issue in this case provided for duty-free entry of:

---

[62] Pub. L. No. 89-651, § 6(c), 80 Stat. 897, 899, 19 U.S.C. § 1202, schedule 8, part 4, headnote 6. As indicated in § VII A.3.a., *supra*, the TSUS was replaced by the HTS, effective 1989. House Committee on Ways and Means, *Overview and Compilation of U.S. Trade Statutes*, 1989 ed., at 1.

> "Articles entered for the use of any non-profit institution, whether public or private, established for educational or scientific purposes:
>
> "Instruments and apparatus, if no instrument or apparatus of equivalent scientific value for the purposes for which the instrument or apparatus is intended to be used is being manufactured in the United States (see headnote 6 to this part) [19 U.S.C. § 1202, Schedule 8, Part 4, Item 851.60, of the . . . (TSUS)]."

Id.

The Secretary of Commerce denied the request. He determined that the Act permits duty-free entry only for articles intended to be used for scientific research or formal science-oriented education, not for vocational training, as here. The Federal Circuit reversed and remanded.

According to the court, the Act allows duty-free status if: (1) the material is entered for use by any nonprofit institution established for scientific or educational purposes; and (2) no instrument or apparatus of equivalent scientific value for the purposes for which it is intended to be used is being manufactured in the United States. The Federal Circuit agreed with the government that the second aspect of that test, determining "equivalent scientific value," is important and that it must be determined in the context of the intended use of the foreign article. *Id.* at 750, 2 Fed. Cir. (T) at 40. It disagreed, however, with the Secretary imposing on the first aspect the requirement that the purpose need be scientific research or formal science-oriented education. It is enough where, as here, the purpose is educational. The court continued:

> Although we agree with the government that in order for the Secretary to make his scientific equivalency determination the article must have some "scientific value" for its intended use, we, however, do not agree that this means that the article must be used in formal science-oriented education. We also do not agree that an article imported for use in vocational training is excluded from the benefits of the Act.

729 F.2d at 754, 2 Fed. Cir. (T) at 44.

As to whether the article had some scientific value, the court stated that "'scientific' is a very broad term and . . . for the purposes of this Act it includes the applied sciences such as navigation and aviation as well as the customary academic sciences such as physics, chemistry, and biology." 729 F.2d at 755, 2 Fed. Cir. (T) at 42. The court then concluded that "vocational training in a scientific field does come within the Act and . . . that appellant's use of the simulators was to educate and train students in such a scientific field." 729 F.2d at 757, 2 Fed. Cir. (T) at 46. Having determined that the first aspect of the two-part test was met, the court remanded the case so that the second aspect could be determined. *Id.*

B. *Review of the Secretary of Agriculture*

Under 28 U.S.C. § 1295(a)(8) and 7 U.S.C. § 2461 (1988), the Federal Circuit has jurisdiction of any appeal "[f]rom the decisions made under sections 2404, 2443, 2501, 2502, and 2568 of" title 7. The origin of those sections is the Plant Variety Protection Act of 1970, and they involve determinations relating to plant variety protection by the Secretary of Agriculture. As of July 1, 1990, the Federal Circuit has not had any "Secretary of Agriculture" cases.

Certificates of plant variety protection to be issued by the Department of Agriculture are available only for certain types of plants propagated *sexually*. Prior to 1970, patent protection for *asexually* reproduced plants had been the subject of 35 U.S.C. §§ 161-164, which allows the PTO Commissioner to grant patents therefor if the conditions of 35 U.S.C. are otherwise met. The origin of the latter sections is the Plant Patent Act of 1930, which:

> applie[d] only to plants propagated by *asexual* reproduction. [Emphasis added.] As was stated by Congressman Mayne in the House hearings on the 1970 act [Plant Variety Protection Act]:
>
> "Those plants which reproduce asexually such as by budding and grafting have been covered by the patent law since 1930. There is no justification for not extending the same coverage to sexually reproduced plants. [Hearings on H.R. 1290, 91st Cong., 2d Sess., 116 Cong. Rec. 40296 (1970).]"

In re Bergy, 596 F.2d 952, 984, 201 USPQ 352, 380 (CCPA 1979), *cert. granted sub nom. Parker v. Bergy*, 444 U.S. 924, *appeal dismissed as moot*, 444 U.S. 1028 (1980).

X. FRIVOLOUS APPEALS

Any summary of the court's first eight years should include some discussion of the court's handling of frivolous appeals. The court has treated very seriously the filing of, and proceeding with, such appeals. In the court's view, they constitute an unnecessary and unjustifiable burden on overcrowded courts, diminish the opportunity for careful consideration of nonfrivolous appeals, and delay access to the courts of persons having truly deserving causes.

Asberry v. United States Postal Service, 692 F.2d 1378, 215 USPQ 921 (Fed. Cir. 1982), was the first case in which the Federal Circuit determined that an appeal was frivolous. In that case, Mr. Asberry petitioned for review of an MSPB decision that denied his petition to review an earlier decision dismissing his appeal in view of a settlement. Because of the preclusive effect of the settlement, the Federal Circuit affirmed, but went on to assess costs and attorney fees against Mr. Asberry and his lawyer in favor of the government under rule 38 of the Federal Rules of Appellate Procedure. That rule provides: "[i]f a court of appeals shall determine that an appeal is frivolous, it may award just damages and single or double costs to the appellee." However, because *Asberry* was the first Federal Circuit opinion finding an appeal to be frivolous, and neither of its predecessor courts had ever entered or even had a rule allowing such awards, the Federal Circuit remitted the imposed costs and attorney fees. On the other hand, the opinion warned, in the future "a frivolous appeal filed or proceeded with in this court will result in imposition of damages and costs upon appellant and counsel in accordance with Rule 38." 692 F.2d at 1382.

Indeed, subsequent "frivolants," sometimes called "recreational litigants," were not as lucky as Mr. Asberry. *See, e.g., Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990) (Pac-Tec and its attorney held jointly and severally liable to Amerace for the latter's attorney fees and double its costs in connection with a frivolous appeal); *Dreamlite Holdings Ltd. v. Kraser*, 890 F.2d 1147, 13 USPQ2d 1076 (Fed. Cir. 1989), *cert. denied*, 110 S. Ct. 1924 (1990) (Kraser and his attorney held jointly and severally liable to Dreamlite for the latter's attorney fees and double its costs in connection with a frivolous appeal); *Sun-Tek Indus., Inc. v. Kennedy Sky Lites, Inc.*, 856 F.2d 173 (Fed. Cir. 1988) (Kennedy's counsel held liable to Sun-Tek for reasonable attorney fees and costs Sun-Tek incurred in defending a frivolous appeal); *Zuger v. United States*, 834 F.2d 1009 (Fed. Cir. 1987) (Zuger, a pro se, held liable for $500 for a frivolous appeal); *Porter v. Farmers Supply Serv., Inc.*, 790 F.2d 882, 229 USPQ 814 (Fed. Cir. 1986) (Porter and his counsel held jointly and severally liable to Farmers for the latter's costs and attorney fees in connection with a frivolous appeal); *Wright v. United States*, 728 F.2d 1459 (Fed. Cir.), *cert. denied*, 469 U.S. 844 (1984) (Wright, a pro se, held liable for double United States costs and $500 for a frivolous appeal); *Beachboard v. United States*, 727 F.2d 1092 (Fed. Cir. 1984) (Beachboard, a pro se, held liable for double United States costs and $200 for a frivolous appeal).

Probably the severest sanction was imposed in *In re Solerwitz*, 848 F.2d 1573 (Fed. Cir. 1988) (in banc), *cert. denied*, 488 U.S. 1004 (1989). Mr. Solerwitz represented former air traffic controllers who were removed because of their participation in a 1981 illegal air traffic controllers strike. (*See* discussion of *Air Controller* cases, section II.D, *supra*.) In their appeals to this court from decisions of the MSPB upholding their removal, Mr. Solerwitz filed 154 petitions for review for 736 controllers. In order to expedite resolution of about 4,500 petitions for review, the Federal Circuit designated twelve lead cases that it believed presented most of the legal issues common to the appeals. All other cases were suspended pending decision on those twelve cases. After the twelve lead cases were decided, all counsel representing air traffic controllers were cautioned against the impropriety of maintaining frivolous appeals, and that they should give consideration to whether the fact patterns in their cases were distinguishable from the twelve lead cases.

Despite the warning, Solerwitz filed or maintained 142 frivolous appeals, 107 of which had virtually identical briefs. Moreover,

> "Solerwitz disregarded Federal Rules of Appellate Procedure and this court's rules, failed to file appendices, provided no citations to the record, ignored authorities cited by the government, advanced numerous arguments on issues not on appeal, and repeatedly raised contentions not raised before the Merit Systems Protection Board. Mr. Solerwitz' briefs were devoid of any showing on which the decision appealed from could even possibly be reversed, devoid of any basis on which the precedents of this court could be distinguished in law or fact, and devoid of any effort to make such distinctions, in total disregard of this court's written instructions. . . ."

Id. at 1575. The Federal Circuit sanctioned Mr. Solerwitz $78,300.

Thereafter, the court instituted a proceeding by in banc order directing Mr. Solerwitz to "show cause why he should not be suspended for two years from representing clients before this court." Senior Circuit Judge Bennett conducted a hearing requested by Mr. Solerwitz, after which he recommended that Mr. Solerwitz be suspended from practice before this court for two years, but that enforcement of the suspension be held in abeyance for the entire period, pending his demonstration of rehabilitation during probation. On review of that recommendation, the Federal Circuit, in banc, held that a one-year suspension from practice was appropriate disciplinary action for Solerwitz' frivolity, but that it would not be held in abeyance.

Though it has consistently treated frivolous appeals with a stern hand, the court has not been insensitive to contentions of counsel that excessive, but legitimate, advocacy can be confused with frivolous arguments. The court has always kept in mind that there may indeed be a fine line between the two. For example, on petition for rehearing in *Refac Int'l, Ltd. v. IBM*, 798 F.2d 459, 230 USPQ 537 (Fed. Cir. 1986), the court affirmed its earlier decision on the merits (dismissing Refac's appeal) but vacated its earlier rule 38 award (for a frivolous appeal) of attorney fees and costs. The Federal Circuit opined that, although Refac's argument on the merits was not persuasive enough for Refac to win the appeal, it was just within the "ragged edge of the penumbra surrounding legitimate advocacy." *Id.* at 460, 230 USPQ at 537-38.

PART VI

APPENDICES

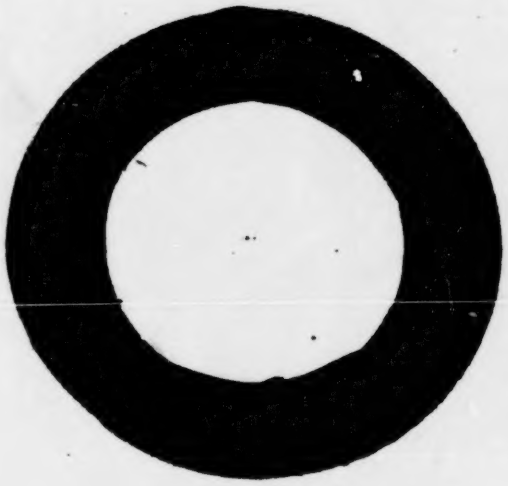

TABLE A
JUDGES OF THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

		Orig. Ct. & Post-1982 Appointments	Senior Status	Deceased	Retired
ORIGINAL COURT (Oct. 1, 1982):					
Active Judges:					
Markey, Howard T.	*1st Chief Judge**	1982			
Friedman, Daniel M.		1982	1989		
Rich, Giles S.		1982			
Nichols, Philip, Jr.		1982	1983	1990	
Davis, Oscar H.		1982		1988	
Baldwin, Phillip B.		1982	1986		
Kashiwa, Shiro		1982			1986
Bennett, Marion T.		1982	1986		
Miller, Jack R.		1982	1985		
Smith, Edward S.		1982	1989		
Nies, Helen W.	*2d Chief Judge***	1982			
(Vacant)					
Senior Judges:					
Laramore, Don N.		1982	1972	1989	
Almond, James L., Jr.		1982	1973	1986	
Cowen, Wilson		1982	1978		
Skelton, Byron G.		1982	1978		
Post-1982 Appointments:					
Newman, Pauline		1984			
Bissell, Jean Galloway		1984		1990	
Archer, Glenn L., Jr.		1985			
Mayer, H. Robert		1987			
Michel, Paul R.		1988			
Plager, S. Jay		1989			
Lourie, Alan D.		1990			
Clevenger, Raymond C., III		1990			
Rader, Randall R.		1990			
(Vacant)					

*Oct. 1, 1982–June 27, 1990
**June 27, 1990–present

TABLE B

JUDGES OF THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Dates of Birth and Death and Age at Time of Death)

Name	Date of Birth	Date of Death	Age—Time of Death		
			yrs.	mos.	days
Almond, James L., Jr.	June 15, 1898	Apr. 14, 1986	87	9	29
Archer, Glenn L., Jr.	Mar. 21, 1929				
Baldwin, Phillip B.	Dec. 23, 1924				
Bennett, Marion T.	June 6, 1914				
Bissell, Jean Galloway	June 9, 1936	Feb. 4, 1990	53	7	25
Clevenger, Raymond C., III	Aug. 27, 1937				
Cowen, Wilson	Dec. 20, 1905				
Davis, Oscar H.	Feb. 27, 1914	June 19, 1988	74	3	22
Friedman, Daniel M.	Feb. 8, 1916				
Kashiwa, Shiro	Oct. 24, 1912				
Laramore, Don N.	Dec. 22, 1906	Aug. 9, 1989	82	7	17
Lourie, Alan D.	Jan. 13, 1935				
Markey, Howard T.	Nov. 10, 1920				
Mayer, H. Robert	Feb. 21, 1941				
Michel, Paul R.	Feb. 3, 1941				
Miller, Jack R.	June 6, 1916				
Newman, Pauline	June 20, 1927				
Nichols, Philip, Jr.	Aug. 11, 1907	Jan. 26, 1990	82	5	15
Nies, Helen W.	Aug. 7, 1925				
Plager, S. Jay	May 16, 1931				
Rader, Randall R.	Apr. 21, 1949				
Rich, Giles S.	May 30, 1904				
Skelton, Byron G.	Sept. 1, 1905				
Smith, Edward S.	Mar. 27, 1919				

TABLE C
JUDGES OF THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT — Lines of Succession

1982	Howard T. Markey CJ 10/1/82-6/26/90	Daniel M. Friedman J 10/1/82-11/1/89*	Giles S. Rich J 10/1/82-	Philip Nichols, Jr. J 10/1/82-10/1/83*	Oscar Davis J 10/1/82-6/19/88***	Phillip B. Baldwin J 10/1/82-11/25/86*	Shiro Kashiwa J 10/1/82-1/7/86**	Marion T. Bennett J 10/1/82-3/1/86*	Jack R. Miller J 10/1/82-6/6/85*	Edward S. Smith J 10/1/82-6/1/89*	Helen Wilson Nies J 10/1/82-6/26/90	Vacant 10/1/82
1983				vacant								
1984				Pauline Newman J 5/7/84-								Jean G. Bissell J 9/14/84-2/4/90***
1985									Glenn L. Archer, Jr. J 12/23/85-			
1986						vacant	vacant	vacant				
1987								H. Robert Mayer J 6/19/87-				
1988					vacant	Paul R. Michel J 3/8/88-						
1989		vacant					S. Jay Plager J 11/11/89-			vacant		
1990	Howard T. Markey J 6/27/90-****	Alan D. Lourie J 4/11/90-			R.C. Clevenger III J 5/3/90-						Helen Wilson Nies CJ 6/27/90-*****	Randall R. Rader J 8/14/90-

*Took Senior Status **Retired ***Deceased ****Stepped aside as Chief Judge *****Became Chief Judge

TABLE D

COMPOSITION OF THE COURT

[The following table is designed to aid the user in identifying the composition of the court at any given time. Each listing is headed by the Chief Judge, whose name is italicized. Circuit judges are then listed below in order of seniority.]

Oct. 1, 1982—Sept. 30, 1983
Markey
Friedman
Rich
Nichols (s. 10/1/83)
Davis
Baldwin
Kashiwa
Bennett
Miller
Smith
Nies
(Vacant)

Oct. 1, 1983—May 6, 1984
Markey
Friedman
Rich
Davis
Baldwin
Kashiwa
Bennett
Miller
Smith
Nies
(Vacant)
(Vacant)

May 7, 1984—Sept. 13, 1984
Markey
Friedman
Rich
Davis
Baldwin
Kashiwa
Bennett
Miller
Smith
Nies
Newman (o. 5/7/84)
(Vacant)

Sept. 14, 1984—June 5, 1985
Markey
Friedman
Rich
Davis
Baldwin
Kashiwa
Bennett
Miller (s. 6/6/85)
Smith
Nies
Newman
Bissell (o. 9/14/84)

June 6, 1985—Dec. 22, 1985
Markey
Friedman
Rich

---

o. — Oath
d. — Deceased
r. — Retired
s. — Senior Status
v. CJ - Vacated Chief Judgeship

June 6, 1985—Dec. 22, 1985
(Cont'd)

Davis
Baldwin
Kashiwa
Bennett
Smith
Nies
Newman
Bissell
(Vacant)

Dec. 23, 1985—Jan. 6, 1986

Markey
Friedman
Rich
Davis
Baldwin
Kashiwa (r. 1/7/86)
Bennett
Smith
Nies
Newman
Bissell
Archer (o. 12/23/85)

Jan. 7, 1986—Feb. 28, 1986

Markey
Friedman
Rich
Davis
Baldwin
Bennett (s. 3/1/86)
Smith
Nies
Newman
Bissell
Archer
(Vacant)

Mar. 1, 1986—Nov. 24, 1986

Markey
Friedman
Rich
Davis
Baldwin (s. 11/25/86)
Smith
Nies
Newman
Bissell
Archer
(Vacant)
(Vacant)

Nov. 25, 1986—June 18, 1987

Markey
Friedman
Rich
Davis
Smith
Nies
Newman
Bissell
Archer
(Vacant)
(Vacant)
(Vacant)

June 19, 1987—Mar. 7, 1988

Markey
Friedman
Rich
Davis
Smith
Nies
Newman
Bissell
Archer
Mayer (o. 6/19/87)
(Vacant)
(Vacant)

Mar. 8, 1988—June 18, 1988
Markey
Friedman
Rich
Davis (d. 6/19/88)
Smith
Nies
Newman
Bissell
Archer
Mayer
Michel (o. 3/8/88)
(Vacant)

June 19, 1988—May 31, 1989
Markey
Friedman
Rich
Smith (s. 6/1/89)
Nies
Newman
Bissell
Archer
Mayer
Michel
(Vacant)
(Vacant)

June 1, 1989—Oct. 31, 1989
Markey
Friedman (s. 11/1/89)
Rich
Nies
Newman
Bissell
Archer
Mayer
Michel
(Vacant)
(Vacant)
(Vacant)

Nov. 1, 1989—Nov. 10, 1989
Markey
Rich
Nies
Newman
Bissell
Archer
Mayer
Michel
(Vacant)
(Vacant)
(Vacant)
(Vacant)

Nov. 11, 1989—Feb. 3, 1990
Markey
Rich
Nies
Newman
Bissell (d. 2/4/90)
Archer
Mayer
Michel
Plager (o. 11/11/89)
(Vacant)
(Vacant)
(Vacant)

Feb. 4, 1990—Apr. 10, 1990
Markey
Rich
Nies
Newman
Archer
Mayer
Michel
Plager
(Vacant)
(Vacant)
(Vacant)
(Vacant)

Apr. 11, 1990—May 2, 1990

Markey
Rich
Nies
Newman
Archer
Mayer
Michel
Plager
Lourie (o. 4/11/90)
(Vacant)
(Vacant)
(Vacant)

May 3, 1990—June 26, 1990

Markey
Rich
Nies
Newman
Archer
Mayer
Michel
Plager
Lourie
Clevenger (o. 5/3/90)
(Vacant)
(Vacant)

June 27, 1990—Aug. 13, 1990

Nies (o. CJ 6/27/90)
Markey (v. CJ 6/27/90)
Rich
Newman
Archer
Mayer
Michel
Plager
Lourie
Clevenger
(Vacant)
(Vacant)

Aug. 14, 1990—

Nies
Markey
Rich
Newman
Archer
Mayer
Michel
Plager
Lourie
Clevenger
Rader (o. 8/14/90)
(Vacant)

TABLE E

VISITING JUDGES (1982-1990)

The judges of the U.S. Court of Appeals for the Federal Circuit have frequently been designated by the Chief Justice to sit with other federal courts:

Judge	*Other Courts Served*
Glenn L. Archer, Jr.	D.C. Cir.
Phillip B. Baldwin	S.D. Ohio.
Marion T. Bennett	8th Cir., D.D.C.
Wilson Cowen	1st Cir.
Oscar Davis	D.C. Cir., 1st Cir., 2d Cir.
Daniel M. Friedman	D.C. Cir., 2d Cir., 8th Cir.
Howard T. Markey	D.C. Cir., 2d Cir., 6th Cir., 8th Cir., 11th Cir.
H. Robert Mayer	D.C. Cir., 1st Cir.
Jack R. Miller	10th Cir.
Philip Nichols, Jr.	7th Cir., 11th Cir.
Helen Wilson Nies	D.C. Cir., 6th Cir., 11th Cir.
S. Jay Plager	D.C. Cir.
Byron G. Skelton	1st Cir., N.D. Texas
Edward S. Smith	4th Cir., 11th Cir., N.D. Ala.

Judges of other federal courts have also been designated to sit with this court:

Visiting Judge	*From*
Arthur L. Alarcon	9th Cir.
Peter Beer	E.D. Louisiana
Rudi M. Brewster	S.D. California
Garrett E. Brown, Jr.	D. New Jersey
William D. Browning	D. Arizona
Samuel Conti	N.D. California
Brian Barnett Duff	N.D. Illinois
Edward Dumbauld	W.D. Pennsylvania
Adrian G. Duplantier	E.D. Louisiana
Morgan Ford	U.S. Court of Int'l Trade
Lloyd D. George	D. Nevada
James Harvey	E.D. Michigan
Richard B. Kellam	E.D. Virginia
Robert J. Kelleher	C.D. California
John C. Lifland	D. New Jersey

Visiting Judge (Cont'd)	*From*
Richard Mills	C.D. Illinois
C. A. Muecke	D. Arizona
Bernard Newman	U.S. Court of Int'l Trade
Charles R. Norgle, Sr.	N.D. Illinois
Edward D. Re	U.S. Court of Int'l Trade
L. T. Senter, Jr.	N.D. Mississippi
Allen Sharp	N.D. Indiana
Luther M. Swygert	7th Cir.
A. Wallace Tashima	C.D. California
Stanley A. Weigel	N.D. California
Hubert L. Will	N.D. Illinois
Spencer M. Williams	N.D. California
John Minor Wisdom	5th Cir.

The designations of circuit and district judges and judges of the U.S. Court of International Trade to act as circuit judges in the Federal Circuit, and of circuit judges of the Federal Circuit to act as circuit judges of another circuit, are made by the Chief Justice of the United States upon presentation of a certificate of necessity by the Chief Judge of the circuit where the need arises. The Chief Justice also maintains a roster of senior judges and retired circuit and district judges, who may be designated and assigned to a court of appeals or a district court upon a certificate of necessity. Senior circuit judges of the Federal Circuit have served in both circuit and district courts under this authority, and both senior circuit judges of other circuits and senior district judges have similarly served in the Federal Circuit.